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**Datasheet for the decision
of 3 August 2010**

Case Number: T 1833/08 - 3.2.05

Application Number: 99307836.9

Publication Number: 0992363

IPC: B41M 5/40

Language of the proceedings: EN

Title of invention:
Heat-sensitive recording material

Patentee:
FUJIFILM Corporation

Opponent:
Mitsubishi HiTec Paper Flensburg GmbH

Headword:

-

Relevant legal provisions:
EPC Art. 111(1), 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:
"Extension beyond content of application as filed (all requests, yes)"

Decisions cited:

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Catchword:

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Case Number: T 1833/08 - 3.2.05

D E C I S I O N
of the Technical Board of Appeal 3.2.05
of 3 August 2010

Appellant:
(Patent Proprietor)

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Respondent:
(Opponent)

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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 18 July 2008
revoking European patent No. 0992363 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: W. Zellhuber
Members: P. Michel
M. J. Vogel

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division revoking European Patent No. 0 992 363 on the ground of extension of scope of protection under Article 123(3) EPC.
- II. Oral proceedings were held before the Board of Appeal on 3 August 2010.

The appellant requested that the decision under appeal be set aside and the patent in suit be maintained on the basis of any of the sets of claims filed as main request and first to third auxiliary requests on 18 June 2010. Alternatively, it is requested that the case be remitted to the first instance.

The respondent (opponent) requested that the appeal be dismissed.

- III. Claim 1 of the main request of the appellant reads as follows:

"1. A heat-sensitive recording material comprising a support having formed thereon one or more heat-sensitive recording layers, wherein

at least one of the one or more heat-sensitive recording layers comprise an electron donative colorless dye, an electron acceptive compound and an ultraviolet ray absorbing agent, and when there is a plurality of heat-sensitive recording layers, each layer comprises the same electron donative colorless

dye and electron acceptive compound as each of the other layers, and

distribution of the ultraviolet ray absorbing agent is such that the amount of the ultraviolet ray absorbing agent increases in a film thickness direction away from the support."

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the word "film" is omitted.

Claim 1 of the second auxiliary request reads as follows:

"1. A heat-sensitive recording material comprising a support having formed thereon two heat-sensitive recording layers, wherein

the heat-sensitive recording layers comprise 3-N-dibutylamino-6-methyl-7-anilinofluoran as an electron donative colorless dye, 2,4-dihydroxybenzilsulfone as an electron acceptive compound and an ultraviolet ray absorbing agent, and

distribution of the ultraviolet ray absorbing agent is such that the amount of the ultraviolet ray absorbing agent increases in a film thickness direction away from the support."

Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request in that the word "film" is omitted.

IV. The appellant argued substantially as follows in the written and oral procedure:

Since the patent in suit was revoked by the Opposition Division on the sole ground of Article 123(3) EPC, this is the sole ground at issue in the present proceedings. Since the Opposition Division did not decide against maintenance of the patent in suit on any other ground than Article 123(3) EPC, the case must be remitted to the Opposition Division for consideration of any other ground of opposition, including Article 123(2) EPC. Otherwise, the appellant would be deprived of an appealable decision. Article 114(1) EPC does not give the Board the right to review the patent in an unlimited way.

Paragraphs 15 to 18 of the decision G 9/91 confirm this point of view. In particular, paragraph 18 states that whilst Article 114(1) EPC covers both the procedure before the Opposition Division and the appeal stage, the provision should be applied more strictly in the appeal procedure. Paragraph 19 refers to the necessity of a full examination only of amended features.

The application as filed taken as a whole implicitly discloses the feature that "at least one of the one or more heat-sensitive layers comprise an electron donative colorless dye, an electron acceptive compound and an ultraviolet absorbing agent". There is no suggestion that the compounds could be different in each layer. In paragraphs [0019] to [0021] of the published version of the application as filed, suitable electron donative colorless dyes and electron acceptive compounds are listed. Again, there is no suggestion that these compounds could be combined and the person skilled in the art would select the same compound from each list for all layers.

The amendments to claim 1 of the main and first auxiliary requests thus comply with the requirement of Article 123(2) EPC.

Example 1 of the application as filed provides a disclosure of the compounds specified in claim 1 of the second and third auxiliary requests. The remaining features of the example, such as the presence of a stabilizer and the use of paper as the support do not contribute to the invention. Further, the examples are merely explanatory and it is permissible to generalize from them.

The amendments to claim 1 of the second and third auxiliary requests thus also comply with the requirement of Article 123(2) EPC.

- V. The respondent argued substantially as follows in the written and oral procedure:

The objections under Article 123(2) EPC were raised in the notice of opposition and should be considered in the present proceedings.

The feature of claim 1 according to the main and first auxiliary requests, according to which, "when there is a plurality of heat-sensitive recording layers, each layer comprises the same electron donative colorless dye and electron acceptive compound as each of the other layers", is not disclosed in the application as filed. The only references to the electron donative colorless dye and the electron acceptive compound in the application as filed are in paragraphs [0006],

[0008], and [0018] to [0020]. In these passages, the electron donative colorless dye and the electron acceptive compound are disclosed independently of one another.

Claim 1 according to the main and first auxiliary requests thus does not comply with the requirements of Article 123(2) EPC.

The only disclosure of the electron donative colorless dye and electron acceptive compound specified in claim 1 is in Example 1 of the application as filed. However, this disclosure is in the context of the remaining features of the examples, such as the presence of a stabilizer, the use of paper as the support, the specified amounts of the various materials and the presence of an ultraviolet ray absorbing agent only in the second layer.

In the absence of the remaining features of the examples, claim 1 according to the first and second auxiliary requests does not comply with the requirements of Article 123(2) EPC.

Reasons for the Decision

1. Admissibility of objections under Article 123(2) EPC

In G 9/91, the Enlarged Board considered the question of to what extent an Opposition Division or Board of Appeal has the power to examine and decide upon grounds not mentioned in the notice of opposition. In the present case, however, the issue of allowability of

amendments under Article 123(2) EPC was raised in the notice of opposition (see point 2 at pages 2 to 5).

At the oral proceedings before the Opposition Division, whilst the objections of the respondent under both Article 123(2) and (3) EPC were discussed, it was not necessary for the Opposition Division to mention the objections under Article 123(2) EPC in the decision, since the decision to refuse both requests was based on Article 123(3) EPC.

The Board thus comes to the conclusion that it is appropriate to exercise their discretion under Article 111(1) EPC to consider the issues arising in view of Article 123(2) EPC in the present proceedings. A remittal to the department of first instance is consequently not necessary.

It is noted that, if the Board were to consider themselves restricted to a consideration of issues arising under Article 123(3) EPC, the case would have to be remitted to the department of first instance at least on the basis of the claims as granted, so that the Opposition Division would be confronted with issues which they have already considered. This is inconsistent with procedural efficiency.

2. *Article 123(2) EPC*

2.1 *Main request*

Claim 1 of the application as filed specifies that "at least one of the one or more heat-sensitive layers comprise an electron donative colorless dye, an

electron acceptive compound and an ultraviolet absorbing agent". Paragraphs [0006] and [0008] of the description of the application as filed contain a similar general disclosure.

Paragraph [0019] of the description of the application as filed lists examples of suitable electron donative colorless dyes and paragraphs [0020] and [0021] list examples of suitable electron acceptive compounds. There is no suggestion that, when a plurality of layers is present, all the layers should include the same electron donative colorless dye and electron acceptive compound as each of the other layers.

Example 1 of the application as filed relates to a heat-sensitive recording paper having two heat-sensitive layers, each having the same electron donative colorless dye (3-N-dibutylamino-6-methyl-7-anilinofluoran) and the same electron acceptive compound (2,4-dihydroxybenzilsulfone). This does not, however, constitute an indication that, in general, all the layers should include the same electron donative colorless dye and electron acceptive compound as each of the other layers.

There is thus no general disclosure in the application as filed to the effect that "when there is a plurality of heat-sensitive recording layers, each layer comprises the same electron donative colorless dye and electron acceptive compound as each of the other layers".

The amendments to claim 1 thus do not comply with the requirements of Article 123(2) EPC.

2.2 *First Auxiliary Request*

The objection under Article 123(2) EPC in respect of the amendments to claim 1 according to the main request also applies to claim 1 according to the first auxiliary request. The amendments to claim 1 thus do not comply with the requirements of Article 123(2) EPC.

2.3 *Second Auxiliary Request*

Example 1 of the application as filed discloses the preparation of a coating solution for a first heat-sensitive recording layer from three solutions; the first (solution A), including 3-N-dibutylamino-6-methyl-7-anilino-fluoran as an electron donative colorless dye, and the second (solution B) including 2,4-dihydroxybenzilsulfone as an electron acceptive compound (see paragraphs [0032] to [0037]). The first heat-sensitive recording layer thus does not include an ultraviolet ray absorbing agent.

Subsequently, in paragraphs [0038] to [0040], there is described the preparation of a solution (solution D) including an ultraviolet ray absorbing agent, under the heading of preparation of the second heat-sensitive recording layer. Whilst it is nowhere described that solution D is mixed with the remaining solutions, it must be assumed that the second heat-sensitive recording layer includes the ultraviolet ray absorbing agent.

Thus, the only disclosure in the application as filed of the use of the electron donative colorless dye and

the electron acceptive compounds specified in claim 1 is in the context of a recording material having two heat-sensitive recording layers, the first layer not containing an ultraviolet ray absorbing agent.

Similarly, the examples all relate to heat-sensitive recording papers rather than heat-sensitive recording materials in general and specify the presence of 1,1,3-tris-(2-methyl-4-hydroxy-5-t-butylphenyl)butane as a stabilizer.

There is thus no general disclosure in the application as filed of a recording material in which the heat-sensitive recording layers contain the specified compounds and in which distribution of the ultraviolet ray absorbing agent is such that the amount of the ultraviolet ray absorbing agent increases in a (film) thickness direction away from the support and thus may also contain an ultraviolet ray absorbing agent in the first layer, the support is not paper and the recording layers do not include the specified stabilizer. It was argued on behalf of the appellant that the features of Example 1 not included in claim 1 do not contribute to the invention. This is, however, not relevant to the question of whether or not the combination of features specified in claim 1 was disclosed in the application as filed. It is noted that there is no indication in the specification that particular features of the examples may be omitted or altered in any way.

The amendments to claim 1 thus do not comply with the requirements of Article 123(2) EPC.

2.4 *Third Auxiliary Request*

The objection under Article 123(2) EPC in respect of the amendments to claim 1 according to the second auxiliary request also applies to claim 1 according to the third auxiliary request. The amendments to claim 1 thus do not comply with the requirements of Article 123(2) EPC.

2.5 Accordingly, none of the requests of the appellant satisfy the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Meyfarth

W. Zellhuber