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**Datasheet for the decision
of 30 April 2008**

Case Number: T 0367/05 - 3.3.09

Application Number: 95111937.9

Publication Number: 0679509

IPC: B32B 27/20

Language of the proceedings: EN

Title of invention:
Biaxially oriented laminated film

Patentee:
TORAY INDUSTRIES, INC.

Opponent:
Mitsubishi Polyester Film GmbH

Headword:

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Relevant legal provisions:

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Relevant legal provisions (EPC 1973):

EPC Art. 76(1), 100(c), 123(2)

Keyword:

"Extension of the claimed subject-matter beyond the content of the earlier application as filed"

Decisions cited:

T 0514/88, T 0201/83, T 1067/97, T 0714/00, T 0025/03

Catchword:

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Case Number: T 0367/05 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 30 April 2008

Appellant: TORAY INDUSTRIES, INC.
(Patent Proprietor) 2, Nihonbashi-Muromachi 2-chome
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Respondent: Mitsubishi Polyester film GmbH
(Opponent) Rheingaustrasse 190-196
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Representative: Zounek, Nikolai
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 20 January 2005
revoking European patent No. 0679509 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Kitzmantel
Members: N. Perakis
W. Sekretaruk

Summary of Facts and Submissions

I. Mention of the grant of European patent No 0 679 509 in respect of European patent application No 95111937.9 in the name of TORAY INDUSTRIES, INC., which had been filed on 28 July 1995 as a divisional application to the earlier application 89110301.2/0 347 646 in accordance with Article 76 EPC and was thus considered to be entitled to the filing date of 7 June 1989, was announced on 2 February 2000 (Bulletin 2000/05). The patent, entitled "Biaxially oriented laminated film", was granted with four claims. The sole independent product Claim 1 reads as follows:

"1. A biaxially oriented laminated film comprising:
a first layer containing a first thermoplastic resin as a major constituent; and
a second layer containing a second thermoplastic resin as a major constituent, which is formed on at least one surface of the first layer, the second layer containing inert particles with an average diameter of 0.1 to 10 times the thickness of the second layer, the content of the inert particles in the second layer being at least 0.4 but less than 0.5% by weight, the thickness of the second layer being 0.005 - 3 μm and wherein the second thermoplastic resin is a crystalline polyester and the crystallization index of attenuated total reflection Raman of the surface of the second thermoplastic resin is not more than 20 cm^{-1} ."

Claims 2 to 4 were directly dependent on Claim 1.

II. Opposition was filed against the patent by Mitsubishi Polyester Film GmbH on 2 November 2000. The Opponent

requested the revocation of the patent in its full scope, relying on Article 100(a) (lack of novelty and lack of inventive step) and 100(c) EPC 1973 (extension of the subject-matter of the European patent beyond the content of the application as filed: Article 123(2) EPC 1973).

A first oral proceedings were held on 1 April 2003 during which the Opposition Division on its own motion raised a further ground of opposition under Article 100(c) EPC 1973, namely that the subject-matter of the European patent, which was granted on a divisional application, extended beyond the content of the earlier application as filed (Article 76(1) EPC 1973).

III. By its decision orally announced at a second oral proceedings held on 17 December 2004 and issued in writing on 20 January 2005 the Opposition Division revoked the patent.

The Opposition Division held in the appealed decision that granted Claim 1 of the patent in suit did not fulfil the requirements of Article 76(1) EPC 1973.

According to the Opposition Division the claimed feature "the content of the inert particles in the second layer being **at least 0.4 but less than 0.5** % by weight" did not find support in the earlier (parent) application as filed, which, in contrast, disclosed that that content was **0.5 to 50** % by weight".

With regard to the value of **0.4 % by weight**, disclosed in relation to a comparative example (Comparative

Example 3), the Opposition Division considered that a comparative example did not provide support for an amended range since it did not form part of the "whole disclosure of the alleged invention". Furthermore, it pointed out that the claimed "biaxially oriented film" was disclosed to satisfy the three criteria of: scratching resistance, dubbing resistance and friction coefficient. The Comparative Example 3 by satisfying only one of those criteria did not relate to the disclosure of the claimed invention.

IV. On 17 March 2005 the Patent Proprietor (Appellant) lodged an appeal against the decision of the Opposition Division and paid the appeal fee on the same day.

With the Statement setting out the Grounds of Appeal filed on 9 May 2005, the Appellant refuted the conclusions of the Opposition Division. It essentially argued that the basis for its amendments was the content of the earlier patent application as filed, which was the "total information content of the disclosure" according to decision T 514/88 (OJ, 1992, 570). Therefore the value of 0.4% by weight, which was stated *expressis verbis* on page 14, Table 1, of the earlier application, was undeniably part of the content of its disclosure. The Appellant further argued that the EPC did not require that something had to be specifically described as part of the invention and that the term "content" left completely open in which form the subject-matter might be described. Thus technical information in the earlier application in form of comparative examples could be the basis for a later divisional application.

- V. With the letter dated 23 October 2007 the Opponent (Respondent) informed the Board that it would not attend the forthcoming oral proceedings and requested a decision according to the state of the file.
- VI. The Board in its communication dated 6 December 2007 expressed the provisional opinion that the patent was correctly revoked by the Opposition Division under Article 100(c) in combination of Article 76(1) EPC 1973. The Board considered that the **value range** of the inert particle content in the second layer of the biaxially oriented film (layer A) being at least 0.4 but less than 0.5% by weight did not find support in the earlier application as filed.
- VII. In the letter dated 12 February 2008 the Opponent (Respondent) argued that the divisional application as filed did not disclose an inert particle content of less than 0.5% by weight with the consequence that the claimed subject-matter relating to an inert particle content ranging from 0.4 to less than 0.5% by weight contravened the requirements of Article 123(2) EPC 1973.
- VIII. Oral proceedings were held before the Board on 30 April 2008 in the absence of the Opponent (Respondent). At those proceedings the Patent Proprietor filed as a further request the following question to be referred to the Enlarged Board of Appeal:
- "Can a range of a feature of the claim be based on an example which had been denominated "comparative example" in the original application of the parent application?"

At these proceedings the Board further contested the claimed subject-matter under Article 76(1) EPC 1973 for the reason that the isolated extraction from the definition of the biaxially oriented film according to Comparative Example 3 of the value "at least 0.4% by weight" corresponding to the concrete inert particle content in layer A of that film and its generalisation by insertion of that value into the subject-matter of granted Claim 1 as lower limit of the inert particle content range found no support in the earlier application as filed.

IX. The relevant arguments presented by the Appellant in its written submissions and at the oral proceedings may be summarized as follows:

- The Opposition Division has wrongly revoked the patent under Article 100(c) EPC in combination with Article 76(1) EPC 1973, based on the consideration that the lower value of the claimed range for the inert particle content in layer A, namely 0.4% by weight did not find support in the earlier (parent) application as filed.
- In view of T 514/88 the value of 0.4% by weight was part of "the content" of that earlier application, because it was stated *expressis verbis* on page 14, Table 1, of the published version of the earlier application. Therefore Article 76(1) EPC 1973 was not contravened.
- Furthermore, the "content" of the earlier application had to be understood in its literal meaning, namely "the whole content" of the earlier application, since there was no requirement in Articles 76(1) and 100(c) EPC 1973 that something

had to be described specifically as part of an invention.

- The term "content" left it completely open in which form the subject-matter might be described. So, it left open the possibility, that the content of an earlier application, in addition to one or more inventions described, contained additional technical information.
- As Article 76(1) EPC 1973 did not state at all that the content of the earlier application, which formed the basis for the divisional application had to be described as being an invention, the technical information provided in the earlier application in the form of comparative examples was relevant information which could be the basis for a later divisional application.
- Additionally the characterisation of examples as "according to the invention" or as "comparative examples" did not provide a qualifying distinction of the technical information of the application. It was commonly accepted practice that examples according to the invention became comparative examples during the examination or opposition phase of an application/patent in view of relevant state of the art. Therefore the naming of the technical information "example" or "comparative example" was irrelevant and only the content of the "finally claimed subject-matter" was decisive for that delimitation.
- In the present case, the inert particle content value of 0.4% by weight was disclosed for Comparative Example 3. This example should be considered as additional technical information, which formed part of the content of the earlier

application and which could serve as basis for a divisional application.

- The properties of Comparative Example 3, as far as the friction coefficient and the scratch resistance were concerned, were disclosed to be "not good", whereas as far as dubbing resistance was concerned, it was disclosed to be "excellent".
- Consequently a skilled person in the art reading the technical information of the earlier application and being interested in the first place in the property "dubbing resistance" while having less interest in the other properties would receive all the necessary information to accomplish this embodiment from Comparative Example 3 including the manner of its manufacture.
- Anyway, there was no basis in the EPC to deprive an applicant from the possibility to make that technical information, which was made available to the public by himself, part of a divisional application. On the contrary, the applicant should have the possibility to prosecute this information, he has provided, in the form of a divisional application.
- With regard to the objections raised by the Board, the extraction and generalisation of the value 0.4% by weight from Comparative Example 3 of the earlier application as filed was allowable.
- According to standard case law, values from the examples can be taken to redefine claimed value ranges.
- In the present case the value of 0.4% by weight was the lowest inert particle content with still excellent dubbing resistance (earlier application as published, page 15, table 1). It was thus allowable

to use this value in order to define the lowest particle content in the claimed subject-matter.

- Furthermore the value of 0.4% by weight could be taken in isolation from that Comparative Example since the technical evidence of the earlier patent as published (page 14, table 1, Example 1, Comparative Examples 3 and 4) showed that the inert particle content varied independently from the other parameters of the film, namely the thickness of layer A and the ratio of average particle size/ thickness of layer A.
- In consequence, it was allowable to extend the range of the inert particle content in layer A from 0.5 to 50% as claimed in the parent application down to 0.4% by weight and to define - by exclusion of the afore-mentioned range of the parent application - the currently claimed range of 0.4 to less than 0.5% by weight.

X. The sole argument presented by the Respondent in its written submissions may be summarized as follows:

- According to granted Claim 1, the content of the inert particles in the second layer of the biaxially oriented film, ie layer A, was from 0.4 to less than 0.5% by weight, whereas this was from 0.4 to 50% by weight according to the originally filed (divisional) application. Therefore the upper limit of the claimed range "less than 0.5 % by weight" found no support in the originally filed divisional application with the consequence that the subject-matter of Claim 1 did not fulfil the requirements of Article 123(2) EPC 1973.

XI. The Appellant (Patent Proprietor) requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for deciding on the ground of opposition under Article 100(a) EPC 1973.

It further requested to refer a question to the Enlarged Board of Appeal.

XII. The Respondent (Opponent) requested in writing that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

2. Support by the earlier application as filed (Articles 100(c) and 76 EPC 1973)

2.1 Article 100(c) concerns more than one ground for opposition, from which the relevant one for the present case is that relating to the extension of the subject-matter of a European patent granted on a divisional application, beyond the content of the earlier application as filed. This ground for opposition corresponds to the requirement for the filing of a divisional application under Article 76(1) EPC 1973, that it may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed.

2.2 With regard to the patent in suit (granted on a divisional application), Article 100(c) in combination

with Article 76(1) EPC 1973 is relevant for the subject-matter of Claim 1 as far as the following disputed feature is concerned:

"the content of the inert particles in the second layer being at least 0.4 but less than 0.5% by weight".

2.3 Turning to the earlier application (the parent application) published as EP 0 347 646, the Board remarks that - as far as the description of the claimed invention is concerned - its disclosure is limited to a content of inert particles in the second layer, namely layer A, ranging from 0.5 to 50% by weight in its broadest definition (page 2, lines 46-47; page 3, line 58 to page 4, line 1). Preferred narrower ranges are also disclosed such as 1-30% by weight and 2-15% by weight (page 3, line 58 to page 4, line 1).

Thus the Board can only conclude that - as far as the there claimed invention is concerned - the currently claimed range of at least 0.4 but less than 0.5% by weight for the content of inert particles in the second layer does not find support in the earlier application as filed.

As set out below there is also no further information in the earlier application which would justify the dividing out of a range of from 0.4 to less than 0.5%.

2.4 In the latter respect the Board rejects the assertions of the Appellant:

(i) that the value of 0.4% by weight can be extracted in isolation from the technical evidence of the earlier

application as filed, namely from Comparative Example 3, on the one hand because this is standard practice and on the other hand because the inert particle content in the second layer varies independently from the other parameters used to define the claimed biaxially oriented film,

(ii) that this value could be used to extend the value range of 0.5 to 50% by weight to a lower value, because the value of 0.4 was the lowest inert particle content value for which the dubbing resistance is excellent, and

(iii) that a value range of 0.4 to less than 0.5% by weight was supported by the content of the earlier application as filed.

2.4.1 With regard to the first assertion the Board denies that it is standard practice to extract isolated features from an originally disclosed combination. On the contrary, the case law of the Boards of Appeal of the EPO only exceptionally justifies the isolated extraction of a feature from a set of features and this on the basis of the specific condition that the skilled person could have readily recognised this value as not so closely associated with the other features of the example as to determine the effect of that embodiment of the invention as a whole in a unique manner and to a significant degree, ie in the absence of any clearly recognisable function or structural relationship among said features (see T 201/83 OJ EPO 1984, 481 as well as T 1067/97 of 4 October 2000, T 714/00 of 6 August 2002, T 25/03 of 8 February 2005, none of them being published in OJ EPO).

In the specific situation of Comparative Example 3, the Appellant has not convinced the Board that the feature of the inert particle content in layer A was not inextricably linked with the other features of this example, to wit the thickness of layer A and the ratio of average particle size/thickness of layer A.

As a general consideration, it is remarked that Comparative Example 3, like each of the examples of the earlier application, be it an example according to the claimed invention or a comparative example, defines a distinct biaxially laminated film characterised by specific technical parameter and possessing specific physical/mechanical properties. Comparative Example 3, like each example of the earlier application as filed thus discloses a self-contained, specific situation wherein the individual parameters are dependent on each other. The isolated extraction of the inert particle content in layer A is thus not allowable because, on the basis of the available information, it is not credible that there is no functional or structural relationship between this feature and the other two features of the exemplified biaxially oriented film.

On the contrary, upon consideration of the technical evidence related to Comparative Example 3 in the context of the other examples reported in that table, the only reliable information the skilled person obtains from it is that the "excellent" dubbing resistance is due to the combination of the specific values of the three parameters, namely the content of the inert particles in layer A, the thickness of that layer and the ratio of the average particle

size/thickness of the layer. In fact, the Board can not find any justification for the Appellant's allegation that the qualification of that property as "excellent" is unilaterally linked to the specific content of the inert particles in layer A.

In particular, the Appellant's argument is not convincing that the skilled person would have directly and unambiguously concluded from the comparison of Example 1 with Comparative Examples 3 and 4, which have the same thickness value, namely 0.3 μm , and the same ratio of average particle size/thickness of layer A, namely 1, that the content of inert particles could vary independently of the other parameters, with the consequence that the value of 0.4% by weight would have been considered as not linked structurally or functionally with them.

In the Board's judgment, this interpretation of the technical data of the earlier application as filed is incorrect. The reason being *inter alia* that the previously mentioned examples relate to biaxially oriented films with a single specific value for the thickness of layer A and a single specific value for the ratio of the average particle size/thickness of layer A, whereas Claim 1 encompasses films with a very broad range of thickness, ie of 0.003 to 3 μm and a very broad range of the said ratio, ie of 0.1 to 10. Consequently, even if for the specific set of parameters of the films exemplified in Example 1 and Comparative Examples 1, 3 and 4, it could be successfully argued that the inert particle content may vary independently of the other two parameters, this specific conclusion cannot reasonably be extended

without further corroborating evidence to the much broader definition of the claimed film. By contrast, Examples 7 and 8 in Table 1 show that the dubbing resistance being "excellent" or only "good" depends on the cooperation of the three parameters "particle content", "layer thickness" and the "ratio particle size/layer thickness".

The Board therefore concludes that the Appellant has arbitrarily isolated the value of 0.4% by weight of the above mentioned particle content out of the specific technical context of Comparative Example 3 of the earlier application with the consequence that, by using this isolated feature in the subject-matter of granted Claim 1, it has contravened the requirements of Article 76(1) EPC 1973.

2.4.2 With regard to the second assertion, the Board refutes the argument of the Appellant that the value of 0.4% by weight is particularly relevant, based on the technical fact that it discloses the lowest inert particle content in layer A, which provides a biaxially oriented film with an excellent dubbing resistance. In the Board's judgment, this argument even if it were true, cannot overrule the lacking extractability of the value of 0.4% as set out above.

It is moreover open to doubt whether such a conclusion can correctly be drawn because there are further comparative examples (Comparative Examples 10 to 13 in Table 3, of the published earlier application), which disclose even lower values for the content of inert particles in layer A, namely 0.05 and 0.15% by weight.

While Table 3 does not provide the results for the dubbing resistance, this missing information cannot legitimately be interpreted to mean that the dubbing resistance was not satisfactory. Therefore in the absence of clear technical evidence the Board does not recognize that the value 0.4% by weight has, with regard to the dubbing resistance, any particular technical significance as a limit of the inert particle content.

- 2.4.3 With regard to the third assertion, the Board considers that the single value of 0.4%, even if disclosed in the claimed generality, would not provide support for all the values falling within the currently claimed range of 0.4 to less than 0.5% by weight. Given that the earlier application focuses on the different range of 0.5 to 50% by weight, 0.5% being disclosed as lower limit of the then claimed invention, the skilled person would not directly and unambiguously derive from the earlier application's whole disclosure that values below 0.5% are operable. Therefore the Board does not acknowledge that on the basis of the exclusive value of 0.4% by weight the Appellant is entitled to claim all the values in the range from 0.4 up to less than 0.5% by weight of the inert particle content in the second layer (layer A) of a biaxially oriented film. Rather Comparative Example 3, where this value is disclosed in combination with other parameters, represents a single point in a multidimensional matrix whose "success" - with regard to the dubbing resistance - cannot be extrapolated to other parameter combinations in the range between 0.4 and 0.5%.

2.5 In view of the above, the Board considers that the contested feature of granted Claim 1 extends beyond the content of the earlier application as filed and thus contravenes Article 76(1) EPC, with the consequence that Claim 1 is not allowable.

3. The Appellant has requested to put a question to the Enlarged Board with regard to the use of a feature in a claim of a divisional application derived from an example denominated "comparative example" in the earlier application.

Under the circumstances of the case, as the Board has decided that the specific value 0.4% by weight cannot be arbitrarily isolated from the technical context of Comparative Example 3 without extending the claimed subject-matter beyond the content of the earlier application, there is no need to take action on this request.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Röhn

P. Kitzmantel