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**Datasheet for the decision
of 18 November 2008**

Case Number: T 0901/07 - 3.2.07

Application Number: 00907024.4

Publication Number: 1169139

IPC: B05D 3/02

Language of the proceedings: EN

Title of invention:

Synthetic resin film for laminates and method of producing same

Applicant:

Coveright Surfaces Holding GmbH

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 54, 111(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Novelty - yes, after amendment"

"Remittal - yes"

Decisions cited:

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Catchword:

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Case Number: T 0901/07 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 18 November 2008

Appellant: Coveright Surfaces Holding GmbH
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D-45141 Essen (DE)

Representative: Tilmann, Max Wilhelm
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 04 December 2006
refusing European application No. 00907024.4
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: P. O'Reilly
E. Dufrasne

Summary of Facts and Submissions

- I. European application No. 00 907 024 was refused by the examining division for added subject-matter, lack of clarity and lack of novelty.
- II. The appellant (applicant) filed an appeal against that decision.
- III. The appellant was summoned to oral proceedings before the Board. With the summons the Board sent a communication setting out its provisional view, including an explanation of the circumstances under which it would consider remitting the case to the examining division.
- IV. In its response dated 2 October 2008 the appellant requested that the decision under appeal be set aside and the case be remitted to the department of first instance on the basis of claims 1 to 20 filed with said response. The request for oral proceedings was withdrawn pending the intended remittal.
- V. The Board cancelled the scheduled oral proceedings.
- VI. Claim 1 of the sole request reads as follows:

"1. A method of producing synthetic resin film for laminates, said synthetic resin film comprising a substrate impregnated with a thermosetting resin, said method comprising

- (a) impregnating the substrate with a first thermosetting resin composition comprising a first uncured thermosetting resin and a low profile additive,

which is inert, substantially spherical and has a particle size in the range of about 5 to about 60 microns,

(b) drying the impregnated substrate of (a),

(c) impregnating the substrate of (b) with a second thermosetting resin composition comprising a second uncured thermosetting resin and a low profile additive, which is inert, substantially spherical and has a particle size in the range of about 5 to about 60 microns, and

(d) drying the impregnated substrate of (c)."

VII. The document cited in the present decision is the following:

D1: US-A-5 456 949

VII. The arguments of the appellant may be summarised as follows:

Alumina particles can have many shapes and sizes. The low profile shape according to claim 1 is one of various possible shapes. Thus the subject-matter of the claim is novel over D1 which does disclose any shape for the alumina particles disclosed therein.

Reasons for the Decision

1. *Articles 123(2) and 84 EPC*

1.1 Claim 1 as amended in the appeal proceedings is a combination of claims 1 and 10 as originally filed as well as the definition of a low profile additive set out

on page 5, lines 28 to 29 of the description as originally filed.

- 1.2 Therefore, the amendments to claim 1 comply with Article 123(2) EPC. The application has not otherwise been examined for compliance with this article.
- 1.3 The examining division in the impugned decision objected to claims 13 and 18 based on Articles 84 and 123(2) EPC respectively. These claims, however, are no longer present in the latest amended set of claims filed in the appeal proceedings.

2. *Novelty*

- 2.1 D1 discloses alumina particles but without disclosing their shape. Claim 1 specifies that the low profile additives are substantially spherical. This feature of the claim is therefore novel over the disclosure of D1. This was also the view of the examining division as expressed in its decision (see reasons point 4, penultimate paragraph) whereby the examining division pointed out that the feature was not contained in the claim upon which it was deciding.
- 2.2 Therefore, the subject-matter of claim 1 is novel in the sense of Article 54 EPC.

3. *Remittal to the department of first instance*

The examining division has not yet examined claim 1 (as amended during appeal proceedings) with regard to inventive step. In accordance with Article 111(1) EPC, the Board therefore considers it appropriate to remit

the case to the examining division so as to give the appellant the possibility to argue its case before two instances.

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:

The Chairman:

G. Nachtigall

H. Meinders