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**D E C I S I O N**  
of 20 June 2002

**Case Number:** T 0736/99 - 3.5.2

**Application Number:** 92301933.5

**Publication Number:** 0502745

**IPC:** G11B 5/64

**Language of the proceedings:** EN

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

**Patentee:**  
TORAY INDUSTRIES, INC.

**Opponent:**  
Teijin Limited

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 56, 108, 114(2)  
EPC Rule 55(c)

**Keyword:**

Document representing prior art intervening between priority date and filing date, submitted in response to a first instance decision approving an amended patent with loss of priority, more than two years after expiry of term for filing statement of grounds of appeal - submitted in due time - (no) - sufficiently relevant to be admitted to proceedings - (yes).  
Remittal as requested auxiliarily by both parties - (yes).

**Decisions cited:**  
G 0002/98, T 0939/92, T 1002/92, T 0894/97

**Catchword:**  
-



Case Number: T 0736/99 - 3.5.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.2  
of 20 June 2002

**Appellant:**  
(Opponent)

Teijin Limited  
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**Representative:**

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**Respondent:**  
(Proprietor of the patent)

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**Representative:**

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**Decision under appeal:**

Interlocutory decision of the Opposition Division  
of the European Patent Office posted 19 May 1999  
concerning maintenance of European patent  
No. 0 502 745 in amended form.

**Composition of the Board:**

**Chairman:** W. J. L. Wheeler  
**Members:** R. G. O'Connell  
J. H. P. Willems

## Summary of Facts and Submissions

I. This is an appeal by the opponent as sole appellant from the interlocutory decision of the opposition division proposing to maintain European patent No. 502 745 in amended form.

II. The sole independent claim of the amended patent as approved by the opposition division is worded as follows:

"1. A laminated film having at least three layers, at least one of which layers is biaxially oriented and an outermost layer A of which contains

a) inorganic particles A in an amount within the range of 0.01 to 2% by weight, which inorganic particles are selected from zirconia, chain-like silica and alumina particles, have a ratio of the mean secondary particle size to the mean primary particle size of the particles A in the range of 2 to 60 and have a mean primary particle size D which is in the range 1 to 100 nm and satisfies the equation

$$D \leq T \leq 200 D$$

where T is the thickness of the layer A; and

b) particles B selected from calcium carbonate particles, crosslinked polymer particles and colloidal silica particles in an amount within the range of 0.005 to 5% by weight and having a mean primary particle size D1 which is in the range 0.3 to 2  $\mu\text{m}$  and a primary particle size distribution with a relative standard deviation of not greater than 0.6; and, in which outermost layer A,

c) the mean primary particle size D of the particles A is less than the mean primary particle size D1 of the particles B."

III. The following prior art documents from the proceedings before the opposition division remain relevant to the present appeal:

D1: EP-A-0 378 154

D2: EP-A-0 347 646

D3: JP-A-Hei 2-60 937.

In addition the following prior art documents were filed by the appellant in the course of the appeal:

D4: JP-A-3 90 329 (with full English translation)

D5: JP-A-3 121 136 (with partial English translation)

D6: JP-A-1 129 038 (with partial English translation)

D7: US-A-4 818 581

while

D8: GB-A-1 533 480

was filed by the respondent.

IV. In a communication dated 12 March 2002 accompanying a summons to oral proceedings fixed for 20 June 2002 the board noted that the respondent proprietor's reply to the statement of grounds of appeal had raised several pertinent questions in relation to the main issue on appeal, ie inventive step over the closest prior art document D1 combined with document D2, which merited

answers and invited the appellant opponent to comment on these points either by letter or at the forthcoming oral proceedings.

V. In a response dated 16 May 2002 the appellant opponent pointed out that the opposed patent claimed the priority of seven Japanese patent applications. He contended that the combination of features recited in claim 1 as approved by the opposition division in the decision under appeal was disclosed only in separate priority documents so that the effective priority date of this claim was the filing date of the application for a European patent, 6 March 1992. He accordingly submitted with his letter *inter alia* document D4 published 16 April 1991 as now relevant to the assessment of inventive step and arguments based thereon.

VI. By fax dated 14 June 2002 the respondent proprietor objected to the late filing of "a totally new opposition based on entirely new documents" and *inter alia* contested the assertion that D4 was more relevant than D1.

VII. Oral proceedings took place before the board on 20 June 2002.

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

(i) *Admissibility of prior art document D4*

D4 was admittedly late-filed. The reason for this lateness was simply that prior to receiving the summons to oral proceedings the appellant had not appreciated the now undisputed fact that the priority of claim 1 as approved by the opposition division in the decision

under appeal, which combined features from up to seven priority documents, was, following decision G 2/98 (OJ EPO, 2001, 413) of the Enlarged Board of Appeal, the filing date of the application. A search for prior art published in the priority interval had yielded D4, which was *prima facie* highly relevant in the sense of being likely to change the board's assessment of inventive step in relation to claim 1. Following the criteria set out in decision T 1002/92 (OJ EPO 1995, 605) it was an appropriate case for the board to exercise its discretionary power under Article 114(2) EPC to admit this relevant document to the proceedings and remit the case to the opposition division for further prosecution.

As regards the respondent proprietor's reliance on T 894/97 of 23 November 2001, it was to be hoped that the risk that evidence would be disregarded without examination as to its relevance would remain very small, since such a step would be contrary to the principles set out in T 1002/92. In T 894/97 the board did in fact consider the relevance of the late filed evidence; cf reasons 1.5.

- (ii) The relevance of D4 lay in the fact that it disclosed more features of claim 1 than D1, which had been regarded as closest prior art in the decision under appeal. It disclosed explicitly all features of claim 1 other than the agglomeration feature "*ratio of the mean secondary particle size to the mean primary particle size of the particles A in the range of 2 to 60*".
- (iii) In particular, D4 disclosed the combination of features of the T/D relation of the A particles and relative standard deviation of less than 0.6 of the B particles which the opposition division regarded as crucial in achieving the synergistic improvement of electromagnetic conversion and abrasion resistance and

which, in turn, were decisive in the opposition division's finding that the film specified in claim 1 involved an inventive step; cf decision under appeal at point 4.3.1.

- (iv) As regards the agglomeration feature mentioned above which was not explicitly disclosed in D4, the person skilled in the art would be led to choose particles conforming to this ratio by following completely routine considerations. The specification of the range 2-60 did not represent an inventive selection. Given that the A particles were specified in claim 1 as having an absolute diameter in the range 1 to 100 nm, it followed that the diameter of the secondary particles lay in the range 2 to 6 000 nm. But this upper limit was physically meaningless since it would imply secondary particles protruding from the film. Hence any technical effect which might be achieved by the teaching of claim 1 was not present over a large part of the claimed range and hence in that sense the film specified in claim 1 was not distinguished from D4 by any technical limitation. The principle enunciated in decision T 939/92 Triazoles / Agrevo (OJ EPO 1996, 309) that a technical effect relied on for inventive step must be plausibly obtainable substantially throughout the claimed range applied here. To argue, as the respondent proprietor had done, that the person skilled in the art could determine the effective boundary of claim 1 within the combination of large ranges specified was tantamount to admitting that the disclosure of D4 was sufficient to make a film in accordance with claim 1, which was indeed the appellant opponent's position. Hence claim 1 was obvious for the person skilled in the art over D4 alone.

- (v) The respondent proprietor's argument that D4 was not relevant because it allegedly related to a different manufacturing process was not cogent since the opposed

patent claims related to a product which did not reflect any special process steps. Furthermore the reaction which the respondent alleged to occur in the D4 process, viz an enveloping of the large particles by the small particles would not in technical fact take place, since this would result in a cross-linked mass.

IX. The respondent proprietor argued essentially as follows:

- (i) The hurdle for admission of new evidence at this late stage was an extremely high one; cf EPO Boards of Appeal jurisprudence as reviewed and confirmed in the recent decision T 894/97 of 23 November 2001 at points 1.2 to 1.4.
- (ii) In fact D4 was not all that relevant. It related to a different manufacturing process in which the A and B particles were added together to the slurry causing the smaller particles (designated "B" in D4) to "range continuously around" the larger particles (designated "A" in D4), ie to coat or envelop them; cf D4 (translation), page 6, lines 14 to 16; media dispersion was not applied and the melt was extruded at high temperature. By contrast, in the opposed patent and in the closest prior art D1 separate slurries were involved; media dispersion was applied (opposed patent, page 6, lines 34 to 36 - use of twin-screw extruder, melt extrusion at low temperature). Hence the concept of mean secondary particle size of aggregated particles was not applicable to D4.
- (iii) As to the argument that claim 1 of the opposed patent did not involve an inventive step over the whole range of the claim as in T 939/92 Triazoles / Agrevo (supra, VIII(iv)), the present case was distinguishable because the person skilled in the art would not combine values from the ranges for the respective parameters of the



claimed laminated film in an arbitrary way; his knowledge of the art would guide him in choosing those value combinations which would give a useable film and avoiding those which would not.

(iv) On the point of abrasion resistance it was important to realise that the opposed patent was concerned with a high speed process - of the order of 200 m/min - compared to speeds of the order of 4 m/min in D1 and D4. Hence the chipping resistance referred to in the latter documents was not comparable to the much higher standard of abrasion resistance achieved by the film claimed in the opposed patent.

X. The appellant opponent requested that the decision under appeal be set aside, that D4 be admitted into the proceedings and that the patent be revoked (main request) or that the case be remitted to the department of first instance for further prosecution (auxiliary request).

XI. The respondent proprietor requested that D4 not be admitted into the proceedings and that the appeal be dismissed (main request) or that the case be remitted to the department of first instance for further prosecution (auxiliary request).

### **Reasons for the Decision**

1. The appeal is admissible.

2. *Admissibility of prior art document D4*

2.1 The question whether document D4 should be admitted into the appeal procedure is the first issue to be considered. Given that both parties have made an auxiliary request for remittal to the opposition division in the event that this document is admitted this issue is potentially determinative of the appeal.

2.2 *"Due time" in relation to D4*

2.2.1 A significant aspect of this case in relation to the above issue is that the opposed patent has been substantially amended in the oral proceedings before the opposition division. Thus it is not a case where the appellant opponent could have been expected to submit the document in dispute within the nine-month opposition period. It was only after the opposition division had made the decision under appeal proposing to maintain the opposed patent in amended form in accordance with the proprietor's second auxiliary request that the effective priority date of the patent was undisputedly shifted to the filing date, thus giving rise to a new factual and legal situation outwith that defined by the original notice of opposition. It follows that if D4 had been submitted within the four-month period allowed under Article 108 EPC for filing the statement of grounds of appeal, it would have been submitted in due time within the meaning of Article 114(2) EPC as directly responsive and relevant to the decision under appeal and the board would have had no discretionary power under that subarticle to disregard it.

2.2.2 In fact D4 was submitted two years and eight months after expiry of the term set by Article 108 EPC. The professional representative of the appellant opponent admits that such a delay was inexcusable and states that the factual background was simply that he had taken over the case from the previous representative in

January 2002 and the realisation that the priority date had shifted to the filing date had only come to him when he studied the case in detail following receipt of the board's summons to oral proceedings dated 12 March 2002.

2.2.3 As the appellant opponent accepts unreservedly, a change of professional representative is not an objective excuse for delay. However the board does acknowledge that the fact that the amendment to claim 1 was such as to imply a shift of priority date was not something which was flagged in the decision under appeal. The opposition division is not to be criticised on this account, since there was no prior art document on file whose publication date fell between the filing date and the claimed priority date. Nor is there any requirement in the EPC that a patent proprietor should review, much less expressly abandon, a claim to priority as a consequential amendment following approval of an amended claim by the opposition division.

2.2.4 Nevertheless the fact remains that legally the opponent had constructive notice of the priority shift in the decision under appeal and a first submission of intermediate prior art in reaction thereto after the expiry of the four-month period for filing the statement of grounds of appeal has to be regarded as a late submission whose admission is a matter for the discretionary power of the board pursuant to Article 114(2) EPC.

2.3 *Exercise of discretion pursuant to Article 114(2) EPC*

2.3.1 The board has no reason to doubt the account given by the appellant opponent of the circumstances which caused the submission to be so late and would not characterise this history as pointing to an abuse of

procedure of the kind which might *ipso facto* preclude discretion being exercised in favour of the appellant.

- 2.3.2 The exercise of discretion pursuant to Article 114(2) EPC in opposition appeal proceedings is a matter of striking a balance between the values of procedural expediency and certainty on the one hand and legal closure within the centralised opposition system provided for in the EPC on the other. Generally the boards have applied the criteria of relevance and procedural complication to help resolve the conflict between these incommensurables, with the hurdle of relevance set higher the later the submission. In some recent decisions the criterion of complexity of the legal and technical issues raised by the late submission has been relied on as an additional or alternative criterion. The very considerable body of jurisprudence on this subject is reviewed in "Case Law of the Boards of Appeal of the European Patent Office", 4th edition 2001 at Section VI F.
- 2.3.3 In the judgement of the board D4 is sufficiently relevant in relation to the issue of inventive step for it to be admitted into the opposition appeal procedure despite being submitted late. At the same time the respondent proprietor has made submissions in reply which are sufficient to persuade the board that the latter's request for remittal is justified. The appellant opponent concurs with this request.
- 2.3.4 The board refrains from giving detailed reasons for its finding as to the relevance of D4, since such reasoning would risk prejudicing the first instance consideration which is ordered below. It confines itself to observing that the appellant opponent's argument that D4 was closer prior art than D1 in view, *inter alia*, of its disclosure of the feature of a primary particle size distribution with a relative standard deviation of less

than 0.5, was persuasive, given the weight accorded to this feature in the reasoning of the decision under appeal at point 4.3.1. Thus D4 is not only, albeit late, responsive to the decision under appeal in the sense of reacting to a priority change produced by that decision, but also has the potential to promote convergence of the debate on inventive step.

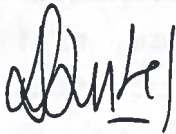
- 2.3.5 The appellant opponent maintains that D4 and the attack on inventive step based thereon clears the high hurdle of "*prima facie* highly relevant" in the sense of T 1002/92, ie highly likely to prejudice maintenance of the patent. It has to be borne in mind, however, that the T 1002/92 hurdle relates to new evidence outwith the legal and factual framework established by the statement pursuant to Rule 55(c) EPC in relation to the unamended patent and may therefore be too exigent in the circumstances of this case; cf 2.2.1 above. For the avoidance of doubt, the board emphasises that it has deliberately left open the question of whether the latter criterion is met by D4.

**Order**

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

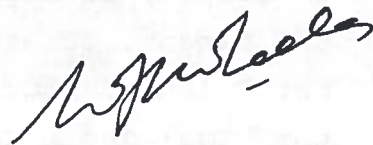
1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:



D. Sauter

The Chairman:



W.J.L. Wheeler