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D E C I S I O N
of 11 April 2005

Case Number: T 0892/03 - 3.3.3

Application Number: 95930021.1

Publication Number: 0787759

IPC: C08J 5/14

Language of the proceedings: EN

Title of invention:

Wet rubbing material and method of manufacturing same

Applicant:

NSK-WARNER KABUSHIKI KAISHA

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 113(1)

EPC R. 67

Keyword:

"Rejection based on new claims - substantial procedural violation"

"Remittal to the first instance"

"Reimbursement of the appeal fee (yes)"

Decisions cited:

T 0316/95

Catchword:

-



Case Number: T 0892/03 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 11 April 2005

Appellant:

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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 27 March 2003
refusing European application No. 95930021.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R. Young
Members: C. Idez
E. Dufrasne

Summary of Facts and Submissions

- I. European patent application No. 95 930 021.1, based on International application No. PCT/JP95/01737, filed on 31 August 1995, claiming the priority of two earlier patent applications in Japan, was published under No. WO-A-96/37538 (EP-A-0 787 759) on 28 November 1996.
- II. The first communication of the Examining Division was issued on 18 May 2001 and was based on Claims 1 to 26 as originally filed.

Claim 1 read as follows:

"A wet friction material including fibrous base materials such as natural pulp fibers and organic synthetic fibers, fillers such as diatomaceous earth, a friction adjustment agent such as cashew resin, and a binder such as thermosetting resin, characterized in that:

the concentration of an excessive binder formed in the outer most surface layer which is expressed by a ratio (A/B) in the range of 0.85 to 1.15 where a binder concentration from the surface to a depth of 10 μ m is A and a binder concentration from a depth of 10 μ m to a depth of 100 μ m is B, wherein the surface is not subjected to any of sliding, cutting, machining, abrasion, and carbonization."

- III. In its communication the Examining Division stated that documents D1 (EP-A-0 231 098) and D2 (JP-A-6 173 983) both disclosed wet type friction materials comprising a fibrous material, a friction modifier, a filler, and a

binder, i.e. that they disclosed all four constituents of the material according to Claim 1. The Examining Division further held that the remaining feature, i.e. the ratio A/B was not explicitly disclosed in D1 and D2.

The Examining Division took the view that in absence of any information to the contrary, it would be expected that a ratio of about 1 would also be included in the prior art. Thus, the Examining Division stated that, unless the Applicant could demonstrate that this feature was not present in the compositions disclosed in D1 and D2, it would not serve to establish novelty.

The Examining further held that the ratio A/B was a definition by a result to be achieved, but that there was a lack of essential features in Claim 1 which ensured that this ratio was fulfilled.

IV. With its letter dated 16 November 2001, the Applicant submitted a new set of claims 1 to 22.

Claim 1 read as follows:

"A wet friction material including fibrous base materials, fillers, a friction adjustment agent, and a binder, characterized in that the concentration of an excessive binder formed in the outermost surface layer which is expressed by a ratio (A/B) in the range of 0.85 to 1.15 where a binder concentration from the surface to a depth of 10 μ m is A and a binder concentration from a depth of 10 μ m to a depth of 100 μ m is B, wherein a ratio of an apparent area to a true contact area is more than 20% when measured in oiled environment, and wherein the surface is not subjected

to any of sliding, cutting, machining, abrasion, and carbonization."

The Applicant argued that the subject-matter of new Claim 1 was not disclosed in the prior art and hence was new.

- V. In its communication dated 21 January 2002, the Examining Division stated that the new parameter (i.e. "wherein a ratio of an apparent area to a true contact area is more than 20% when measured in oiled environment") was not comparable with D1 or D2. It was thus not acceptable to distinguish the invention from the prior art. Consequently, the Examining Division maintained its objection of lack of novelty. The Examining Division further held that this parameter was not clear.

The Examining Division told the Applicant that, if claims were maintained in which the only features not present in the prior art were new parameters, and if the Applicant did not demonstrate that these parameters were not present in the prior art, the application would be refused.

- VI. With its letter dated 30 July 2002, the Applicant submitted a new set of Claims consisting of a new Claim 1 and of Claims 2 to 19 corresponding to Claims 5 to 22 as filed with its letter of 16 November 2001. Claim 1 read as follows:

"A wet friction material including fibrous base materials, fillers, a friction adjustment agent, and a binder, wherein the concentration of an excessive

binder formed in the outermost surface layer which is expressed by a ratio (A/B) in the range of 0.85 to 1.15 where a binder concentration from the surface to a depth of 10 μ m is A and a binder concentration from a depth of 10 μ m to a depth of 100 μ m is B, wherein the surface is not subjected to any of sliding, cutting, machining, abrasion, and carbonization, and wherein the friction material has a smoothness in which an Abbot load curve has more than 90% of a relative load length in the range of the surface to a depth of 14 μ m as well as a plateau ratio is less than 6 μ m at a difference between slicing levels in the range of 5 to 60% of the relative load length of an Abbot load curve; and when the friction material is in a dried state, a Young's modulus which is a ratio of vertical stress and longitudinal stress in the vertical direction is in the range of 83.3 MPa to 25 MPa when a surface pressure at ordinary temperature is less than 0.25 MPa, and the Young's modulus is in the range of 250 MPa to 375 MPa when a surface pressure at ordinary temperature is in the range of 0.25MPa to 1MPa."

The Applicant submitted that it had not been able to obtain samples from the materials disclosed in D1 and D2. It also argued that it was the Examiner's duty to find out whether or not the claimed subject-matter was novel. As long as the state of the art did not comprise anticipatory disclosure a claimed invention should be regarded as novel. In that respect, the wet friction material of the prior art had a high concentration binder layer formed at the outermost layer of the friction material surface. In the friction materials according to the present invention, the binder concentration was uniform between the surface and the

inside. This was reflected by the ratio A/B in the range 0.85 to 1.15. Furthermore, the Abbot load curve, the Young modulus of the friction of the claimed friction material indicated new characteristics of the friction material. Thus, the subject-matter of Claim 1 was novel.

VII. With its decision dated 27 March 2003, the Examining Division refused the application on the grounds of lack of novelty of the subject-matter of Claim 1 as submitted by the Appellant with its letter dated 30 July 2002.

The decision stated that the Applicant had had two opportunities to comment on the objection to lack of novelty and that the intention to refuse Claim 1 if characterised solely by parameters had been communicated to the Applicant. Hence, according to the decision the requirements of Article 113(1) EPC were fulfilled. The decision held that the only remaining features which were not explicitly disclosed in the prior art (D1, D2) were new parameters which were not comparable with the prior art. It further stated that the parameters introduced with the last response of the Applicant (i.e. Abbot load curve, plateau ratio and Young's modulus) were obscure and added nothing to the disclosure of Claim 1 as originally filed, and that none of the parameters present in Claim 1 were regarded as adequately defined in order to establish novelty.

VIII. A Notice of Appeal against the decision was lodged on 4 June 2003 by the Appellant (Applicant) with simultaneous payment of the prescribed fee. With the Statement of Grounds of Appeal filed on 5 August 2003,

it submitted a set of Claims 1 to 16 as new main request. The Appellant requested that the decision of the Examining Division be set aside and a patent be granted on the basis on this set of claims and, as an auxiliary request, that oral proceedings should be summoned.

IX. In a communication dated 29 October 2004, the Board informed the Appellant of its intention to set aside the decision of the Examining Division, to remit the case to the first instance for further prosecution, and to order a reimbursement of the appeal fee (paragraph 1.13 of the communication). The Appellant was further invited to reconsider its request for oral proceedings.

X. With its letter dated 3 March 2005, the Appellant requested:

(i) that the decision of the Examining Division be set aside;

(ii) that the case be remitted to the first instance for further prosecution on the basis of Claims 1 to 19 filed on 30 July 2002 as main request, or alternatively on the basis of Claims 1 to 16 submitted with the Statement of Grounds of Appeal on 5 August 2003 as auxiliary request; and

(iii) that the appeal fee be refunded.

It further indicated that it waived its request for oral proceedings provided the Board would accept these requests.

Reasons for the decision

1. The appeal is admissible.
2. *Procedural matters*
 - 2.1 As can be seen from paragraphs II, IV and VI above, Claim 1, filed with the letter of 30 July 2002 of the Applicant, differs from original Claim 1 and from Claim 1 as submitted with letter of 16 November 2001, in particular, in that parameters concerning the Abbot curve, the plateau ratio and the Young modulus of the wet friction material have been incorporated therein.
 - 2.2 It thus follows from these considerations that Claim 1 of the set of the claims on which the decision was based presented substantial differences with respect to Claim 1 of the respective sets of claims which were the basis of the first and second communication of the Examining Division.
 - 2.3 These substantial differences were also reflected in the reasoning which led to the conclusion of lack of novelty in the contested decision, since it was stated that the parameters Abbot load curve, plateau ratio and Young's modulus were obscure and added nothing to the disclosure of Claim 1 as originally filed, and that none of the parameters present in Claim 1 were regarded as adequately defined in order to establish novelty. The Board, however, notes these reasons have never been communicated before to the Applicant.

2.4 This conclusion cannot be altered by the general statement made in paragraph 3 of the communication of 21 January 2002 of the Examining Division (cf. Section VI above), which can at most have represented a warning to the Applicant, but which cannot evidently have given the **specific** reasons why the set of claims filed with the letter of 30 July 2002 does not meet the requirements of Article 54 EPC.

2.5 According to Article 113(1) EPC, decisions of the EPO may only be based on grounds on which the party concerned has had an opportunity to comment. In the present case, it is, however, evident that the Appellant did not have an opportunity to present its comments with regard to the grounds of refusal of the amended claims submitted with the letter of 30 July 2002.

2.6 Consequently, this failure to comply with the procedural requirements of Article 113(1) EPC clearly amounts to a substantial procedural violation. Thus, the contested decision must be set aside and, in accordance with the express request of the Appellant (cf. Section X above), the Board remits the case back to the Examining Division for further prosecution on the basis of Claims 1 to 19 filed with the letter of 30 July 2002 (main request) or alternatively on the basis of Claims 1 to 16 submitted with the Statement of Grounds of Appeal on 5 August 2003 (auxiliary request).

2.7 Since this failure to comply with the procedural requirements of Article 113(1) EPC also constitutes a substantial procedural violation within the meaning of Rule 67 EPC, the reimbursement of the appeal fee is

equitable in the present circumstances (cf. also T 316/95 of 30 July 1999, not published in OJ EPO).

- 2.8 The requests of the Appellant (cf. Section X above) being allowable, there is thus no need to hold oral proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution on the basis of Claims 1 to 19 filed with the letter of 30 July 2002 (main request) or alternatively on the basis of Claims 1 to 16 submitted with the Statement of Grounds of Appeal on 5 August 2003 (auxiliary request).
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

E. Görgmaier

R. Young