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Datasheet for the decision of 1 July 2015

Case Number: T 1279/10 - 3.5.07

Application Number: 04770087.7

Publication Number: 1673779

IPC: G11B27/30

Language of the proceedings: EN

Title of invention:
Multiple layer optical disc, and device for writing such disc

Applicant:
Koninklijke Philips N.V.

Headword:
Multi-layer disc drive/PHILIPS

Relevant legal provisions:
EPC Art. 83, 84, 111(1), 123(2)
EPC R. 103(1)(a)

Keyword:
Added subject-matter - (no)
Sufficiency of disclosure - (yes)
Claims - clarity (yes)
Remittal to the department of first instance - (yes)
Substantial procedural violation - (no)
Reimbursement of appeal fee - (no)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
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Case Number: T 1279/10 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 1 July 2015

Appellant: (Applicant)	Koninklijke Philips N.V. High Tech Campus 5 5656 AE Eindhoven (NL)
Representative:	Uittenbogaard, Frank Philips Intellectual Property & Standards P.O. Box 220 5600 AE Eindhoven (NL)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 15 December 2009 refusing European patent application No. 04770087.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	R. Moufang
Members:	M. Rognoni
	R. de Man

Summary of Facts and Submissions

I. The applicant (appellant) appealed against the decision of the Examining Division to refuse European patent application no. 04770087.7.

II. In the contested decision, the Examining Division held that all requests contravened Article 123(2) EPC because, after deletion of the reference to part III of the DVD video specification on page 7, lines 9 and 10 of the description, the meaning of the term "video cell" extended beyond what had been disclosed in the application as originally filed.

Furthermore, the Examining Division raised objections of lack of support under Article 84 EPC against the main request and the first and third auxiliary requests. It also noted that limitations in the claims comprising the term "DVD" or "DVD-related terminology" would possibly contravene Article 83 EPC. In addition, the Examining Division found that dependent claim 6 of the main request and claim 2 of the second auxiliary request did not comply with Article 123(2) EPC.

III. With the notice of appeal, the appellant requested to set aside the decision under appeal and to grant a patent. Auxiliarily, oral proceedings were requested.

IV. With the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of:

- the claims filed with letter dated 16 September 2009 as main request for the oral proceedings before the Examining Division, and the description as originally filed (main request);

- the claims according to the main request and page 7 of the original description amended as indicated in item 2.2 of the statement of grounds of appeal (first auxiliary request);

- the claims according to the main request and the description as filed with letter dated 16 September 2009 (second auxiliary request);

- the claims according to the main request and page 7 of the original description amended as indicated in item 4.1 of the statement of grounds of appeal (third auxiliary request);

- the claims according to the first auxiliary request filed with letter dated 16 September 2009 and the description as originally filed or alternatively the description of the first, second or third auxiliary request ("fourth auxiliary request").

With the statement of grounds of appeal, the appellant resubmitted claims 1 to 10 according to the main request, claims 1 to 9 according to the "fourth auxiliary" request and amended pages of the description according to the first, second and third auxiliary requests.

Furthermore, the appellant requested the reimbursement of the appeal fee.

V. In a communication dated 12 June 2014, the Board *inter alia* introduced the following documents into the proceedings:

D2: DVD Format/Logo License Agreement (source: http://www.dvdfllc.co.jp/license/l_pro.html#agree),
D3: J. Taylor: "DVD-Video: Multimedia for the Masses",IEEE Multimedia July-September 1999, pages 86-92,
D4: US-B1-6 385 388,
D5: EP-A-1 052 644,
D6: WO-A1-01/01415,
D7: EP-A-1 204 106.

The Board also expressed the opinion that the reasons under Articles 83, 84 and 123(2) EPC provided by the Examining Division did not justify the refusal of the application. On the other hand, considering that novelty and inventive step had never been the object of a substantive examination, the Board found that it was appropriate to set aside the contested decision and remit the case to the department of first instance for further prosecution.

As to the appellant's request for reimbursement of the appeal fee, the Board stated that it was not fully convinced that, as alleged by the appellant, the Examining Division had committed a substantial procedural violation which would justify such remedy.

The Board then invited the appellant to specify whether it wished to maintain its request for oral proceedings under these circumstances.

VI. With letter dated 1 September 2014 the appellant declared that it did not maintain its request for oral proceedings in view of the circumstances indicated in the Board's communication.

VII. Claim 1 according to the main request reads as follows:

"Optical drive (10) capable of writing information in a logical storage space (LSS) of a [*sic*] optical disc (2) which has a physical storage space (3) comprising two or more layers (LO; LI) [*sic*] of physical storage locations,
each storage location (4) having a physical address (PA),
the logical storage space (LSS) comprising storage locations within a first one (LO) [*sic*] of said layers and within a subsequent one (LI)[*sic*] of said layers,
the storage locations in said logical storage space (LSS) having contiguously numbered logical addresses (LA);
- the optical drive (10) capable of receiving data from a host device (20), the data containing information to be written onto the optical disc and/or data containing instructions for said optical drive (10)
- the optical drive (10) having an address limit memory (12) containing at least a value for a parameter LAmax indicating the maximum value of the logical addresses (LA) of the storage locations (4) in said first storage layer (LO)[*sic*];
characterized in that
- the optical drive (10) is adapted to receive from the host device (20) a limit fix command instructing said optical drive (10) to store a value for the parameter LAmax as determined by the host device (20) in said address limit memory (20)
the optical drive (10) being capable of changing the value for the parameter LAmax in said address limit memory (12) to the value received from the host device (20)."

Claims 2 to 4 are dependent on claim 1.

Claim 5 relates to a host device for controlling an optical drive according to claim 1.

Dependent claim 6 reads as follows:

"Host device according to claim 5, designed to send a video signal, the video signal comprising a sequence of cells, a transition from one layer to the next only being allowed at a cell boundary, to said optical drive (10), the host device (20) being capable of evaluating the video signal to be written so as to determine where cell boundaries (34) in this video signal are to be expected [step 221], to calculate a suitable value for said parameter LAmax such that a block (4) for which it holds that LA = LAmax corresponds to a cell boundary, and to send a limit fix command to said optical drive (10) for instructing said optical drive to store said calculated value into its address limit memory (12)."

Claim 7 is dependent on claim 5.

Claim 8 relates to a "Data storage system (1)" comprising *inter alia* "a [sic] optical drive (10) in accordance with claim 1" and "a host device (20) capable of cooperating with said optical drive (10) in accordance with claim 5".

Claims 9 and 10 are dependent on claim 8.

The auxiliary requests are not relevant to the present decision.

VIII. In the statement of grounds of appeal, the appellant argued essentially as follows:

In the light of the decision T 50/02, a document was made available to the public in the sense of Article 54(2) EPC if all interested parties had an opportunity of gaining knowledge of the content of the document for their own purposes, even if they did not have a right to disseminate it to third parties, provided that these third parties would be able to obtain knowledge of the content of the document by purchasing it for themselves. Hence, as a document available to interested parties, the DVD standard was available to the public within the meaning of Article 54(2) EPC.

Furthermore, the term "video cells" in the context of DVDs was part of common general knowledge and therefore the reference in the description to the DVD standard presented additional information not needed for sufficiency of disclosure under Article 83 EPC.

A further objection raised in the contested decision was that claim 1 lacked the feature "capable of writing a dual layer DVD disc" and that, in absence of such feature, the claims were considered too broad and not supported by the description, contrary to Article 84 EPC.

Although the examples of the invention in the description were based on the DVD system, a more general explanation of the problem and of the invention was given in the description. The claims on file were a generalisation based on the examples and covered obvious modifications and equivalents of the detailed examples. In particular, as the skilled reader would understand the disclosure, the claims should not be limited to a particular optical disc system such as

DVD, but be broad enough to cover other multilayer optical disc systems.

As to the request for reimbursement of the appeal fee, the applicant had suffered, during the proceedings before the Examining Division leading to the refusal of the application, mainly from the application of an "unsupported principle" *i.e.* the requirement that the technical problem as such had to be derivable from the application as filed. However, no such requirement could be based on the EPC or the Guidelines. Furthermore, the Examining Division triggered and subsequently disputed amendments based on the fact that the DVD video standard had to be considered not public. This was contrary to the established case law of the boards of appeal.

Finally, the ground for rejecting all requests under Article 123(2) EPC had not been discussed at the oral proceedings. All the deficiencies affecting the examination proceedings amounted to a substantial procedural violation which justified the reimbursement of the appeal fee.

Reasons for the Decision

1. The appeal is admissible.

2. In the contested decision, the Examining Division raised essentially the following objections under Articles 83, 84 and 123(2) EPC:

   (a) Due to the deletion of the sentence "With respect to 'video cells', reference is made to part III of the DVD video specification" on page 7 of the

description, the term "video cell" was no longer unambiguously linked to the DVD specification. This extended the meaning of the term "video cell" beyond what was disclosed in the application as originally filed. Thus, all requests contravened Article 123(2) EPC.

(b) It was neither explained in the application nor understood by the Examining Division for what technical reasons certain data structures, such as the DVD video cell, would preferably be contained in a single storage layer, as stated in the application (page 2, line 33 to page 3, line 2). Furthermore, the statement on page 4, lines 16 to 18 ("it may be desirable for other reasons to be able to adjust the size of the logical space of a storage layer") was speculative, as no reasons had been given.

(c) The applicant's argument that the player according to the invention could prepare itself for layer jump was not supported by any corresponding features in claim 1 and there was no evidence that this would provide any advantage.

(d) Other problems identified by the applicant which would be solved by the present invention were not implied by or related to the technical problem initially suggested, namely how to ensure that the last logical address of a storage layer corresponded to a video cell boundary. Thus, the identification of alternative problems or corresponding technical effects involved hindsight.

(e) The only problem addressed by the present invention seemed to be related to achieving compliance with the DVD-Video Specification. As claim 1 did not contain any reference to writing a dual layer DVD, it was not supported by the description (Article 84 EPC).

(f) Limitations comprising the term DVD or DVD-related terminology would contravene Article 83 EPC, since this implied that the skilled person would have to refer to the non-public DVD Specifications for disclosure.

(g) Dependent claim 6 of the main request comprised the feature "a transition from one layer to the next only being allowed at a cell boundary". This implied a generalization beyond DVD video cells to any data structure that could not be split over two layers. Thus, this claim contravened Article 123(2) EPC.

Articles 123(2) and 83 EPC

3. As pointed out above (see point 2.(a)) the Examining Division considered that the deletion of a reference to the DVD video specification from the description of the present application violated Article 123(2) EPC. The allegedly inadmissible deletion had been prompted by the objection raised in the communication dated 11 June 2008 that the cited DVD specification had not been made available to the public.

3.1 The appellant's main request comprises the claims dated 16 September 2009 and the description as originally filed. As it thus includes the reference to part III of the DVD video specification with respect to "video

cells" (see page 7 of the application as published, lines 9 and 10), the main request overcomes the Examining Division's objection of added subject-matter (Article 123(2) EPC).

3.2 The question of the availability to the public of the DVD specification is relevant as far as this document is required for defining the technical context of the present application and specifying the invention. However, before considering whether the DVD video specification is state of the art according to Article 54(2) EPC, it is expedient to examine whether the information provided by this document is actually necessary to conclude that the present application is sufficiently disclosed within the meaning of Article 83 EPC.

4. The first two pages of the description (see application as published) give a general introduction to the field of the invention, namely multiple-layer optical storage discs, and refer, in particular, to some basic features of DVDs (Digital Versatile Disc) presented as commonly known (see for instance the last paragraph of page 1).

4.1 As explained on page 2, lines 5 to 17 of the application, a disc drive apparatus comprises optical means for writing data on an optical medium and is capable of accessing storage blocks at the level of physical addresses. On the other hand, the host apparatus, *i.e.* a PC or a video recorder, is a device which communicates with the disc drive and sends commands instructing the disc drive to write data to a certain storage location. The host apparatus has no direct access to the medium's physical storage space, but only to the logical storage space. *"Although the logical storage space does not need to be a physically*

contiguous storage space, the storage blocks in the logical storage space have consecutive logical addresses, which are usually not identical to the physical addresses" (application as published, page 2, lines 14 to 17). In other words, the host apparatus can access storage blocks only through the intermediary of the disc drive.

4.2 As pointed out in the penultimate paragraph of page 2, known optical discs may have two or even more storage layers, each storage layer containing a storage track in the shape of a spiral or multiple concentric circles. In these cases, the logical storage space extends over multiple storage layers and the transition from the last block of one storage layer to the first block of the next storage layer corresponds to an increment of 1 of the logical address.

4.3 According to the paragraph bridging pages 2 and 3, a *"typical problem occurs in the case of a DVD-Video Disc. According to the DVD Video Standard, it is (as a rule) not possible to continue writing right through to the last possible block of the first layer, and then to make a transition to the first block of the next layer. During writing, DVD Video data is organized in cells, and a transition from one layer to the next is only allowed at a cell boundary. This is related to the fact that, on reading video data from disc, it is desirable to have a seamless continuation of video image display. Since it is usually not known in advance where these cell boundaries will be located, it is not known in advance where the transition from one layer to the next will be made. Consequently, it is not known in advance what the highest logical address of one storage layer is; likewise, it is not known in advance what the relation is between physical addresses and logical*

addresses in the next layer". It is therefore difficult to determine the remaining storage capacity during writing and consequently the exact location of the transition area between the two layers (see page 3, lines 10 to 20).

4.4 In other words, the present application deals with a problem occurring when data is organised in "cells", which cannot or should not be split over two layers, as requested by the DVD video standard. The problem is avoided by shifting to the second layer the recording of a data cell which could be only partially stored in the first layer. Thus, the last logical address of the first layer is not the logical address of the last available physical storage block and depends essentially on the size of the data cell and on the number of remaining physical storage blocks in the layer.

4.5 The skilled reader of the application realises that even if the invention is explained within the context of optical discs, in particular DVDs, the same considerations can be made for any kind of multilayer media when it is desirable to avoid splitting data blocks over two recording layers. In other words, notwithstanding the fact that the present invention may be particularly useful for optical media complying with the DVD specification, there can be no doubt that the technical effect of not interrupting the recording of a block of data to switch the recording from one layer to another is independent of the nature of the data, of the characteristics of the data block (or cell) and of the kind of optical medium used.

4.6 The gist of the present invention consists essentially in providing a disc drive which is capable of limiting

the logical address of storage locations in a layer to a value LAmax which is determined by the host apparatus. In this case the jump from one layer to the next will be controlled by the host on the basis of the size of a data block which should not be split.

4.7 In the Board's opinion, the actual constitution of a video data cell is immaterial for the understanding of the invention or for its implementation, the only relevant characteristics of a data cell being that it has certain boundaries and should not be split between two layers.

4.8 Furthermore, the Board notes that the reference to part III of the DVD video specification on page 7, lines 9 and 10 of the application as published is provided in the context of Figure 3 which is a diagram schematically depicting a logical space and a video sequence 30 comprising video cells 35 separated by boundaries 34. It merely shows that the parameter LAmax is determined as a function of the position of the boundary 34. As observed above, no further details of the DVD video specification are needed to understand that the parameter LAmax is selected on the basis of the partition of the data into cells so that no cell needs to be stored over two layers. Hence, the reference to the DVD video specification merely informs the reader that the DVD standard provides an example of data organised in "cells", namely blocks, which cannot be split over different layers.

5. In the contested decision, the Examining Division also objected that the feature "a transition from one layer to the next only being allowed at a cell boundary" in claim 6 of the main request implied an impermissible

generalisation beyond DVD cells (see point 2.(g) above).

5.1 As pointed out above, the Board considers that, although the exemplary embodiments of the invention relate to a DVD drive, it is clear to the skilled reader that the invention is applicable to any multiple layer disc drive destined to store data organised in blocks or cells which cannot or should not be split. Thus, there is no need to limit the claim to DVD video cells which may have specific characteristics defined in the DVD standard (see point 2.(f) and (g) above).

6. Apart from the fact that the term "video cell" is sufficiently well explained in the present application, at least as far as required to understand the technical context of the invention, the problem it seeks to solve and its general implementation, the Board has found evidence that the term "video cell" was well documented before the priority date of the present application so that it could be assumed that it was a term familiar to the skilled person.

6.1 On page 87 of document D3, under the heading "DVD-Video data structures", it is specified that *"DVD-Video data organization structure represents the physical location of data on the disc. Since data may be shared among different titles and programs, logical data structures overlay the physical structure. The logical structures contain navigation information and determine the presentation order of information, independent of the physical order"*.

6.2 In the first paragraph of the section "Physical data structure" (second sentence), document D3 points out that the standard specifies storing data sequentially

in a physically contiguous order. The physical data structure is as follows:

- a Video Title Set (VTS) is the primary physical block and contains internal information about the title and it is followed by Video Object Sets;
- the Video Object Set structures are broken into 1-megabyte chunks that are stored as .VOB files on the disc;
- data at the Video Object Set (VOBS) level includes attributes for video, audio and sub-picture;
- each Video Object Set consists of one or more Video Objects;
- a Video Object consists of one or more Cells, a Cell being a group of pictures or audio blocks and representing the smallest addressable chunk;
- a Cell can be as short as a second or as long as a movie and is uniquely identified by its ID and the Video Object ID;
- each Cell is divided into Video Object Units (VOBUs) Video Object Units are made up of Packs of Packets, whose format complies with the MPEG standard.

6.3 As specified in the section "Logical data structure", the presentation of the logical data structure overlays the physical data structure. The top level of the logical structure is made up of Titles. Each Title contains up to 999 Program Chains. A Program Chain contains 0 to 99 Programs which are a collection of pointers to Cells. Thus, the physical data and the logical presentation data structure converge at the Cell level. In fact, the Program Chain links Cells together and indicates the order in which to play the programs and the Cells.

6.4 The same data structure in accordance with the DVD specification is shown in D4 (see in particular Figures 6 and 7 and column 4, line 65 to column 5, line 57). Further detailed information on the DVD-Video format based on the DVD Standard is given also in D5 and D6. Both documents refer to video cells and D5 points out that the minimum unit of video data for logical processing is a cell and that logical processing is done in units of cells (D5, paragraph [0114]).

7. In summary, the Board comes to the conclusion that the present application discloses the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art even without relying on information which may be provided by the part III of the DVD specification. Thus, for the purpose of complying with Article 83 EPC, it is irrelevant to decide whether this document had been made accessible to the public before the priority data of the application and thus was state of the art within the meaning of Article 54(2) EPC.

Article 84 EPC

8. A further objection raised in the contested decision was that claim 1 was not supported by the description, as it was not limited to a drive capable of writing a dual layer DVD disc (Article 84 EPC - see point 2.(e) above).

9. Claim 1 according to the main request relates to an optical drive capable of writing information in a logical storage space of an optical disc. Claim 1 specifies that the optical disc has:

e) a physical storage space comprising two or more layers of physical storage locations,

f) each storage location having a physical address,

g) the logical storage space comprising storage locations within a first one of said layers and within a subsequent one of said layers,

h) the storage locations in said logical storage space having contiguously numbered logical addresses.

Claim 1 specifies the features of the disc drive as follows:

a) the optical drive is capable of receiving data from a host device,

- the data containing information to be written onto the optical disc and/or data containing instructions for said optical drive;

b) the optical drive has an address limit memory containing at least a value for a parameter LAmax indicating the maximum value of the logical addresses of the storage locations in said first storage layer;

c) the optical drive being adapted to receive from the host device a limit fix command instructing said optical drive to store a value for the parameter LAmax as determined by the host device in said address limit memory;

d) the optical drive is capable of changing the value for the parameter LAmax in said address limit memory to the value received from the host device.

9.1 Features e) to h) relate to a generic optical disc with a plurality of storage layers to be used to store generic data (see feature a).

As to features a) to d), they specify in essence that the optical drive has an address limit memory for storing a parameter LAmax and that this parameter can be changed in response to a command sent by the host, whereby the new LAmax value is also determined by the host. As observed by the Examining Division, claim 1 is not directed to solving a specific problem that may occur while recording video data on a DVD video disc, but relates to a disc drive with a value LAmax which is controlled by the host. As it is implicit that the transition from the first layer to the second layer during data recording depends on the maximum value of the logical address of the first layer, giving control of LAmax to the host has as a consequence that the transition from the first layer to the second is effectively controlled by the host.

9.2 On page 4, lines 15 to 19, of the application, it is specified that *"objectives of the present invention have been explained in the context of video cell boundaries in the case of writing video data. However, it may be desirable for other reasons to be able to adjust the size of the logical space of a storage layer, i. e. the number of logical addresses in a storage layer"* (underlining added).

10. According to the Examining Division (see item 2.5.1 of the contested decision) the above statement was

speculative and could give no support to the broad wording of claim 1.

10.1 In particular, the Examining Division considered that claim 1 lacked support under Article 84 EPC, *inter alia,* because there was no explanation in the application as to why the alleged problem identified in the context of DVD video cells, or a similar problem, would occur when recording streams not based on the DVD-Video format, or when recording to an optical disc using an optical drive other than DVD (-R, +R, -RW, +RW).

10.2 For the purpose of fulfilling the requirement of Article 84 EPC, it is immaterial to question whether the present invention "makes sense" only for a DVD drive and whether the statement that *"it may be desirable for other reasons to adjust the size of the logical space of a storage layer"* is merely speculative (see page 4, lines 16 to 18 of the application).

It is explicitly stated in the description that the teaching of the application is applicable to different types of recordable discs. All the features of the disc drive recited in claim 1 are clearly described in the application and are common to generic optical disc drives and to DVD drives.

10.3 The only feature of the claimed optical drive which may seem undetermined, as it depends on the structure of the data to be recorded and on the kind of optical media, is the parameter LAmax. In fact, this parameter is selected by the host and sent to the optical drive which is capable of storing it in a memory.

10.4 However, it is not necessary to know the value of LAmax or the beneficial effects provided by limiting the logical address on a recording layer to a maximum value LAmax in order to be able to implement a disc drive according to claim 1 capable, as described in the application, of recording "cells" or blocks of data without splitting them over two layers.

11. Furthermore, in the Board's opinion, the skilled person had sufficient background information about optical recording at the time of filing of the present application to understand that being able to actively control and vary the size of the logical space of a storage layer could be advantageously employed to overcome certain known issues relating to optical recording media with plural storage layers.

11.1 For instance, it can be argued that the scenario described in document D7 would provide an example of a possible field of application of the present application in a broader technical context than the recording of video data on a DVD. In particular document D7 relates, inter alia, to a multi-layered recording medium comprising a recording area divided into three zones.

As shown in Figures 5 and 6, and explained in the corresponding passages of the description (see third and fourth embodiments, paragraphs [0062] to [0092]), data are recorded in sections of the first and second layer by shifting the focus of the laser beam and moving it alternatively in opposite radial directions. It is understood that in D7 the recording path is determined by the disc drive on the basis of the physical addresses. However, it would also be possible to achieve the same result by letting the host define

recording areas in the first and second layers. This could be done according to the underlying teaching of the present invention by limiting the maximum logical addresses to be used in each layer before switching to the next layer.

11.2 Hence, given the broad wording of claim 1, the objective of the claimed invention can be seen in the possibility of varying the size of the logical space of a storage layer of a multilayer optical disc (page 4, line 18 to 19). Although the specific embodiments described in the original application relate indeed to a DVD optical system and to the recording of video data, the general teaching underlying the present invention would have been understood by the reader provided with the background knowledge to be expected from the notional skilled person.

11.3 For the avoidance of doubt, the Board notes that questions concerning the problem addressed by the claimed invention are certainly appropriate and may even be required within the context of an inventive step assessment and in the light of the state of the art.

12. In summary, the Board comes to the conclusion that the reasons under Articles 83, 84 and 123(2) EPC provided by the Examining Division do not justify the refusal of the application.

12.1 Considering that novelty and inventive step were never the object of a substantive examination, the Board finds it appropriate in the present case to make use of its power under Article 111(1) EPC and remit the case to the department of first instance for further

prosecution on the basis of the appellant's main request.

Alleged procedural violation

13. The appellant has alleged three deficiencies in the examination procedure which would amount to a substantial procedural violation warranting the reimbursement of the appeal fee.

13.1 Firstly, in the appellant's opinion, the refusal of the application was, *inter alia*, caused by the Examining Division's use of an "unsupported principle", *i.e.* the requirement that the technical problem as such had to be derivable from the application as filed. However, no such requirement could be based on the EPC or the Guidelines.

Secondly, the Examining Division had prompted, and subsequently contested, amendments based on its assumption that the DVD video standard was to be considered not public.

Thirdly, the Examining Division had refused all requests made during the oral proceedings based on a ground which had not been discussed during the oral proceedings.

14. As to the alleged use of an "unsupported principle", relating to the definition of the technical problem solved by the invention, the Examining Division acknowledged in paragraph 2.6.3 of the decision that the technical problem could be reformulated on the basis of technical effects derivable from the application as filed, in line with the Guidelines and the case law of the boards of appeal. However, the

Examining Division considered that the alternative problems, or the corresponding technical effects, suggested by the applicant, were not implied by, nor related to, the technical problem initially suggested. Furthermore, the corresponding technical effects, if any, involved hindsight or required features which were not recited in the independent claim.

In the Board's opinion, the conclusions of the Examining Division relating to the reformulation of the technical problem may be contested as being based on its particular reading of the original disclosure. However, they do not appear to be based on an "unsupported principle" of law.

14.1 As to the alleged second procedural deficiency, the Examining Division essentially took the view that, by removing from the application all references to the DVD standard, the term "video cell" was no longer unambiguously linked to this standard. This extended the meaning of the term "video cell" beyond what was disclosed in the application as originally filed (Article 123(2) EPC).

It may be argued that the Examining Division should have investigated further whether the term "video cells" was sufficiently explained in the application and/or known to the skilled person from sources other than "part III of the video specification". However, its conclusions with respect to Article 123(2) EPC did not follow from a severe misunderstanding of the EPC or of the Guidelines.

14.2 As to the third alleged deficiency, it appears from the minutes of the oral proceedings (see item 1) that this ground for refusing all requests was communicated to

the applicant at the beginning of the oral proceedings and that the applicant therefore had an opportunity for presenting its comments in this respect.

14.3 In summary, the reasons given by the Examining Division for refusing the application appear to be based on a certain interpretation of the disclosure and on the assumption that information relating to the DVD Standard was not available to the public. Although the Board agrees with the appellant that the Examining Division was wrong in refusing the application, its decision was, in the Board's opinion, imputable to an error of judgement, and not the consequence of the use of a new and unsupported principle.

14.4 However, an error of judgement, i.e. an incorrect application of the requirements of the EPC to the facts of the present case, does not mean that the department of first instance conducted the examination procedure in a clearly inappropriate manner and thus committed a substantial procedural violation sufficient to warrant the reimbursement of the appeal fee.

14.5 Since, in the Board's opinion, the contested decision is not tainted by a substantial procedural violation, one of the preconditions for ordering the reimbursement of the appeal fee under Rule 103(1)(a) EPC is not met.

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.

3. The request for reimbursement of the appeal fee is refused.

The Registrar: The Chairman:

I. Aperribay R. Moufang

Decision electronically authenticated