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D E C I S I O N
of 4 December 2003

Case Number: T 0297/01 - 3.2.5

Application Number: 95116882.2

Publication Number: 0709223

IPC: B41M 5/00

Language of the proceedings: EN

Title of invention:
Recording medium, and image forming method and printed material making use of the same

Patentee:
CANON KABUSHIKI KAISHA

Opponent:
DEGUSSA AG

Headword:
-

Relevant legal provisions:
EPC Art. 87(1)

Keyword:
"Entitlement to priority - no"
"Remittal to the first instance for further prosecution"

Decisions cited:
G 0010/91, G 0002/98, T 0223/95

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0297/01 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 4 December 2003

Appellant: (Opponent)
DEGUSSA AG
Benningsenplatz 1
D-40474 Düsseldorf (DE)

Representative:
Weber, Wolfgang, Dr
Degussa AG
Intellectual Property Management Patente und Marken
Postfach 13 45
D-63403 Hanau (DE)

Respondent: (Proprietor of the patent)
CANON KABUSHIKI KAISHA
30-2, 3-CHOME, Shimomaruko,
Ohta-ku
Tokyo (JP)

Representative:
Leson, Thomas Johannes Alois, Dipl.-Ing.
Patentanwälte
Tiedtke-Bühling-Kinne & Partner,
Bavariaring 4
D-80336 München (DE)

Decision under appeal:
Decision of the Opposition Division of the European Patent Office posted 12 February 2001 rejecting the opposition filed against European patent No. 0709223 pursuant to Article 102(2) EPC.

Composition of the Board:

Chairman: W. Moser
Members: H. M. Schram
W. Widmeier

Summary of Facts and Submissions

I. The appellant (opponent) appealed against the decision of the Opposition Division rejecting his opposition against European patent No. 0 709 223. The opposition was filed against the patent in suit as a whole.

The Opposition Division held that the opposition was admissible (Rule 56 EPC). In particular, the Opposition Division was of the opinion that the facts and arguments presented in the notice of opposition "enable the reader to understand sufficiently why the claimed subject-matter was considered to lack novelty and inventive step", so that the requirements of Rule 55(c) EPC were found to be met.

II. In his notice of appeal, the appellant referred for the first time to document EP-A 622 244 (D5), which was filed before the first priority date of the patent in suit, but published after said date, and submitted that the subject-matter of claim 1 of the patent in suit lacked novelty with respect to this document.

III. Oral Proceedings were held before the Board of Appeal on 4 December 2003.

IV. The appellant requested that the decision under appeal be set aside and that the patent in suit be revoked in its entirety.

The respondent (patent proprietor) requested that the appeal be dismissed.

V. Claim 1 of the patent in suit as granted reads as follows:

"1. A recording medium comprising a base material (1) and an ink-receiving layer (2) thereon containing a pigment including aggregated particles (4) having a diameter of from 0,5 to 50 µm and a binder, characterized in that said ink-receiving layer has a ratio of BET specific surface area to pore volume, as determined by the nitrogen adsorption-desorption method, within the range of from 50 to 500 m^2/ml."

Claim 1 is followed by dependent claims 2 to 18, which relate to particular embodiments of the recording medium according to claim 1. Independent claims 19 and 22, which refer to the "recording medium according to any one of claims 1 to 18", relate to an image forming method and a printed material, respectively,

VI. The appellant argued essentially as follows:

The objection of lack of novelty raised in the statement of grounds of the appeal was not a fresh ground for opposition, since this ground had been substantiated in the notice of opposition.

The patent in suit claimed a first priority of 27 October 1994 and a second priority of 12 September 1995 of the Japanese patent applications JP 263715/94 (P1) and JP 233982/95 (P2), respectively. However, the patent in suit was not entitled to the first priority date, since the feature "containing a pigment including aggregated particles (4) having a diameter of from 0,5 to 50 µm" of claim 1 of the patent in suit was not

disclosed in document P1. The particle diameters given in Table 1 of the English translation of document P1 (see paragraph [0087]) represented individual points in the range from 10 to 30 µm and could not be considered to form a disclosure of the range from 0,5 to 50 µm. Moreover, these particle diameters seemed to be missing in the corresponding Table of the original Japanese document P1. Consequently, document D5 represented a state of the art pursuant Article 54(2) EPC and could be cited against the subject-matter of claim 1 of the patent in suit, both under Article 54 and Article 56 EPC.

VII. The respondent argued essentially as follows:

The ground for opposition "lack of novelty" was raised in the appeal proceedings for the first time. Apart from an introductory statement in the notice of opposition, viz. "The subject-matter of the patent in suit is neither novel nor inventive", the arguments that were submitted in said notice of opposition only dealt with inventive step. A fresh ground for opposition was a ground for opposition that was not properly submitted and substantiated in the notice of opposition. In the present case the ground for opposition "lack of novelty" was thus a fresh ground. No consent was given to introducing this new ground for opposition, cf. G 10/91 (OJ EPO 1993, 420, point 3 of the Opinion). That novelty was discussed in the decision under appeal (cf. point 6 of the reasons) could not give rise to a different interpretation. This merely showed that the Opposition Division had introduced this ground for opposition of its own motion.

The priority document P1 stated in paragraph [0043] (see the English translation) that it was "particularly preferable to use alumina hydrates disclosed in Japanese Patent Applications No. 5-125437, No. 5-125438, No. 5-125439 and No. 6-114571". The issue of priority could only be decided after examination of these Japanese patent applications, since (one of) these applications might disclose the range of particle diameters specified in claim 1 of the patent in suit.

Reasons for the Decision

1. *Fresh ground for opposition*

In the present case novelty was examined by the Opposition Division in the decision under appeal, as admitted by the respondent.

It follows that "lack of novelty" is not a fresh ground introduced at the appeal stage within the meaning of the Opinion G 10/91 of the Enlarged Board of Appeal, point 18 of the Reasons, which could only be considered by the Board with the approval of the respondent.

2. *Priority*

2.1 The application on which the patent in suit is based was filed on 26 October 1995. A first priority of 27 October 1994 by virtue of the Japanese patent application JP 263715/94 (P1) is claimed in respect of the patent in suit. In addition, a second priority of 12 September 1995 by virtue of the Japanese patent

application JP 233982/95 (P2) is claimed in respect of the patent in suit.

Document D5 is a European patent application which was filed in the name of the respondent on 27 April 1994 and was published on 2 November 1994. It relates to a recording medium comprising a base material and an ink-receiving layer containing a pigment and a binder which is provided on said base material (see page 3, lines 53 to 55), and is thus *prima facie* highly relevant.

If the patent in suit is entitled to the first priority date, document D5 is a state of the art under Article 54(3) EPC, in which case the content of this document can only be considered for the purpose of assessing novelty, cf. Article 56, second sentence. Conversely, if the patent in suit is not entitled to the first priority date, document D5 is a state of the art under Article 54(2) EPC and may also be considered when assessing inventive step.

2.2 In accordance with Opinion G 2/98 (OJ EPO 2001, 413) of the Enlarged Board of Appeal it follows that the priority of document P1 of claim 1 of the patent in suit is to be acknowledged only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from document P1 as a whole.

The English translation of document P1 is silent about the range for the diameter of the aggregated particles specified in claim 1 of the patent in suit. The only reference to diameters of the aggregated particles in this document can be found in row 9 of Table 1

containing particle diameters of six different pigments (see paragraph [0087] at page 28). This Table is reproduced at page 10, lines 35ff, of the patent in suit and corresponds also to Table 1 of the English translation of document P2 (see paragraph [0098] at page 33). However, whereas Table 1 of document P2 has ten rows, Table 1 of document P1 only comprises the first eight rows (the last two rows containing the particle diameters and the zeta potential are missing). The translations of the priority documents were filed by the appellant pursuant to Article 88(1) EPC and Rule 38(5) EPC on 22 June 1998. The examination file contains a declaration from a Japanese patent attorney dated 17 June 1998, stating that both documents have been translated by this attorney. It thus appears that Table 1 of the English translation of document P1 has been erroneously taken from the English translation of document P2.

But even if the Board were to assume, to the advantage of the respondent, that the English translation of document P1 is a true and correct translation of the latter, the six particle diameters given in Table 1, viz. 30, 26, 16, 12, 10 and 20 µm, could not be considered to disclose the range "from 0,5 to 50 µm" as defined in claim 1. Moreover, Table 1 lists the physical properties of an ink-receiving layer, wherein particular pigments, viz. alumina hydrates, have been used.

The respondent acknowledged that Table 1 cannot be considered disclosing the range of the particle diameters as specified in claim 1 of the patent in suit. He has submitted however that paragraph [0043] of

the English translation of document P1 could form a basis for the feature "containing a pigment including aggregated particles (4) having a diameter of from 0,5 to 50 µm", if one of the cross-referenced documents cited in said paragraph was found to disclose said feature. This paragraph, which corresponds to the passage at page 5, lines 21 to 23, of the patent in suit, reads: *The alumina hydrate preferable for the working of the present invention includes alumina hydrates that prove noncrystal when analyzed by X-ray diffraction, and it is particularly preferable to use alumina hydrates disclosed in Japanese Patent Applications No. 5-125437, No. 5-125438, No. 5-125439 and No. 6-114571*.

It may be noted, however, that claim 1 of the patent in suit is not restricted to a recording medium containing a pigment made from alumina hydrates. Even if the passage cited above disclosed the range for the particle diameter, it still would not disclose the subject-matter of claim 1 of the patent in suit as a whole, i.e. a recording medium containing any pigment satisfying the remaining requirements of the claim. For this reason alone the argument of the respondent must fail. In addition it may be noted that in general cross-references to other documents in a patent application cannot be taken into account for the purpose of deciding whether the subject-matter of a claim is *directly and unambiguously*, using common general knowledge, derivable from said patent application.

It follows from the above that the skilled person cannot derive the subject-matter of claim 1 of the patent in suit from document P1.

2.3 In the judgement of the Board, the first priority of 27 October 1994 by virtue of document P1, claimed in respect of the patent in suit, cannot be acknowledged. Consequently, document D5 is *prior* art within the meaning of Article 54(2) EPC.

3. Taking into consideration that the new document D5 amounts to a fresh case against the patent in suit, the Board considers it appropriate to make use of its discretionary powers under Article 111(1) EPC and to remit the case to the Opposition Division for further prosecution (see decision T 223/95 of 4 March 1997, not published in the OJ EPO, point 5 of the Reasons).

Order

For these reasons it is decided that:

1. The decision under appeal be set aside

2. The case is remitted to the Opposition Division for further prosecution.

The Registrar: The Chairman:

R. Schumacher W. Moser