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**Datasheet for the decision  
of 11 March 2010**

**Case Number:** T 1298/06 - 3.3.10

**Application Number:** 01270580.2

**Publication Number:** 1268707

**IPC:** C09K 19/54

**Language of the proceedings:** EN

**Title of invention:**

Stratified phase-separated composite comprising a photo-  
polymerization dye

**Applicant:**

Koninklijke Philips Electronics N.V.

**Opponent:**

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**Headword:**

Stratified phase-separated composite/KONINKLIJKE PHILIPS  
ELECTRONICS N.V.

**Relevant legal provisions:**

EPC Art. 83, 84, 123(2), 111(1)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Amendments allowable (yes)"

"Claims substantially amended on appeal - fresh case -  
remittal"

**Decisions cited:**

G 0010/93, T 0063/86, T 0139/87, T 0047/90

**Catchword:**

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Case Number: T 1298/06 - 3.3.10

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.10  
of 11 March 2010

**Appellant:**

Koninklijke Philips Electronics N.V.  
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**Representative:**

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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 20 March 2006  
refusing European application No. 01270580.2  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** R. Freimuth  
**Members:** C. Komenda  
J.-P. Seitz

## Summary of Facts and Submissions

- I. The appeal lodged on 24 May 2006 lies from the decision of the Examining Division posted on 20 March 2006 refusing European patent application No. 01 270 580.2 published under the International publication No. WO 02/48281.
- II. The decision under appeal was based on the claims according to the then pending request submitted with letter dated 18 April 2005, independent claim 1 thereof, which was identical to its original version, was directed to a stratified phase-separated composite comprising a photo-polymerized layer and a liquid layer, which was obtainable by photo-polymerization of a photo-polymerizable composition.
- III. The Examining Division found that the subject-matter of claims 1 to 7 and 9 to 13 according to the then pending request was not disclosed in a manner sufficiently clear and complete for it to be carried out by a skilled person within the whole scope claimed in the sense of Article 83 EPC and that it was not supported by the description in the sense of Article 84 EPC.

The Examining Division held in particular that the application in suit did not disclose the claimed subject-matter in a manner sufficiently clear and complete for it to be carried out by a skilled person, insofar as it was directed to a composite comprising a photo-polymerized layer and a liquid layer composed of liquids other than liquid crystals. All Examples of the application in suit related to composites, which were obtained by photo-polymerizing a photo-polymerizable

composition comprising a photo-polymerizable monomer, a photo-polymerization dye and particular liquid crystals. It was common general knowledge that liquid crystals were organic compounds of a specific mesomorphic state of matter, which was neither to be regarded as being a liquid nor a solid state of matter. For the broad term "liquid" in claim 1 the application did therefore not provide sufficient information on how stratified phase-separated composites comprising a liquid layer other than a layer of liquid crystal could be obtained, thus resulting in a violation of Article 83 EPC. Further, the subject-matter of claim 1 did not fulfil the requirements of Article 84 EPC, since the broad claim directed to a composite comprising a liquid layer of a liquid other than a liquid crystal was not supported by the description.

The Examining Division thus based the decision under appeal solely on the embodiments of the claimed subject-matter relating to composites comprising a liquid layer of a liquid other than a liquid crystal.

IV. During pending oral proceedings before the Board held on 11 March 2010 the Appellant (Applicant) submitted *via facsimile* a fresh request of thirteen claims superseding the previous request. Independent claim 1 of that request read as follows:

"1. A stratified phase-separated composite comprising a photo-polymeric layer and a liquid layer, the composite being obtainable by photo-polymerizing a layer of a photo-polymerizable stratified-phase-separable composition, the composition comprising:

a photo-polymerizable monomer;

a photo-polymerization dye which is adapted to at least partially absorb the actinic radiation used for photo-polymerizing the monomeric material which, during photo-polymerization, selectively accumulates in the photo-polymeric layer being formed; and a liquid crystal."

V. The Appellant requested in writing in its facsimile of 11 March 2010 that a patent be granted or that the case be remitted to the Examining Division for further prosecution on the basis of the claims 1 to 13 filed during the oral proceedings, thereby implicitly requesting that beforehand the decision under appeal be set aside.

VI. The oral proceedings before the Board were held in the absence of the Appellant, which had been duly summoned, but had not informed the Board that he would not attend the oral proceedings. At the end of the oral proceedings the decision of the Board was announced.

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Scope of examination on appeal*

While Article 111(1) EPC gives the Boards of Appeal the power to raise new grounds in ex-parte proceedings where the application has been refused on other grounds, proceedings before the Boards of Appeal in ex-parte cases are primarily concerned with examining the

contested decision (see decision G 10/93, OJ EPO 1995, 172, points 4 and 5 of the reasons), other objections normally being left to the Examining Division to consider after a referral back, so that the Appellant has the opportunity for these to be considered without loss of an instance.

In the present case the Board, thus, restricts itself to examining whether the amended claims meet the requirements of Article 123(2) EPC and whether the objections as to insufficient disclosure pursuant to Article 83 EPC and to lack of support pursuant to Article 84 EPC as formulated in the decision under appeal and forming the sole grounds for refusal of the application, can still be considered as applying to the amended claims.

3. *Amendments (Article 123(2) EPC)*

The amendments were based on original claims 1 to 13. The subject-matter of claim 1 is based on original claim 1 in combination with original claim 8 and page 2, lines 24 to 26 of the application as filed. Claims 7 and 10 to 13 were amended accordingly. Claims 2 to 6, 8 and 9 remained unchanged.

For these reasons, the Board concludes that that the present claims as amended comply with the requirements of Article 123(2) EPC.

4. *Ground for refusal*

The decision under appeal exclusively dealt with insufficient disclosure in the sense of Article 83 EPC

and lack of support in the description in the sense of Article 84 EPC of the independent claim 1 of the then pending request to the extent that it was directed to a composite comprising a liquid layer composed of liquids other than liquid crystals. The amendments made to the claimed subject-matter in the fresh request, in particular by presenting a fresh independent claim 1 which was substantially restricted in scope by specifying liquid crystals to be used in the photopolymerizable composition, have the effect that the reasons given in the contested decision for refusing the present application no longer apply, since the present claim 1 has never been challenged under Article 83 or 84 EPC.

Thus, the Board considers that the amendments made by the Appellant meet the objection as to insufficiency of disclosure and lack of support as formulated in the decision under appeal and are substantial in the sense that in the present case the examination has to be done on a new basis, with the consequence that the appeal is well founded.

This finding is in line with established jurisprudence of the Boards of Appeal that an appeal is to be considered well founded if the Appellant no longer seeks grant of the patent with a text as refused by the Examining Division and if substantial amendments are proposed which clearly meet the objections on which the decision relies (see decisions T 63/86, OJ EPO 1988, 224; T 139/87, OJ EPO 1990, 68 and T 47/90, OJ EPO 1991, 486).



5. *Remittal*

Having so decided, the Board has not, however, taken a decision on the whole matter, since as set out above substantial amendments to the subject-matter claimed have been made by submitting fresh claim 1 which was only presented at the oral proceedings before the Board. The decision under appeal did not consider fresh claim 1 in the form of the present request, as such request was never submitted to the first instance. It is only before the Board that the Appellant has restricted the claimed invention that the Examining Division considered to be insufficiently disclosed and unsupported by the description, in order to overcome the objections raised. Thus, fresh claim 1 generates a fresh case not yet addressed in examination proceedings.

Under these circumstances, the examination not having been concluded, the Board considers it appropriate to exercise its power conferred on it by Article 111(1), second sentence, second alternative, EPC to remit the case to the Examining Division for further prosecution.

6. The Board also considers the following issues outlined below as meriting consideration when resuming examination proceedings:

Due to the amendments made to claim 1 claim 8 appears to be redundant. The wording of the amended claims appears to need further editorial amendments as regards the syntax.

**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 on the basis of claims 1 to 13 of the sole request filed during the oral proceedings.

The Registrar

The Chairman

C. Rodríguez Rodríguez

R. Freimuth