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Datasheet for the decision of 10 March 2016

Case Number: T 0105/11 - 3.5.07

Application Number: 05771127.7

Publication Number: 1776692

IPC: G11B7/00, G11B19/12

Language of the proceedings: EN

Title of invention:
Recording medium, method for recording control information in the recording medium, and method and apparatus for recording/ reproducing data in/from the recording medium using the same

Applicant:
LG Electronics Inc.

Headword:
Compatibility control information/LG ELECTRONICS

Relevant legal provisions:
EPC Art. 56, 113(2)
EPC R. 42(1)(c), 103(1)(a), 111(2), 140
RPBA Art. 11

Keyword:
Correction of errors in decisions - incorrect form
Admissibility of appeal - statement of grounds - filed within time limit (no) - protection of legitimate expectations (yes)
Basis of decision - text submitted or agreed by applicant (no)
Substantial procedural violation - appealed decision sufficiently reasoned (no)
Remittal to the department of first instance - fundamental deficiency in first instance proceedings (yes)
Reimbursement of appeal fee - (yes)

Decisions cited:
T 0026/81, T 0116/90, T 1176/00, T 1081/02, T 0830/03, T 0993/06, T 0130/07

Catchword:
See point 1 of the reasons.

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Case Number: T 0105/11 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 10 March 2016

Appellant: (Applicant)	LG Electronics Inc. 20, Yoido-dong Yongdungpo-gu Seoul 150-721 (KR)
Representative:	Vossius & Partner Patentanwälte Rechtsanwälte mbB Siebertstrasse 3 81675 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 29 July 2010 refusing European patent application No. 05771127.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	R. Moufang
Members:	R. de Man
	P. San-Bento Furtado

Summary of Facts and Submissions

I. The appeal relates to European patent application No. 05771127.7. The application was refused in oral proceedings held on 30 June 2010. The decision was subsequently put in writing and despatched on 29 July 2010.

II. With a letter dated 19 August 2010, the applicant (appellant) noted that point 3.1 of the grounds for the decision referred to a main request and an auxiliary request, but that no auxiliary request had been on file. It requested that the decision be corrected accordingly.

III. On 6 September 2010, the Examining Division re-issued the written decision with a new date and with point 3.1 of the grounds for the decision corrected.

IV. The appellant filed a notice of appeal, dated 21 September 2010 and received on 23 September 2010, directed "against the refusal of the European patent application No. 05 77 1127.7". It requested "that the Decision of September 6, 2010 be reversed and the patent be granted". It requested oral proceedings as an auxiliary measure.

V. A statement of grounds of appeal was filed and received on 7 January 2011. In it, the appellant requested "that the Decision of September 6, 2010 be reversed and the patent be granted based on the claim set as filed on May 25, 2010, which is identical to the claim set on which the Decision of September 6, 2010 is based". In case the Board could not agree to that request, the request for oral proceedings was maintained.

VI. In a communication pursuant to Rule 100(2) EPC dated 27 November 2015, the Board discussed both the admissibility and the allowability of the appeal. It indicated its intention to remit the case to the Examining Division for further prosecution and to order reimbursement of the appeal fee. The appellant was asked to indicate whether it wished to maintain its request for oral proceedings.

VII. With a letter dated 12 January 2016, the appellant consented to a remittal to the Examining Division without prior oral proceedings.

VIII. The Examining Division refused the application for lack of inventive step in the subject-matter of the independent claims in view of the following document:

D1: US-A-2003/223339.

IX. Page 1 of the grounds for the decision starts as follows:

"The examination is being carried out on the following application documents:

Description, Pages
1-30 as published

Claims, Numbers
1-40 received on 30-07-2009 with letter of 30-07-2009

Drawings, Sheets
1/10-10/10 as published"

X. Claim 1 of the claims filed with the letter of 30 July 2009 reads as follows:

"A recording medium comprising:

a data area; and

a management area for recording control information characterized in that the control information is capable of identifying write compatibility and read compatibility with a drive for recording or reading data on or from the recording medium,

wherein the control information includes a class number for identifying the read compatibility, and a version number for identifying the write compatibility, and

the write compatibility is determined using the version number when the read compatibility is allowable based on the class number, and the class number and the version number is in a same byte position."

XI. Claim 1 of the claims filed with the letter of 25 May 2010 reads as follows:

"A recording medium comprising:

a data area; and

a management area for recording control information characterized in that the control information is capable of identifying write compatibility and read compatibility with a drive for recording or reading data on or from the recording medium,

wherein the control information includes type information indicative of a type of the recording medium, a class number for identifying the read compatibility, and a version number for identifying the write compatibility, the class number is sequentially increased whenever physical attribute of the recording medium is changed to a predetermined range having no

read compatibility, the version number is sequentially increased whenever physical attribute of the recording medium is changed to a predetermined range having no write compatibility, and

wherein the type information indicates one of read-only recording medium, write-once recording medium or rewritable recording medium, the write compatibility is determined using the version number when the read compatibility is allowable based on the class number after specifying the type of the recording medium based on the type information, and the class number and the version number are in a same byte position."

Reasons for the Decision

1. *Admissibility of the appeal*

1.1 Once an examining division has taken a decision, in the absence of an admissible and allowable appeal it has no power to withdraw that decision and to take a new decision. The re-issuing of the (corrected) written decision on 6 September 2010 therefore does not invalidate the decision issued on 29 July 2010.

1.2 The re-issued decision was evidently intended as a response to the appellant's request for correction of an obvious mistake in the first written decision (Rule 140 EPC), but the form in which it was issued does not make this unambiguously clear. The Board need not decide whether the re-issued decision is legally void or whether, despite its deficient form and in particular the lack of a clear and correct indication of its nature and legal basis, it corrects the first written decision with retrospective effect and, hence, without changing its date (see decision T 116/90 of

3 December 1990, reasons 1). What matters is that, in either case, the date of notification of the decision refusing the application remains the date of notification of the first written decision.

1.3 In the notice of appeal, the appellant requested that the "Decision of September 6, 2010" be set aside. But in view of the further reference to "the refusal of the European patent application" and the appellant's request that "the patent be granted", there can be no doubt that the notice of appeal is to be understood as being directed against the decision refusing the application given in oral proceedings and posted on 29 July 2010.

1.4 Since the written decision of 29 July 2010 is deemed to have been notified on 8 August 2010 (Rule 126(2) EPC), the time limits for filing the notice of appeal and the statement of grounds of appeal laid down in Article 108 EPC expired on Friday, 8 October 2010 and on Wednesday, 8 December 2010, respectively. The notice of appeal was therefore received in time, but the statement of grounds of appeal was not.

1.5 Since the notice of appeal does not contain any statement indicating the reasons for setting aside the decision impugned as required by Article 108, third sentence, and Rule 99(2) EPC, the fact that the statement of grounds of appeal was filed out of time in principle has the consequence that the appeal is to be found inadmissible (Rule 101(1) EPC).

1.6 However, in several cases involving the issuing of a "second decision" by the department of first instance, the boards of appeal have held that an appeal which in principle would have to be rejected as inadmissible

should, in the circumstances of those cases, nevertheless be found admissible in view of the principle of the protection of legitimate expectations.

1.7 The circumstances of those cases were as follows.

In decision T 1176/00 of 23 July 2003, the EPO had sent a communication to the parties to the effect that the first written decision was withdrawn and that the corrected version would be issued as soon as possible. The board considered that the appellant in that case presumably had relied on this - legally incorrect - communication and that it would therefore conflict with the principle of protection of legitimate expectations to regard the appeal as inadmissible.

In decision T 1081/02 of 13 January 2004, the EPO had informed the parties that the first written decision had been issued erroneously and was to be considered void. This communication, although legally incorrect, had caused the parties to await the second written decision and consequently miss the original time limit for filing their appeals. Although both parties had been professionally represented and should therefore have been aware of the legal situation, the board considered that it would not be consistent with the principle of protection of legitimate expectations if the EPO's legally incorrect communication were allowed to negatively affect the appellants.

In decision T 830/03 of 21 September 2004, the EPO had informed the parties, after a notice of appeal had already been received, that the first written decision "was only a draft". This led the appellant to await a second written decision before filing a second notice of appeal and, outside the period of four months after

the date of notification of the first written decision but within the four months after notification of the second decision, a statement of grounds of appeal. Since the appellant had been misled, in application of the principle of protection of legitimate expectations the statement of grounds of appeal was deemed to have been filed within the time limit of Article 108 EPC.

In decision T 993/06 of 21 November 2007, the opposition division had issued two decisions dated 13 April 2006 and 22 May 2006, the second decision being accompanied by a communication containing the information "please find enclosed an Interlocutory Decision with a new date". The appellant-opponent filed a notice of appeal in due time, but filed a statement of grounds of appeal only within the four months after notification of the second decision. Since the opposition division and thus the EPO itself had caused confusion by issuing two decisions, regarding the appeal as inadmissible was considered to be in conflict with the principle of protection of legitimate expectations. The board in that case appears to have considered it relevant that the notice of appeal had been filed in time, so that the legitimate interests of the proprietor had been safeguarded.

In decision T 130/07 of 22 February 2008, the second written decision was accompanied by a communication stating that the first written decision was to be considered void. The appellant-opponent filed the notice of appeal and the statement of grounds only within the time limits with respect to the second written decision. The board noted that, by that time, a professional representative could have been aware of the relevant jurisprudence and have known that such "second decisions" changed neither the date of the

decision nor the period for filing an appeal. On the other hand it had to be noted that, despite this same jurisprudence, the EPO still proved incapable of avoiding the mistake of issuing "second decisions" with alleged new dates and alleged new time limits for appeal instead of unambiguous correction decisions as provided for by Rule 140 EPC. The board considered that applying the principle of protection of legitimate expectations did not infringe the legitimate interests of the proprietor, since the way the opposition division had handled the case had not given the proprietor ground to believe that the decision had become *res judicata*.

1.8 The present case may be distinguished from those discussed above in that the appellant explicitly requested that the written decision be corrected. Although the correction decision was still issued in an incorrect form and, when considered on its own, still suggested a new date and time limit, it appears that the professionally represented appellant should have been aware that the second decision intended to correct, as requested by the appellant itself, the first written decision under Rule 140 EPC.

1.9 In addition, in the cases discussed above the EPO had made explicit statements to the effect that the first decision was to be ignored. In the present case no such explicit statement was made. Although the form and the new date of the second written decision may well have confused the appellant, it could be argued that any such confusion was the result of an incorrect legal understanding of the meaning of a correction decision rather than reliance on an unambiguous statement made by the EPO.

1.10 Nevertheless, it is still imputable to the EPO that the second written decision was not correctly and unambiguously identified as a correction decision in the first place (cf. decision T 130/07, *supra*, reasons 1.9 and 1.10). The Board does not doubt that this explains why the appellant directed the notice of appeal and the statement of grounds of appeal against the "Decision of September 6, 2010" and filed them within two and four months, respectively, from that decision's date of notification.

1.11 For this reason, albeit not entirely without hesitation, the Board holds, in application of the principle of the protection of legitimate expectations, that the statement of grounds of appeal is deemed to have been filed in time.

1.12 Since the appeal also complies with the other provisions referred to in Rule 101 EPC, it is admissible.

2. *The invention*

The application relates to recording media and in particular to optical discs. The background section of the description explains that a variety of standard technical specifications are associated with various disc types. A recording or reproducing device suitable for a "low-version" (e.g. low-speed) disc may either fail to record or reproduce data in or from a "high-version" disc or incur unexpected errors in the recording or reproducing operations. When this happens, the device may fail to correctly diagnose the cause of the errors and attempt to repeat the recording or reproducing operations, possibly resulting in fatal system errors (see page 2, line 19, to page 3, line 4).

In order to solve this problem, the invention essentially proposes including read/write-compatibility information in the recording medium.

3. *The text forming the basis for the decision*

3.1 The communication annexed to the summons to oral proceedings before the Examining Division was based on claims 1 to 40 filed with the letter of 30 July 2009. With its letter of 25 May 2010, the appellant replaced these claims with amended claims 1 to 23. The decision correctly mentions this in point 1.7 of its facts and submissions.

However, page 1 of the grounds for the decision contains the statement that "[t]he examination is being carried out on" claims 1 to 40 filed with the letter of 30 July 2009. Furthermore, point 2.3 of its reasons refers to "claims 1, 9, 18 and 28", which correspond to the independent claims filed with the letter of 30 July 2009.

In addition, the first sentence of point 2.7 reads as follows:

"Finally, the appellant has latterly introduced into claim 1 the detail that 'the class number and the version number is (sic) in a same byte position'."

Claim 1 as filed on 30 July 2009 does indeed contain the feature "the class number and the version number is in a same byte position". Claim 1 as filed on 25 May 2010 on the other hand contains, among other amendments, the corrected feature "the class number and the version number are in a same byte position".

The decision hence contains several suggestions that it was based on claims 1 to 40 filed with the letter of 30 July 2009, i.e. on a text no longer approved by the applicant.

3.2 The reasons for the decision make only indirect reference to the claims filed with the letter of 25 May 2010 (referred to as "L3" in the decision) in the last two sentences of point 2.7:

"In L3, the applicant also introduced details regarding disk (recording) type information previously in dependent claims, all of which are known from the prior art. These details also failed to address the problem of inventive step."

In the Board's view, these two sentences at best create confusion as to whether the decision is based on claims 1 to 40 filed with the letter of 30 July 2009 and no longer approved by the applicant, or on claims 1 to 23 filed with the letter of 25 May 2010.

3.3 Contrary to the advice given in (now) point E-IX, 5 of the Guidelines for Examination in the EPO, the text of the (independent) claims was neither copied into the decision nor annexed to it. This text hence cannot be used to resolve the confusion.

3.4 It follows that the Examining Division has not unambiguously decided on a text submitted or agreed by the applicant, as required by Article 113(2) EPC. This constitutes a substantial procedural violation.

4. *The decision's reasoning*

4.1 The Examining Division refused the application for lack of inventive step in the subject-matter of the independent claims in view of document D1. Although point 1.1 of the grounds for the decision states that document D1 was published on 14 October 2004, which is after the priority date of the present application, its true publication date is 4 December 2003. Document D1 is hence prior art under Article 54(2) EPC.

4.2 In its decision, the Examining Division briefly discussed document D1, which it considered to be the closest prior art for the subject-matter of "claims 1, 9, 18 and 28". In point 2.4, it found the difference "between D1 and the matter of the application" to be "related only to reproducing and specifically that a device constructed according to an older standard cannot read a disk recorded according to a newer standard". It then focused on the problem of read incompatibility that, on the one hand, could not be and had not been solved and, on the other hand, did not plausibly exist.

4.3 A reasoned objection to lack of inventive step must explain why the skilled person, having regard to the prior art, would in an obvious manner arrive at the invention as defined by the claims. The reasoning should normally be based on the problem-and-solution approach as set out in the Guidelines for Examination, deviation from this approach being the exception (see Guidelines G-VII, 5).

4.4 If it is argued that the skilled person, starting from the closest prior art, would in an obvious manner arrive at the subject-matter of an independent claim,

then the reasoning should at least contain an analysis of the claims and of the closest prior art, with a view to determining which claim features are known in combination from the closest prior art and which are not. In the present case any such analysis is missing.

Although document D1 comprises ten pages of dense text and six sheets of drawings, the Examining Division has not identified a single passage to back up its assertions. In addition, with one exception (see point 4.9 below) the decision makes no reference to the actual features of any claim. As a consequence, what in the Examining Division's view is the "difference between D1 and the matter of the application" is not specified at the level of precision of the claim, but only loosely summarised as "relat[ing] only to reproducing and specifically that a device constructed according to an older standard cannot read a disk recorded according to a newer standard".

In the Board's view, this renders the decision insufficiently reasoned in violation of Rule 111(2) EPC, which constitutes a further substantial procedural violation.

4.5 The decision is unconvincing in further respects. For example, after summarising the problem to which the "difference" relates, point 2.4 of the decision continues as follows:

"But this is a problem to which there is no solution; presumably, if the player tries a few times and fails, its firmware will be clever enough to report 'blank disk' or 'bad disk' and eject it; it is difficult to see what the inclusion of read compatibility information will achieve which the drive (or the user)

will not be able to work out for itself i.e. that the disk is unreadable."

The Board notes that the inclusion of read-compatibility information evidently allows a player to quickly determine whether it is able to play the disk without having to try and fail. The inclusion of this information hence achieves a technical effect and consequently solves a technical problem in the sense of the problem-and-solution approach, namely that of modifying or adapting the closest prior art to achieve the effect (Guidelines G-VII, 5.2).

4.6 According to point 2.6 of the decision, the Examining Division required there to be "a plausible reason for the existence of read-compatibility problems". In point 2.8 it doubted that "the problem actually exists".

However, if a claimed invention is found to solve a technical problem, it is irrelevant whether or not that problem actually "exists" in the prior art. An invention may solve a problem that is not perceived as a "problem" in the ordinary sense of that word; the technical problem is to be understood as the task (in German: "Aufgabe") given to the skilled person. And an invention may solve a problem that in practice has not yet presented itself; even if at the filing date of the present application no read-compatibility problems existed in connection with then known optical media and optical media players, that would not generally invalidate verifying the read compatibility of optical media as a technical problem.

4.7 The Examining Division further noted in point 2.8 that read-compatibility information would only be available

to drives which were capable of reading it and understanding what it meant. Some older drives could undergo a firmware update, but that was not mentioned in the application.

While these observations are undoubtedly correct, they are no argument against the presence of inventive step.

4.8 Point 2.6 further mentions that "the existence of a label indicating that a disk required a particular class ... of read-compatibility ... is an obvious step to take, as has already been mentioned above". Yet none of points 2.1 to 2.5 give an argument in support of the stated obviousness of that step.

4.9 In point 2.7 of the decision, the Examining Division refers to a specific feature of (previous) claim 1. While this feature is said to "further enhance the novelty of the matter claimed", the Examining Division was apparently of the opinion that it could be ignored because "it is not explained what problem this is solving and neither is this clear from the description". However, if an application is refused for lack of inventive step, it is up to the Examining Division to give reasons why the skilled person, having regard to the prior art, would arrive at the claimed invention.

4.10 According to point 2.10 of the decision, if "a problem and solution are not clearly derivable from the application as filed", then "case law (T 26/81) indicates that the application must be refused".

Decision T 26/81 (OJ EPO 1982, 211) confirmed in its headnote that the requirement of Rule 27(1)(d) EPC 1973 (now Rule 42(1)(c) EPC) that "the invention should be

disclosed in such terms that the technical problem and its solution can be understood" is of a mandatory character. But it went on to say that "if it is accepted by an Examining Division that an independent claim defines a patentable invention, it must be possible to derive a technical problem from the application" and that the requirement of Rule 27(1)(d) EPC 1973 hence "cannot be set up as a separate formal criterion independent of inventiveness".

Rule 42(1)(c) EPC merely requires the invention to be presented in such terms that the technical problem and its solution can be understood. This is indeed a prerequisite for assessing inventive step in accordance with the problem-and-solution approach. The Board is not aware of any fundamental deficiencies of the present application that could reasonably prevent an examining division from applying to it the problem-and-solution approach as set out in detail in the Guidelines for Examination. The Board therefore sees no reason to suspect that Rule 42(1)(c) EPC might not be complied with (notwithstanding a possible need for amendment of the description in case amended claims are found to be allowable).

5. *Remittal to the department of first instance*

5.1 According to Article 11 RPBA, a board is to remit a case to the department of first instance if fundamental deficiencies are apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise.

Although the Board considers that the age of the present application is a factor to be taken into account, in view of the deficient reasoning of the

contested decision, which does not constitute a proper basis for examination of inventive step in these appeal proceedings, the Board will allow the appeal and remit the case to the Examining Division for further prosecution.

5.2 Since the substantial procedural violations found above form the immediate reason for the remittal, reimbursement of the appeal fee under Rule 103(1)(a) EPC is equitable.

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 appeal fee is to be reimbursed.

The Registrar: The Chairman:

I. Aperribay R. Moufang

Decision electronically authenticated