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**Datasheet for the decision
of 22 June 2016**

Case Number: T 1678/14 - 3.4.02

Application Number: 11182532.9

Publication Number: 2437049

IPC: G01N21/84, B29C65/78, G02B5/30,
G02F1/13, G02F1/1335,
B32B38/00, B32B41/00

Language of the proceedings: EN

Title of invention:
Method and system for laminating optical elements

Applicant:
Nitto Denko Corporation

Headword:

Relevant legal provisions:
EPC Art. 76(1)

Keyword:
Divisional application - subject-matter extends beyond content
of earlier application (yes)

Decisions cited:
T 0341/06

Catchword:

Claim 1 of the divisional application defines a method for inspecting an optical film.

That inspection process, however, is taught in the parent application to form an integral part of a more general lamination process. Since the inspection process is not disclosed as a second, separate invention in the parent application as filed, it may not be claimed in the divisional application separately from the method of laminating the film.



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Case Number: T 1678/14 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 22 June 2016

Appellant: Nitto Denko Corporation
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Osaka 567-8680 (JP)

Representative: Gill Jennings & Every LLP
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 25 March 2014
refusing European patent application No.
11182532.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman B. Müller
Members: A. Hornung
H. von Gronau

Summary of Facts and Submissions

I. The applicant appealed against the decision of the examining division refusing European patent application No. 11182532.9 on the basis of Article 76(1) EPC. The present application is a divisional application of European patent application No. 07829703.3.

II. The applicant requested that the decision of the examining division be set aside and a patent be granted on the basis of a new main request filed with the statement setting out the grounds of appeal. The applicant asserted that it responded to the objection raised by the examining division under Article 76(1) EPC "by introducing positive reference to the presence and use of a lamination unit where the film is cut into a sheet and is attached to a product panel member ...".

As a precaution, the appellant requested oral proceedings.

III. In a communication annexed to a summons to oral proceedings, the board informed the applicant about its provisional and non-binding opinion according to which the claimed subject-matter extended beyond the content of the earlier application.

IV. The board's opinion concerning the objection under Article 76(1) EPC was worded as follows (see point 6.3 of the communication annexed to the summons):

6.3 *"The board, in its preliminary and non-binding view, tends to agree with the conclusion drawn by the examining division according to which the subject-matter of the divisional application extends beyond the content of the parent application, contrary to the requirements of Article 76(1) EPC.*

6.3.1 Lamination step not effectively present in claim 1 of the divisional application

The invention of present claim 1 generally relates to a method for inspecting a continuous optically functional film. Beyond that, claim 1 comprises several references to a lamination unit or a laminating process which, however, do not effectively form part of the claimed subject-matter.

In particular, the claimed method is such "as to make the inspected optically functional film usable in a laminating unit for laminating the optically functional film to an optical product panel member" (see claim 1, lines 7 to 9). However, this passage of claim 1 merely seems to define in broad terms a functional feature of the claimed inspecting method without defining a laminating unit nor a laminating activity clearly forming part of the claimed method.

Moreover, in lines 21 to 28, claim 1 goes on defining a transferring step of the inspected optical film to a lamination unit where the inspected optical film is cut into pieces, the releasable film is removed and then the cut film attached to the panel. This passage of claim 1 seems to define effectively only a transferring step but no laminating step forming part of the claimed method. The details about the steps carried out in the unit to which the film is transferred seem to characterize merely the unit as such but not the claimed method for inspecting the film.

It follows that present claim 1 does not seem to effectively comprise a step of laminating the optically functional film to the panel.

6.3.2 "Attached to" versus "laminated to"

Notwithstanding the fact that no laminating step appears to form effectively part of the claimed subject-matter (see point 6.3.1 above), it is to be noted that present claim 1 (lines 26 and 28) uses the wording "attached to" for describing the relationship between the optically functional film and the product panel member. However, it seems that the wording "attached to" has a broader meaning than the wording "laminated to" which is used in the parent application as filed. It appears to be doubtful whether this amendment has a sufficient basis in the parent application, contrary to the requirement of Article 76(1) EPC.

6.3.3 Inspection process not disclosed as a second, separate invention in the parent application as filed

The skilled person is taught by the parent application as originally filed that the invention relates to a method or a system for laminating an optically functional film to a panel.

There seems to be no indication in the parent application as filed of a further invention relating specifically to the inspection of the optically functional film as such.

In particular, based on page 6, lines 11 to 17 of the parent application, it seems to be clear that the inspection of the film was not meant to be a second invention independent and separate from the first invention relating to the lamination of the film to a panel:

- "According to still further aspect of the present invention, in addition to the features described above, the method further comprises, before the step of cutting, a step of inspecting the presence or absence of a defect in the optical element strip, wherein the releasable liner is detached from a portion of the

optical element strip shortly before the inspection step is carried out, and the detached releasable liner or a new releasable liner is adhered to the portion of the optical element strip shortly after the portion of the optical element strip has subjected to the inspection step."

The underlined wording in the paragraph above indicates that the inspection process as presently claimed is merely a further aspect of the lamination process representing the actual invention disclosed in the parent application as filed.

The applicant's attention is also drawn to the sentence on page 23, line 7, of the parent application, introducing the description of the inspection process as presently claimed in terms of being merely a modification of the embodiment of the actual invention of the parent application: "The above embodiment of the present invention may be modified as follows", and not as a second, separate invention on its own.

The applicant's attention is further drawn to claim 7 of the parent application as filed defining an inspecting step. Since claim 7 of the parent application is dependent on claim 1 defining a method of laminating, the skilled person is taught that the inspecting step is actually a refinement of the method of laminating.

It follows that the parent application as filed does not seem to disclose an inspection process as a further invention separate from the method of laminating an optically functional film to a panel. As the inspection process is taught in the parent application as forming an integral part of the lamination process, the inspection process may not be claimed in the divisional application

separately from the method of laminating the film to the panel. See the decision T 341/06 (point 2 of the Reasons) where, in a similar case, the patent was also found to infringe Article 76(1) EPC for the reason that the subject-matter of claim 1 was not disclosed as an independent combination of features in the parent application.

6.3.4 Provisional conclusion

In view of the points 6.3.1 to 6.3.3 above, the parent application as filed appears to disclose steps for inspecting defects in a continuous optically functional film only as part of a method of laminating the film to an optical product panel. Present claim 1, however, does not define a method of laminating. It even lacks a method step of laminating.

Therefore, the board is of the preliminary opinion that present claim 1 infringes the requirement of Article 76 EPC.

6.4 *In the statement of grounds of appeal, the applicant merely states that it has responded to the objection raised by the examining division under Article 76(1) EPC "by introducing positive reference to the presence and use of a lamination unit where the film is cut into a sheet and is attached to a product panel member ...".*

This amendment does not help the applicant's case since, in the provisional view of the board, the method of claim 1 does not comprise a step of laminating the film to a panel (see points 6.3.1 and 6.3.2 above)."

V. *In response to the summons to oral proceedings, the applicant informed the board with its letter dated 26 May 2016 that it withdraws its request for oral proceedings. The*

applicant did not file any comments concerning the board's preliminary opinion as annexed to the summons.

VI. Following the applicant's letter of 26 May 2016, the oral proceedings were cancelled.

VII. Independent claim 1 of the appellant's main and sole request reads as follows:

" A method for inspecting for the existence of any defect in a continuous optically functional film (F) included in a continuous film laminate at least comprising a releasable film (S) attached to one of opposite surfaces of the continuous optically functional film by feeding the continuous film laminate through an inspection station (2), so as to make the inspected optically functional film usable in a laminating unit (5) for laminating the optically functional film to an optical product panel member (W), the method being characterized by comprising steps of:

removing the releasable film (S) from the continuous film laminate at a position before a position where the continuous film laminate reaches the inspection station;

introducing the optically functional film (F) or a laminate of the optically functional film and a protective film (P) into an inspection station (2) with the releasable film (S) removed therefrom, to carry out a defect inspection on the optically functional film;

if a defective area is detected in the optically functional film, calculating a position in coordinates of the defective area by a control device (9);

re-attaching a continuous releasable film (S2) to the first surface of the inspected continuous optically functional

film; and transferring the inspected continuous optically functional film having a continuous releasable film re-attached thereto to a lamination unit (5) where the inspected continuous optically functional film is cut into a sheet having a length corresponding to a size of a product panel member (W) to which the cut sheet of the optically functional film is to be attached, the releasable film (S2) is removed from the inspected continuous optically functional film, and then the cut sheet of the optically functional film is attached to the product panel member (W)."

Reasons for the Decision

1. In the communication annexed to the summons (see point IV. above), the board expressed its preliminary view, along with the underlying reasons, that the subject-matter of claim 1 extended beyond the content of the earlier application as filed (Article 76(1) EPC) and that the appellant's arguments in favour of inventive step, filed with the grounds of appeal, were not convincing.
2. The appellant neither attempted to rebut the board's provisional opinion, nor submitted any new requests aiming at overcoming the objections.

The board sees no reason to deviate from its preliminary opinion regarding compliance of the application with the requirements of Article 76(1) EPC, which therefore becomes final.

3. In essence, the board is of the view that the present method for inspecting an optical film is disclosed in the parent application as filed only as an integral part of a method for laminating the optical film (see point IV above, referring to point 6.3.3 of the summons to oral proceedings).

It follows that the present patent application does not meet the requirements of Article 76(1) EPC for the reasons set out in the board's preliminary opinion.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Kiehl

B. Müller

Decision electronically authenticated