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**Datasheet for the decision
of 10 May 2017**

Case Number: T 1049/11 - 3.5.07

Application Number: 04737212.3

Publication Number: 1644919

IPC: G11B7/00

Language of the proceedings: EN

Title of invention:

Method of recording information on a multi layer record carrier, and device for recording on a dual layer record carrier

Applicant:

Koninklijke Philips N.V.

Headword:

Multi layer record carrier/KONINKLIJKE PHILIPS

Relevant legal provisions:

EPC Art. 83, 84, 123(2)

Keyword:

Admissibility of appeal - (yes)

Claims - clarity after amendment (yes) - support in the description (yes)

Sufficiency of disclosure - (yes)

Remittal to the department of first instance - (yes)

Decisions cited:

T 2111/13

Catchword:



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Case Number: T 1049/11 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 10 May 2017

Appellant: Koninklijke Philips N.V.
(Applicant) High Tech Campus 5
5656 AE Eindhoven (NL)

Representative: de Haan, Poul Erik
Philips International B.V.
Philips Intellectual Property & Standards
High Tech Campus 5
5656 AE Eindhoven (NL)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 12 November
2010 refusing European patent application No.
04737212.3 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman R. Moufang
Members: M. Jaedicke
P. San-Bento Furtado

Summary of Facts and Submissions

- I. The applicant (appellant) appealed against the decision of the Examining Division to refuse European patent application No. 04737212.3. The application was filed as international application PCT/IB2004/051045 and published as WO 2005/004117. The decision refers for its reasons to the communication dated 14 July 2010.
- II. In the course of the appeal proceedings, the applicant (appellant) changed its name from "Koninklijke Philips Electronics N.V." to "Koninklijke Philips N.V.".
- III. The Examining Division decided that the subject-matter of the independent claims of the sole request underlying its decision lacked clarity and support (Article 84 EPC) and that the invention was insufficiently disclosed (Article 83 EPC). The International Searching Authority had considered that the invention was so insufficiently disclosed that a meaningful search could not be carried out. During the examination proceedings, the Examining Division did not carry out a search or examine novelty and inventive step.
- IV. In the written proceedings, the Examining Division referred *inter alia* to the following document that was already cited in the application:

D5: WO 03/060895 published on 24 July 2003.
- V. With the statement of grounds of appeal, the appellant maintained its sole substantive request as main request and submitted an auxiliary request.

VI. In a communication under Article 15(1) RPBA accompanying a summons to oral proceedings, the Board expressed as its provisional opinion *inter alia* that the subject-matter of claim 1 of the main request contained added subject-matter and lacked clarity as it was defined by unclear expressions. As to the Examining Division's objections of lack of essential features and insufficient disclosure, the Board indicated that it tended to disagree with the contested decision. In the Board's preliminary opinion, a remittal to the Examining Division was necessary as a search had never been carried out.

The Board also introduced the following document mentioned as prior art in the application itself:

D6: Standard ECMA-267, "120mm DVD - Read-Only Disk", 3rd edition - April 2001.

VII. With a letter dated 6 April 2017, the appellant submitted a main request and first and second auxiliary requests replacing all prior requests. The appellant also requested "that different examiners are assigned" to the case if a remittal was unavoidable.

VIII. In a further communication, the Board expressed its preliminary opinion that the amended requests submitted by the appellant still lacked clarity and contained added subject-matter. Moreover, the fact that the Examining Division misjudged certain issues could not be a reason to order a changed composition of the Examining Division after a remittal. The Board referred *inter alia* to the following further documents:

D8: US2003/0002861 A1 published on 2 January 2003;

D9: US 6,151,281 published on 21 November 2000.

IX. In the course of oral proceedings, held as scheduled on 10 May 2017, the appellant filed an amended main request. At the end of the oral proceedings, the chairman pronounced the Board's decision.

X. The appellant's final requests were that the contested decision be set aside and that a patent be granted on basis of the main request submitted during oral proceedings before the Board or of one of the first to third auxiliary requests submitted as main, first and second auxiliary requests with letter dated 6 April 2017. The appellant also maintained its procedural requests that the Board should decide on inventive step and that, if the case had to be referred back to the first instance, different examiners should be assigned.

XI. Claim 1 of the main request reads as follows:

"Method of recording information on a recordable multi-layer record carrier, recordable meaning write-once or rewritable, said record carrier comprising a first information layer and a second information layer for storing information, the first and second information layers each comprising a data zone for recording the information and a further zone bounding the data zone on its outer diameter, wherein the further zones of the information layers are shifted towards the inner radius of the record carrier when the information is recorded such that an area containing the recorded information filling the data zone on the first information layer and an area containing the recorded information filling the data zone on the second information layer are of substantial [sic] equal size and such that both said

area's [sic] are superjacent."

Claims 2-5 are dependent on claim 1.

Claim 6 reads as follows:

"A recording device for recording information on a recordable multi-layer record carrier, wherein said device is operative for executing a method according to claim 1, 2, 3, 4 or 5."

The auxiliary requests are not relevant to the present decision.

XII. The appellant's arguments relevant to the decision are discussed in detail below.

Reasons for the Decision

Admissibility of the appeal

1. According to Rule 99(2) EPC, the statement of grounds of appeal should indicate the reasons for setting aside the decision impugned. If this requirement is not complied with before the expiry of the time period for filing the statement of grounds of appeal, the appeal is to be rejected as inadmissible (Rule 101(1) EPC). As the case law of the boards of appeal has made abundantly clear (see Case Law of the Boards of Appeal of the EPO, 8th edition 2016, IV.E.2.6.3 a), third paragraph), the appeal procedure is not a mere continuation of the examination procedure. Where the applicant in the grounds of appeal repeats its arguments set out during the examination phase without taking into account the decision under appeal, it mistakes the function of the boards of appeal. They are

not a second go at the examination procedure, but are meant to review decisions made by the examining divisions, based on the objections raised against the decision in the grounds of appeal, which must therefore in general relate to the reasons on which the decision under appeal is based.

- 1.1 In the present case, the appellant replied to the Examining Division's refutation of its submissions in the first instance proceedings by repeating to a significant extent previous assertions in the statement of grounds of appeal (see there section 3, pages 3 and 4; section 5, pages 5 to 8).

A mere repetition of previous assertions without addressing the particular reasons on which the decision was based can lead to the inadmissibility of the appeal. In certain exceptional circumstances, the appeal might nevertheless be admissible, in particular in special cases in which the repeated submissions already adequately address the grounds underlying the contested decision (see Case Law of the Boards of Appeal of the EPO, 8th edition 2016, IV.E.2.6.4 a), third and fourth paragraphs).

- 1.2 In the examination proceedings, the Examining Division and the applicant repeatedly exchanged arguments concerning essentially the same issues. The communication to which the contested decision referred repeated some of the Examining Division's objections made in earlier communications and the appellant was able to sufficiently address these objections in the statement of grounds of appeal by essentially repeating the arguments it had already submitted during the examination proceedings. Consequently, the present appeal is an exceptional case where the repeated

arguments in the statement of grounds of appeal meet the requirements of Rule 99(2) EPC.

- 1.3 Hence, the Board considers that the appeal complies with the provisions referred to in Rule 101 EPC and is therefore admissible.

The invention

2. The application relates to a method of recording information on a recordable multi-layer record carrier, i.e. a record carrier that is write-once or rewritable. On such a record carrier, the information to be recorded is stored in a data zone, which is a specific area on the information layer configured to record information content. The various areas are defined according to specific rules and layouts (formats).

According to the technical background explained in the application, recordable record carriers with two information layers were developed to increase storage capacity (page 1, lines 10 to 27, of the international publication). An example was the dual-layer DVD+R (Digital Versatile Disc - Recordable) disc known from document D5, which was in principle compatible with the standard ECMA-267 (see document D6).

However, the problem with such newly developed dual-layer record carriers was that the recorded discs could not always be reproduced without errors on players constructed for read-only record carriers, such as DVD-ROM (Digital Versatile Disc - Read Only Memory) players for which there was already a large installed base (see page 1, line 28 to page 2, line 2).

In particular, players for read-only discs became

confused during a layer jump, or focusing routine, when the read-out spot jumped to an unwritten (blank) data area on an information layer of the disc. As a consequence, the player likely rejected the disc. Such unwritten or blank areas occur when the information to be recorded does not fill the whole data zone, i.e. the amount of information to be recorded is smaller than the storage capacity of the combined data zones of the information layers.

While it was possible to solve the problem of confusion created by blank data areas by filling the data zone with dummy data (which is known in the context of single layer record carriers, see D8 and D9), this so-called "finalisation" took a considerable amount of time (up to an hour or more). Hence, this solution was inefficient and unacceptable for consumer applications.

The idea behind the invention is to avoid the need to fill blank areas in the data zone with dummy data by reducing the disc area of this zone to substantially the size of the information to be recorded per information layer and to align the data zones on the record carrier so that the data zones are superjacent. The invention achieves this reduction in the size of the data zone of at least two information layers of the disc by shifting a further zone bounding the data zone on the outer diameter of the disc towards the inner radius of the disc so that the fully written data zones on these layers are of substantially equal size and superjacent (see page 3, lines 6 to 19, and originally filed claim 1). Hence, the recording method according to the invention has the advantage that no time-consuming finalisation procedure has to be performed.

Main request - admission

3. Since the main request, submitted during the oral proceedings before the Board, was a legitimate response to the Board's objections under Articles 123(2) and 84 EPC expressed in its preliminary opinion and could be treated without adjournment of the oral proceedings, the Board admitted it into the appeal proceedings.

Main request - amendments

4. Compared with the claim underlying the contested decision, claim 1 of the main request was amended as follows:
 - (a) the expression "recordable meaning write-once or rewriteable" was added after "a recordable multi-layer record carrier";
 - (b) the feature that the first and second information layers "have a reflection level above 18%" was removed;
 - (c) the feature that the middle zones of the first and second information layers were shifted was replaced by features reciting that each of these information layers has a "further zone bounding the data zone on its outer diameter" and that these "further zones of the information layers are shifted";
 - (d) it was clarified that the information was recorded such that the areas containing the recorded information on the information layers were filling the data zone.

Main request - added subject-matter (Article 123(2) EPC)

5. The appellant submitted that amendment (a) was based on page 1, line 10, of the description and that amendment (b) was merely removing a non-essential feature that had been introduced by the appellant of its own volition during the examination proceedings. By removing the feature, the appellant was overcoming the Examining Division's objection that the feature lacked clarity.

Amendment (c) was based on the figures (in particular Figures 7 and 8 clearly disclosed that the shifting concerned only the control data; this was evident as the control data in the middle zone were presented in the figures in the same way as the control data in the "lead-in" and "lead-out" zones on the disc) and the description. The passage on page 4, lines 5 to 7, of the description made it clear to the skilled person that the inventive shifting of the boundary of the data zone also had to be applied to record carriers not conforming to the DVD-ROM standard as this standard did not disclose more than two layers on the same side of a disc. Amendment (d) was based on the description (see page 3, lines 6 to 11) and Figure 7 and addressed objections raised in the preliminary opinion of the Board.

6. The Board agrees with the appellant that the amendments have a basis in the application as originally filed. The skilled person would derive directly and unambiguously from the original application that the invention was neither limited to a dual-layer disc nor to DVD-ROM compliant discs nor to the Opposite Track Path DVD-ROM disc type. This is already clear from the originally filed claim 1, which is more general than claim 1 of the main request, and is explicitly stated

in the original description on page 4, lines 4 to 7.

The original application does not contain the expression "further zone bounding the data zone on its outer diameter". However, this technical feature is directly and unambiguously derivable from the original application. Figures 7 and 8 illustrate what is meant by "shifting the middle zone": the control information depicted on the left-hand side of the middle zone in these figures has been shifted to the left when compared with its usual position as in Figure 6, for example. In the figures, areas of the information layers containing control information (see the lead-in zone, the lead-out zone, and the middle zone) are hatched in the same manner in order to distinguish areas on the record carrier containing control information from areas containing information to be recorded or random data or blank areas. The skilled person knows that the control information in the middle zone in the Opposite Track Path disc type (see Figure 2B) has, at least with respect to the data zone, a similar function to that of the lead-out zone on the outer diameter of the Parallel Track Path disc type (see Figure 2A). Consequently, the skilled person understands that a function of the further zones containing control information is to bound the data zone on its outer diameter (see Figures 2A, 2B, 7 and 8; description, page 3, lines 6 to 11).

It follows that the claims comply with the requirements of Article 123(2) EPC.

Main request - clarity and support (Article 84 EPC)

7. The contested decision contains several objections under Article 84 EPC.

7.1 The first reason to refuse was that the expression "having a reflection level above 18%" was not clear.

As the objected to feature was removed in the claims of the main request, the objection is no longer relevant.

7.2 A second objection in the contested decision was that the feature "middle zone" did not have a recognized meaning in the general context of optical recording. As the expression "middle zone" is no longer used in claim 1, this objection is overcome.

7.3 In a further objection, the Examining Division said that it was not clear how an area could be shifted during recording. In the Board's opinion amendments (c) and (d) clarify this issue: the control information bounding the data is moved towards the inner radius of the disc (see Figures 7 and 8). Consequently, a skilled person understands that, in the context of claim 1, "shifting" means recording the control information bounding the data zone on the outer side at a position closer to the inner radius of the disc. Hence, the Examining Division's objection is not valid for amended claim 1 of the main request.

7.4 The Examining Division also objected to the fact that the term "recordable" was defined as once-recordable and rewritable on page 1, line 10, of the description. In general, "recordable" meant only once-recordable. Hence, this special meaning was not clear from the claim. The clarification by amendment (a) overcomes

this objection.

7.5 In section 3.3 of the communication to which the contested decision refers, the Examining Division objected that the following two essential features were not present in the independent claims and that the claims were not supported as prescribed by Article 84 EPC:

- (i) "the recordable multi-layer record carrier is a *dual layer* recordable DVD disc";
- (ii) "the result of the method of recording is a disc that is reproducible by the pre-existing DVD-ROM players" (according to the Examining Division the claimed method did not make technical sense without this feature as the then pending claims only defined features that made the recorded multi-layer carrier comply with one arbitrary alleged requirement of unspecified pre-existing DVD-ROM players).

7.5.1 According to the appellant, the Examining Division argued that "the invention could only be applied for solving the problem of dual-layer recordable discs with 'DVD-ROM compatibility'". The appellant disagreed as the application defined several problems for multi-layer record carriers and was not restricted to a dual-layer recordable DVD disc. The problem could also be derived from the effect stated in the application on page 3, lines 12 to 14. According to this passage, the invention solved the problem of avoiding a time-consuming finalisation procedure. Page 1, lines 23 to 27 of the description stated that a dual-layer DVD+R disc is in principle compatible with the dual-layer

DVD-ROM standard. The wording "in principle" was to be construed as meaning that physical parameters of DVD+R discs are in line with the DVD-ROM Standard. Although the contents of the "DVD-ROM Standard" were not necessary in order to be able to carry out the invention, the appellant did not share the view of the Examining Division that this standard was not available to the skilled person.

- 7.5.2 Feature (i) is not essential, as the examples with two layers can be applied to discs having more than two information layers as disclosed on page 4, lines 4 to 7, of the application and as the invention is clearly not limited to DVD discs for the reasons given in the following.
- 7.5.3 Feature (ii) is not essential either. While the description mentions a specific compatibility issue, feature (ii) demands that the disc is reproducible by pre-existing DVD-ROM players, which means that all compatibility issues with such players are solved. However, a skilled person would not understand the original application in this sense. The application is silent on aspects of compatibility such as the physical specifications of the disc, the file system or specific applications. Hence, the Board is convinced that a skilled person reading the application would immediately understand that the solution to the specific problem of confusion of players after jumps of the read-out spot to a blank data area does not depend on compatibility with the DVD-ROM specification in all aspects. Rather, the skilled person would understand that this problem results from the different technical capabilities of recording and playing devices with respect to unwritten data areas, as argued by the

appellant during the oral proceedings before the Board.

The application discloses on page 1, lines 2 to 4, that "the invention relates to a method of recording information on a dual layer DVD+R or DVD+R/W disc, such that it becomes compliant with the dual layer DVD-ROM Standard". Moreover, the application explains on page 1, line 28, to page 2, line 2, the problem "that the information recorded on a dual layer recordable DVD disc cannot always be reproduced on a DVD-ROM player without errors. This, so-called compatibility issue, is especially a problem since a large installed base of DVD-ROM players is already available all around the world." In the Board's view, these statements are to be understood as explaining the background and purpose of the invention. The application discloses on page 2, lines 26 to 29, in detail the particular "compatibility" problem that it actually solved: "However, during such a layer jump, or focusing routine, the read-out spot jumps to the blank data area. According to the DVD-ROM standard, data should be present here. Therefore, a DVD-ROM player will become confused and, most likely, reject the disc". The skilled person would understand from the cited passage and the technical solution disclosed on page 3, lines 6 to 11, that the invention addresses the specific compatibility problem of layer jumps and not all compatibility issues.

Finally, the skilled person would understand from original claim 1 and from the description page 2, lines 5 to 7, and page 4, lines 4 to 7, which explicitly refers to record carriers having more than two information layers, that the invention is not limited to DVD-ROM compatible discs as DVD discs have according to D6, section 7 (see page 4 and Figure 1 on

page 5), at most two information layers at an entrance surface.

7.5.4 Consequently, neither feature (ii) nor a limitation to DVD discs can be regarded as essential features of the method of claim 1.

7.6 Since the Board sees no further reason to doubt the clarity and support of the claims of the main request, it concludes that the claims meet the requirements of Article 84 EPC.

Main request - lack of sufficient disclosure (Article 83 EPC)

8. The Examining Division decided that the application did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. In particular, the application did not disclose how to record a dual-layer recordable DVD in such a way that it was reproducible by pre-existing DVD players as the DVD specifications were not publicly available.

9. The reasoning of the Examining Division starts from the assumption that the above-mentioned features (i) and (ii) would be missing essential features. However, as these features are not essential (see points 7.5 to 7.5.4 above) and as the present claims are silent on any compatibility with the DVD specifications, the reasoning of the Examining Division cannot be valid.

As it is clear from the claims that the invention is not limited to DVD technology in general or even to a particular dual-layer recordable DVD disc format, and as nowhere in the application is there any indication that recording media according to the invention must

comprise all features required by the DVD specifications for a recordable multi-layer carrier, and as the Examining Division did not identify any particular feature - apart from the allegedly essential features (i) and (ii) mentioned above - of the claimed invention which the skilled person would have been unable to carry out, the Board considers that the Examining Division's reasoning failed to show convincingly that the lack of publicly available dual-layer recordable DVD formats made it impossible to carry out the invention.

This argumentation is also applicable *mutatis mutandis* to the Examining Division's reasoning that the requirements imposed by pre-existing DVD-ROM players were not publicly known, so that the skilled person was unable to create a record carrier compatible with such existing DVD-ROM players. It is neither claimed nor indicated in the description that the invention would solve the problem of producing recording media compatible in all aspects with all existing DVD-ROM players. In the Board's opinion, the issue of compatibility with such DVD-ROM players is provided merely as motivation for the invention, in order to show the need for addressing the issue of jumps to blank areas when the medium is recorded (see above, point 7.5.3).

Finally, the Board points out that the DVD-ROM standard D6 publicly disclosed formats for the lead-in, lead-out, middle, and data zones (see sections 5 and 6 of D6).

As the Board is not aware of any other reason to doubt that the invention is sufficiently disclosed, it

follows that the claimed invention meets the requirements of Article 83 EPC.

10. The Board notes the arguments of the appellant against the non-public nature of the DVD standards (see statement of grounds of appeal, section 5). In particular, the appellant argued that anybody was able to obtain a copy of the DVD standard against payment and compliance with the non-disclosure requirements. The Examining Division was wrong to link the EPO's ability to obtain a copy for unrestricted dissemination to the public with the requirement for public availability.

While it is not necessary to decide that issue, the Board notes that Article 83 EPC requires the application to disclose the invention in a manner sufficiently clear and complete so that a person skilled in the art can carry out the invention. Hence, for the issue of sufficient disclosure, it is relevant whether a skilled person actually wishing to carry out the invention was able to obtain all necessary information for this purpose at the filing date. It might not be relevant for the examination of sufficient disclosure whether the information was obtainable for other purposes. Hence, the relevant question to be asked in the context of the DVD books might be rather whether any interested person wishing to carry out the invention for his own purposes was actually denied access by the DVD Forum to information necessary for carrying out the invention. Moreover, it is not sufficient to argue that access to some information was denied. Rather, it would be necessary to argue in detail in respect of specific features why the information to which access was denied was actually crucial for the implementation of the claimed

invention. The Board is not convinced that the DVD books were crucial information in the present case for the reasons given above.

In view of the above considerations, the Board has serious doubts that evidence of the EPO's inability to access the DVD books for the purpose of making them publicly available could be a sufficient basis for a valid objection under Article 83 EPC (even if the DVD books were considered as necessary information for the implementation of the claimed invention). As it is not necessary to answer this question in order to arrive at a decision, the Board leaves open its position on this issue.

Main request - remittal

11. The appellant requested the Board to rule positively on inventive step because a remittal would result in a further delay, which would be inappropriate in view of the age of the application. The Board considers that, in the present case, a full examination of novelty and inventive step is not appropriate as a search was never carried out for the application and novelty and inventive step have never been the object of substantive examination during the first instance proceedings.

Hence, 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. As claim 1 of the main request meets the requirements of Article 84 EPC and the invention is sufficiently disclosed, there is no reason why the claimed invention could not be searched. Therefore, the

further prosecution of the case before the first instance should start without further delay with the substantive examination of novelty and inventive step of the main request on the basis of a full search carried out by the Examining Division.

Procedural request to change the composition of the Examining Division

12. The appellant requested the Board to order that different examiners be allocated to this case after remittal. It argued that the first instance proceedings had been "hampered by [the invention] not being searched, long delays, and extensive arguments of the Examiner relating to availability and relevance of DVD knowledge". Moreover, the appellant argues that "a similar case (EP04770087) in the same field was similarly hampered, and decided in appeal T 1279/10 to be referred back to the first instance. Again, in the first instance (2nd round by the same examiner) arguments were raised regarding clarity on which the appeal had already decided. Finally, the case was refused in Oral Proceedings in 2016".
13. The Board is aware of decision T 2111/13 of 22 July 2014, according to which the boards of appeal do not have any power regarding the designation of the division responsible for the further prosecution of the case after remittal (see reasons point 8).
14. However, even if the Board had the necessary power, the Board believes that there would be no compelling case here for ordering a changed composition. While the Examining Division made errors of judgement, such errors could not, in the present case, be a sufficient reason to order a changed composition of the Examining

Division. The Board sees no procedural violation during the first instance proceedings of the present case and the appellant has not argued that there was such a violation.

15. It follows that the appellant's procedural request to change the Examining Division's composition for the further prosecution after the remittal cannot be allowed.

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:



I. Aperribay

R. Moufang

Decision electronically authenticated