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**Datasheet for the decision  
of 7 February 2017**

**Case Number:** T 1768/11 - 3.5.07

**Application Number:** 03774370.5

**Publication Number:** 1570477

**IPC:** G11B20/10

**Language of the proceedings:** EN

**Title of invention:**

Information storage medium and method of recording/reproducing  
the same

**Applicant:**

Samsung Electronics Co., Ltd.

**Headword:**

Information storage medium/SAMSUNG ELECTRONICS

**Relevant legal provisions:**

EPC Art. 84, 113(2), 123(2)

EPC R. 99(2)

RPBA Art. 12(4)

**Keyword:**

Admissibility of appeal - appeal sufficiently substantiated  
(yes)

Amendments - added subject-matter - all requests (yes)

Claims - clarity - all requests (no)

**Decisions cited:**

T 1178/08, T 1212/08, T 1108/10, T 0305/11

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 1768/11 - 3.5.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.07**  
**of 7 February 2017**

**Appellant:** Samsung Electronics Co., Ltd.  
(Applicant) 129, Samsung-ro  
Yeongtong-gu  
Suwon-si, Gyeonggi-do, 443-742 (KR)

**Representative:** Appleyard Lees IP LLP  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 28 March 2011  
refusing European patent application No.  
03774370.5 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman** R. Moufang  
**Members:** R. de Man  
M. Jaedicke

## **Summary of Facts and Submissions**

- I. The applicant (appellant) appealed against the decision of the Examining Division refusing European patent application No. 03774370.5, which was filed as international application PCT/KR2003/002627 and published as WO 2004/053870.
- II. The decision was issued as a so-called "decision on the state of the file" on EPO Form 2061 in response to a corresponding request by the appellant filed by letter of 8 March 2011. For the reasons for the refusal the form referred to the communications of the Examining Division dated 2 June 2008 and 7 December 2010.

The communication dated 2 June 2008 was based on the claims "as published". It cited documents D1, D2 and D3 and raised objections under Articles 54, 56 and 84 EPC.

The communication dated 7 December 2010 was based on claims 1 to 11 filed with the letter of 2 October 2008 and was annexed to a summons to oral proceedings. It cited a document D10 and raised the following objections:

- the feature added to claim 1 as published infringed Article 123(2) EPC;
- the same feature of claim 1 violated Article 84 EPC;
- claim 1 lacked an essential feature, contrary to Article 84 EPC;
- the subject-matter of claim 1 lacked inventive step over a combination of documents D10 and D3; and
- the same objection of lack of inventive step applied to the subject-matter of corresponding independent claims 5 and 9.

- III. With the statement of grounds of appeal, the appellant submitted a main request and first and second auxiliary requests.
- IV. In a communication accompanying a summons to oral proceedings, the Board questioned whether the statement of grounds of appeal was sufficiently substantiated and whether the newly filed requests should be admitted into the proceedings. It further expressed the preliminary view that independent claims 1, 5 and 9 of the main request and of the first auxiliary request and independent claim 5 of the second auxiliary request infringed Articles 84 and 123(2) EPC and that the subject-matter of the independent claims of each request lacked inventive step.
- V. With a letter dated 9 January 2017, the appellant filed an amended main request and amended first and second auxiliary requests and informed the Board that it would not be represented at the oral proceedings.
- VI. Oral proceedings were held on 7 February 2017 in the appellant's absence. At the end of the oral proceedings, the chairman pronounced the Board's decision.
- VII. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request or, in the alternative, on the basis of the claims of one of the first and second auxiliary requests. Alternatively, the appellant requested "allowance of the application based on such other claim set it approves that the Board of Appeal will allow" (see page 3 of the statement of grounds of appeal).

VIII. Claim 5 of the main request reads as follows:

"A method of recording information on and/or reproducing information from an information storage medium, the method comprising:

preparing a user data area in which user data is recorded and which has first sync patterns and an additional data area located in at least one of areas before and after the user data area; and

forming second sync patterns used in the additional data area which are different from the first sync patterns used in the user data area, characterised in that the information storage medium is a read-only information storage medium and the additional data area is configured for compatibility in different formatted information storage media."

Claim 5 of each of the first and second auxiliary requests is identical to claim 5 of the main request.

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

## **Reasons for the Decision**

### 1. *Admissibility of the appeal*

1.1 According to Rule 99(2) EPC, the statement of grounds of appeal is to indicate the reasons for setting aside the decision impugned. If this requirement is not complied with before expiry of the time limit for filing the statement of grounds of appeal, the appeal is to be rejected as inadmissible (Rule 101(1) EPC). For the statement of grounds of appeal to comply with

Rule 99(2) EPC, it should address in sufficient detail each of the grounds for the decision (see decision T 305/11 of 26 April 2016, reasons 1.1, and the decisions cited there). In principle, a ground for refusal can be addressed by arguing why the objection raised was incorrect or by amending the application and explaining why the objection is no longer relevant.

1.2 In the present case, one of the grounds for refusal is lack of inventive step in the subject-matter of independent claims 1, 5 and 9 of the set of claims filed with the letter of 2 October 2008. With the statement of grounds of appeal, the appellant amended these claims in accordance with a main request and first and second auxiliary requests and submitted arguments in support of inventive step. These arguments fully rely on the feature "the information storage medium is a read-only storage medium" added to independent claims 1 and 9 of each request. Independent claim 5 of each request, however, was identical to claim 5 of the set of claims filed with the letter of 2 October 2008 and did not include this feature. Hence, it could be argued that the statement of grounds of appeal fails to address the lack of inventive step objection raised against claim 5.

1.3 At the same time, it is apparent that the appellant, when preparing the statement of grounds and the replacement application documents, must have overlooked the fact that its claims included an independent claim 5 in addition to independent claims 1 and 9. In fact, not only did the appellant fail to add a limitation to a read-only storage medium to claim 5 of all requests, but it also forgot to apply to claim 5 of the two auxiliary requests any of the other amendments that it did make to independent claims 1 and 9 of those

requests. In its letter of 9 January 2017, the appellant confirmed that it had overlooked independent claim 5.

1.4 Thus, it is evident from the statement of grounds of appeal how the appellant intended to overcome the lack of inventive step objections raised against all independent claims. The Board considers, therefore, that the statement of grounds of appeal does address these grounds for refusal in sufficient detail.

1.5 As the statement of grounds of appeal also addresses the remaining grounds for refusal of the set of claims filed with the letter of 2 October 2008, namely by giving arguments why the objections under Articles 84 and 123(2) EPC were not justified, the appeal is sufficiently substantiated.

1.6 The appeal also complies with the other provisions referred to in Rule 101 EPC. It is therefore admissible.

## 2. *The decision under appeal*

2.1 According to the contested decision, the applicant was informed in the communications dated 2 June 2008 and 7 December 2010 of the reasons why the application did not meet the requirements of the EPC. This can only be taken to mean that the grounds for refusal are the objections raised in those two communications.

The communication dated 2 June 2008 was based on the claims (and other application documents) "as published" and contained objections under Articles 54, 56 and 84 EPC. By letter of 2 October 2008, the applicant replaced the claims as published with a set of amended



claims 1 to 11. The objections raised in the communication of 2 June 2008, which form part of the grounds for refusal, are thus based on a text that was no longer approved by the applicant. This is in violation of Article 113(2) EPC, which requires the EPO to decide on a European patent application only in the text submitted to it, or agreed by, the applicant.

2.2 In the present case it can be deduced from the file that the Examining Division intended to refuse the application for the reasons given in the communication dated 7 December 2010. That communication was self-contained and clearly identified both the text on which it was based and the objections being raised. Furthermore, it is apparent from the statement of grounds of appeal, which refers only to the "Summons dated 7 December 2010" and the objections raised therein, that the appellant had not been confused by the superfluous and incorrect reference to the communication of 2 June 2008. The Board therefore considers that, despite the fundamental character of Article 113(2) EPC, an immediate remittal to the Examining Division would serve no purpose.

3. *Admission of the main request and first and second auxiliary requests*

3.1 In its communication, the Board expressed concerns as to whether the main request and first and second auxiliary requests filed with the statement of grounds of appeal should be admitted into the proceedings under Article 12(4) RPBA. These concerns are still valid for the current main request and first and second auxiliary requests, which were obtained from the previous requests by including in claim 5 of each request a

feature specifying that the information storage medium is a read-only information storage medium.

- 3.2 The Examining Division's communication of 7 December 2010 was annexed to a summons to oral proceedings. By letter of 8 March 2011, the appellant responded by requesting "that instead of Oral Proceedings an appealable decision be issued based on the state of the file". The appellant neither commented on the substance of the communication of 7 December 2010 nor submitted amended claims.

After the Examining Division had issued the requested decision, the appellant filed the present appeal and, with its statement of grounds of appeal, replaced its sole substantive request with a new main request and first and second auxiliary requests.

- 3.3 Requesting a "decision on the state of the file" instead of responding in substance to objections raised in a communication may be a proper course of action where, for example, the applicant considers that the application is in an allowable state and all arguments have been sufficiently put forward (cf. Guidelines for Examination, E-IX, 4.4). But in the present case, the Examining Division's communication of 7 December 2010 had raised new objections and introduced a new prior-art document. Instead of responding to those objections with substantive submissions, the appellant chose to request a decision on the state of the file and to file an appeal. Only with the statement of grounds of appeal did the appellant, for the first time, respond in substance to the Examining Division's new objections.

- 3.4 According to Article 12(4) RPBA, a board of appeal has the power to hold inadmissible facts, evidence or

requests which could have been presented or were not admitted in the first-instance proceedings.

This provision reflects the principle that appeal proceedings are not intended as a continuation, let alone a replacement, of the first-instance proceedings. Parties to EPO proceedings are not at liberty to forgo the proceedings before a department of first instance and take their case directly to a board of appeal for further prosecution. They can rely on the boards of appeal for a judicial review of the first-instance decision, not for a continued full examination of the merits of the application.

3.5 Upon receiving the Examining Division's summons to oral proceedings, the appellant was in the same position as later when it filed the statement of grounds of appeal; the decision to refuse the application merely confirmed the objections previously communicated. Thus the appellant should have realised that the newly raised objections necessitated the filing of amended requests. It also had the opportunity to file such requests before the date fixed by the Examining Division under Rule 116 EPC. Yet it refrained from doing so. It appears that the appellant preferred to discontinue the still-ongoing proceedings before the Examining Division and to prosecute its case instead directly before the Board. But Article 12(4) RPBA is intended to prevent just that.

3.6 Thus, the present case is one where the appellant could - and should - have presented its new requests in the first-instance proceedings, and consequently the Board may exercise its power under Article 12(4) RPBA to hold them inadmissible (see also decisions T 1212/08 of 13 January 2012, reasons 4.1 to 4.7; T 1108/10 of

9 March 2012, reasons 3.2.1 to 3.2.5; and T 1178/08 of 9 May 2012, reasons 2.6 to 2.6.4). Nevertheless, since the requests now on file present the Board with no difficulties, it decides to exercise this discretionary power in the appellant's favour and to admit them into the proceedings.

4. *The invention*

The invention is related to an information storage medium and a method of reproducing information recorded thereon. As explained in the background section of the application, a known recordable information storage medium such as a CD-R or a CD-RW includes user data areas and additional areas serving as spare areas located before and after the user data areas (page 1, last paragraph, to page 2, first paragraph, of the published application). To improve the ability of reproducing systems to differentiate between additional data areas and user data areas, the invention proposes including second sync patterns in the additional data areas which are different from first sync patterns included in the user data areas (page 3, last paragraph, to page 4, second full paragraph). The invention as presently claimed is limited to a "read-only storage medium".

5. *All requests - added subject-matter and clarity*

5.1 Claim 5 is identical in all requests and includes the feature "the additional data area is configured for compatibility in different formatted information storage media". As a basis for this feature, the appellant relies on the phrase "can maintain consistency with the formats of different types" appearing on page 9, lines 1 to 5, of the published

application and in the paragraph bridging pages 7 and 8.

5.2 The passage on page 9, lines 1 to 5, follows the heading "Industrial Applicability" and is one of the closing paragraphs of the description. It reads as follows:

"As described above, an information storage medium and a method of recording information thereon and/or reproducing information therefrom according to the present invention can maintain consistency with the formats of different types of recordable information storage media and have reproduction compatibility in a drive."

In the Board's view, this passage does not disclose any further technical limitation of the information storage medium described earlier in the application. And it evidently does not refer to any "additional data area" and so cannot be interpreted as meaning that "the additional data area" has a particular property.

The paragraph bridging pages 7 and 8 states that the information storage medium "can include the CD-Rs, CD-RWs, DVD-RWs, DVD-RAMs, DVD+RWs, as well as next generation high definition DVDs, such as Blu-ray discs, Advanced Optical Discs (AODs) and other optical storage media not listed above and/or to be developed". This paragraph, too, does not disclose any specific limitation of the "additional data area".

Since the Board has not been able to identify any other passage in the application as filed that could serve as a basis for the feature, it considers that the subject-

matter of claim 5 extends beyond the content of the application as filed.

- 5.3 In addition, it is unclear what is meant by compatibility "in" different formatted information storage media. It is also not clear whether it is "the additional data area" that is made compatible or the information storage medium that includes the additional data area.

Furthermore, even if the feature were to be interpreted contrary to its wording as meaning that the information storage medium is somehow compatible *with* other (known?) types of information storage media, the claim would remain unclear both because those other types are left completely unspecified (apart from being "different") and because the claim fails to state in what precise technical sense they are "compatible" and by what specific technical measures that compatibility is achieved. In this respect, the appellant's arguments that "compatibility simply means it can work with others and different information storage media just means ones that are simply different" fail to persuade the Board.

- 5.4 Hence, the main request and the first and second auxiliary requests infringe Articles 123(2) and 84 EPC.

6. As to the appellant's request for "allowance of the application based on such other claim set it approves that the Board of Appeal will allow", it is not the Board's task to formulate the appellant's claims.

7. *Conclusion*

Since none of the requests on file is allowable, the appeal is to be dismissed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



A. Vottner

R. Moufang

Decision electronically authenticated