

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 30 June 1998

Case Number: T 0955/93 - 3.3.1
Application Number: 85308585.0
Publication Number: 0183528
IPC: G03C 5/16
Language of the proceedings: EN

Title of invention:
Color photographic element

Patentee:
MINNESOTA MINING AND MANUFACTURING COMPANY

Opponent:
Fuji Photo Film Co., Ltd.

Headword:
-

Relevant legal provisions:
EPC Art. 56, 108, 123(2)
EPC R. 64, 65(1)

Keyword:
"Appeal of Opponent admissible (no) - Statement of Grounds not filed - no challenge of the maintenance of the patent as amended in accordance with the interlocutory decision"
"Inventive step (no) - foreseeable improvement of properties"
"Amendment - not directly and unambiguously derivable from the application as filed"

Decisions cited:
G 0009/91, G 0002/92, T 0001/80, T 0019/81, T 0022/81,
T 0024/81, T 0119/82, T 0099/85, T 0229/85, T 0248/85,
T 0249/88, T 0288/92, T 0680/93, T 1053/93

Catchword:



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

47

Case Number: T 0955/93 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 30 June 1998

Appellant 1:
(Opponent)

Fuji Photo Film Co., Ltd.
26-30, Nishiazabu 2-chome, Minata-ku
Tokyo 106 (JP)

Representative:

Hansen, Bernd, Dr. Dipl.-Chem.
Hoffmann, Eitle
Patent- und Rechtsanwälte
Postfach 81 04 20
D-81904 München (DE)

Appellant 2:
(Proprietor of the patent)

MINNESOTA MINING AND MANUFACTURING COMPANY
3M Center
St. Paul
Minnesota 55101 (US)

Representative:

Bowman, Paul Alan
LLOYD WISE, TREGEAR & CO,
Commonwealth House
1-19 New Oxford Street
London WC1A 1LW (GB)

Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office posted
30 August 1993 concerning maintenance of European
patent No. 0 183 528 in amended form.

Composition of the Board:

Chairman: A. J. Nuss
Members: R. Freimuth
W. Moser

Summary of Facts and Submissions

I. The Appellant 1 (Opponent) and the Appellant 2 (Proprietor of the patent) lodged an appeal against the interlocutory decision of the Opposition Division posted on 30 August 1993 which found that European patent No. 183 528 in the form as granted did not satisfy the requirements of the EPC, but that it could be maintained in the form as amended during opposition proceedings according to an auxiliary request.

II. Notice of Opposition had been filed by Appellant 1 requesting revocation of the patent as granted for lack of inventive step based inter alia on documents

(1) JP-A-59/22049, considered in the form of its partial English translation,

(4) US-A-2 968 556 and

(5) GB-A-1 450 595.

III. The Opposition Division decided that embodiment 2) comprised in independent claims 1 to 3 of the patent as granted, i.e. the incorporation of a filter layer between two infrared-sensitive layers, did not involve an inventive step in view of documents (1) and (4). Independent claim 3 of the patent as granted read as follows:

"3. A photographic element capable of providing a full color image with exposure of at least two silver halide emulsion layers to radiation within the infrared region of the electromagnetic spectrum comprising

- a) a substrate, and
- b) on one side of said substrate at least three silver halide emulsion layers, each of said silver halide emulsion layers being associated with a means for providing a different color dye image,

said three silver halide emulsion layers comprising, a first emulsion sensitized to a portion of the infrared region of the electromagnetic spectrum, a second emulsion sensitized to a portion of the infrared region of the electromagnetic spectrum which is of a shorter wavelength than the portion to which said first emulsion is sensitized, and a third emulsion sensitized to a portion of the electromagnetic spectrum which is of a shorter wavelength than the portion to which said second emulsion is sensitized, and said three silver halide emulsion layers having a construction selected from the group consisting of:

- 1) each of the three layers having a contrast between 2 and 8 and the first two layers differing from each other in photographic speed such that, at an optical density of 1.3, the speed of the second emulsion layer, is at least 0.2 logE units faster than the first emulsion layer, and
- 2) between said first and second emulsion layers is a filter layer absorbing infrared radiation in a range overlapping the region of maximum sensitivity of said second emulsion layer without absorbing more than forty percent of the infrared radiation to which said first emulsion layer is sensitized."

The Opposition Division held that photographic materials comprising two out of three light-sensitive layers which are sensitized to the infrared region of the spectrum, were well known to the skilled person

from document (1), particularly page 8, paragraph 2. When solving the problem of colour separation of infrared-sensitized emulsion layers, the skilled person would look at document (4) teaching the use of filter layers between light-sensitive layers which are sensitized to the visible region of the spectrum. According to document (4), colour separation was improved by these filter layers. The Opposition Division considered it to be obvious to the skilled person that the same method would have been applied also to improve the colour separation of infrared-sensitized emulsion layers.

On the other hand, the Opposition Division decided that Appellant 2's auxiliary request, in which this embodiment 2), i.e. the incorporation of a filter layer between two infrared-sensitive layers, had been deleted in all claims and the description, would satisfy the requirements of the EPC.

- IV. Oral proceedings were held on 30 June 1998.
- V. Appellant 2 lodged an appeal on 5 November 1993 and paid the prescribed appeal fee simultaneously. In his Statement of Grounds of Appeal filed on 28 December 1993, Appellant 2 accepted the Opposition Division's analysis of document (1) and the fact that a person skilled in the art would start from this document. However, he pointed out that it was an essential feature of document (1) that there were no overlapping sensitivities between the light-sensitive layers, and that, as a consequence, there was no indication as to how to achieve colour separation in the event the photosensitivities of layers overlapped. Appellant 2 submitted that the dyes available to sensitize the emulsions to the infrared region provided a broad sensitization with a broad tail of sensitization stretching up to 300 nm on the shorter wavelength side of the peak of maximum sensitization and a narrow tail

up to 70 nm on the longer side. With regard to photographic material in the visible region, he accepted that filter layers had been employed above light-sensitive layers to absorb unwanted radiation. However, in the visible region, such filter layers were equivalent to light shutters or masks blocking a selective wavelength band of light whilst being transparent to the exposing wavelength of the light-sensitive layer underneath the filter layer. Appellant 2 argued that in the visible region there were no problems with a filter layer interfering with the desired exposure of the light-sensitive layer protected by the filter layer. The person skilled in the art would automatically discount the possibility of employing filter layers in the infrared region for the purpose of colour separation, because he would know that it would be impossible to obtain a filter dye not interfering with the radiation required for exposing the infrared-sensitive underlayer. This interference would have the effect of decreasing the sensitivity of the infrared-sensitized underlayer and would disrupt the colour balance of the material. Appellant 2 considered that the use of filter layers in the infrared region was not an obvious choice since the problems of sensitization and selection of filter dyes in the infrared were not comparable. Furthermore the filter dyes had to meet various requirements as indicated in document (4) in column 1, lines 55 to 59 and document (5) on page 1, lines 20 to 23. This view was supported by the fact that all the documents cited in the proceedings, particularly document (4), were published before document (1). Nevertheless, the inventors of the subject-matter of document (1) did not introduce a filter layer between infrared-sensitive layers. Appellant 2 agreed during oral proceedings that he did not base any inventive ingenuity on the upper limit of forty percent of the absorption by the filter layer of that infrared radiation to which the light-sensitive layer underneath was sensitised.

Appellant 2 submitted furthermore that the inventors, when controlling the exposure conditions of the individual layers, found that the employed filter layers using available materials did not act as a simple light shutter comparable to the filter materials used in the visible region, but had the additional effect of altering the speed of the infrared-sensitive layer beneath the filter. He argued that the use of filter layers in this manner was not suggested in the prior art. Without the correct formulation of the problem confronting the inventors and without the analysis of the available filter materials, there had been no incentive to use filter layers between infrared-sensitive layers. Referring to the Guidelines for Examination in the EPO, part C, Chapter IV in general, the Appellant 2 alleged that inventive step may be present in the formulation of a problem to be solved, the solution being obvious once the problem was clearly stated. The fact that with hindsight the infrared photographic material containing filter layers appeared to be conventional was misleading.

Subsidiarily, Appellant 2 amended claims 1 to 3 such that the filter layers absorb infrared radiation to which the underlying emulsion layer is sensitized (auxiliary request). The feature inserted into claim 3 and defining the filter dyes read as follows:

"and absorbing infrared radiation to which said first emulsion layer is sensitised"

Although he admitted that this feature was not disclosed on a "word for word basis" in the application as filed, he argued that it was implicitly referred to in the description and the examples disclosed in the patent specification, particularly examples 5 to 7 on page 16, lines 44 and 45 and examples 8 to 10 on page 18, lines 36 and 37. This feature reflected therefore no more than the absorption properties of the

available filter dyes. He submitted that these claims excluded the "idealised" situation wherein the filter dyes absorbed no light to which the underlying layer is sensitized, and thus overcame an inventive step objection in the decision under appeal.

Having regard to Appellant 1's appeal, Appellant 2 objected to the lack of grounds for appeal as required by Article 108 EPC. Pursuant to Rule 65(1) EPC it should therefore be rejected as inadmissible. He noted that in the light of the decision of the Enlarged Board of Appeal G 9/92, where an admissible appeal is only filed on behalf of the Proprietor, no further objections may be raised by the Opponent to the maintenance of the patent in amended form as previously upheld by the Opposition Division.

VI. Appellant 1 lodged an appeal on 2 November 1993 and paid the prescribed appeal fee simultaneously. In response to the communication of the Board's Registrar that a Statement of Grounds for Appeal was not filed within the time limit laid down in Article 108 EPC, he did not substantiate his appeal.

During oral proceedings, Appellant 1 submitted that document (1), particularly page 8, paragraph 2, was to be regarded as the closest prior art. The reference in document (1) referred to by Appellant 2 that there were no overlapping sensitivities between the light-sensitive layers, represented an ideal situation which, in technical reality, could not occur since the available infrared-sensitizing dyes showed a broad sensitization necessarily causing some overlap. The skilled person therefore could not escape the problem of poor colour separation. Document (4) taught to incorporate filter layers between light-sensitive layers in the visible region in order to improve colour separation. Nothing had discouraged the skilled person from projecting this teaching to the infrared region,

since both visible and infrared light showed strong similarities. The alleged effect of altering the speed of the infrared-sensitive sub-layer was merely an insight gained after incorporation of the filter layer. Therefore the subject-matter claimed did not involve an inventive step.

Having regard to the amendment of the claims according to Appellant 2's auxiliary request, Appellant 1 argued that it was not unambiguously disclosed in the application as filed. The amendment represented a generalisation of specific examples. Moreover, these examples referred to speed differences of infrared-sensitive layers, and not to the specific absorption properties of the filter dyes now introduced into the claims. A correlation of speed differences with absorption properties was not disclosed in the application as filed.

VII. Appellant 1 requested that the appeal of Appellant 2 be dismissed.

Appellant 2 requested that the decision under appeal be set aside and the patent in suit be maintained in the form as granted (main request) or that the patent in suit be maintained on the basis of the set of claims filed on 28 December 1993 (auxiliary request).

VIII. At the end of oral proceedings the Board announced its decision to reject the appeal of Appellant 1 as inadmissible and to dismiss the appeal of Appellant 2.

Reasons for the Decision

1. *Admissibility*

1.1 Appellant 1 lodged an appeal within the time limit of Article 108 EPC, first sentence; he did not file a written statement setting out the grounds of appeal as stipulated in Article 108 EPC, last sentence. Therefore that appeal has to be rejected as inadmissible pursuant to Rule 65(1) EPC in conjunction with Article 108 EPC.

1.2 The appeal of Appellant 2 complies with Articles 106 to 108 EPC and with Rules 1(1) and 64 EPC; it is admissible.

2. *Scope of Appeal*

Since the appeal of Appellant 1 is not admissible, neither the Board nor Appellant 1 may challenge the maintenance of the patent in suit as amended in accordance with the interlocutory decision under appeal (see decision of the Enlarged Board of Appeal G 9/92, OJ EPO 1994, 875, point 14 of the reasons). Thus, submissions of Appellant 1 may only be taken into consideration insofar as they relate to the requests filed by Appellant 2.

Main Request

The only issue to be decided in this appeal having regard to Appellant 2's main request is whether its rejection for lack of inventive step by the Opposition Division is to be upheld or not.

3. *Inventive step*

3.1 The embodiment 2), i.e. the incorporation of a filter layer between two infrared-sensitive layers, is comprised in independent claims 1 to 3. These three

independent claims concern a photographic element having at least three light-sensitive layers; according to claim 1, all these three layers are infrared-sensitive, according to claims 2 and 3, only two of them. According to claims 1 and 2, the layers are arranged in a specific order, according to claim 3, in any order relative to the substrate. Claim 3 being the claim with the broadest scope, the Board will assess first whether the subject-matter of that claim involves an inventive step.

3.2 According to Article 56 EPC an invention shall be considered to involve an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. According to the established jurisprudence of the Boards of Appeal it is necessary, in order to assess inventive step on an objective basis, to identify the closest state of the art, to determine in the light thereof the technical problem which the invention addresses and solves, and to examine the obviousness of the disclosed solution to this problem in view of the state of the art (see e.g. decisions T 1/80, OJ EPO 1981, 206, points 3, 6, 8, 11 of the reasons; T 24/81, OJ EPO 1983, 133, point 4 of the reasons; T 248/85, OJ EPO 1986, 262, point 9.1 of the reasons). This "problem-solution approach" avoids assessing inventive step in a subjective manner, as reflected in Appellant 2's hypothetical question why the inventors of the subject-matter disclosed in document (1) did not envisage the claimed invention, i.e. to introduce a filter layer between infrared-sensitive layers.

3.3 In accordance with this approach, in a first step the closest state of the art is to be established.

3.3.1 The patent in suit refers to photographic elements capable of providing a full colour image with exposure of at least two silver halide emulsion layers to

radiation within the infrared region of the electromagnetic spectrum. This kind of photographic element already belongs to the state of the art. Document (1) discloses in claim 1 in combination with page 8, paragraph 2 a photographic element comprising three light-sensitive silver halide emulsion layers, one being sensitized to visible red light and the two others to different regions of the infrared. This analysis of document (1) has been accepted by Appellant 2.

The Board considers, in agreement with the parties, that this disclosure of document (1) represents the closest state of the art, and, hence, the starting point in the assessment of inventive step.

3.3.2 Appellant 2 pointed to the teaching on page 8, paragraph 2 of document (1) that "photosensitivities are set in three ranges which do not overlap with each other from the visible range above 500 nm to the infrared range, ...". He interpreted this disclosure as teaching that **any** overlap of the photosensitivities between each of the different light-sensitive layers is completely excluded. However, Appellant 2's interpretation is not supported by the wording of this teaching. When interpreting a specific teaching in a document belonging to the prior art, it should be read in the context of the whole document and be consistent with further technical facts submitted by Appellant 2 himself.

As to the context, document (1) teaches in claim 1 as well as on page 5 that the **maximum** photosensitivities should be different in each of the light-sensitive layers. On page 8, paragraph 2 the ranges for the different photosensitivities are specified, i.e. 600-700 / 700-800 / 800-1000 nm. In the context of the whole teaching of document (1), the skilled reader would therefore understand the specific teaching on

page 8, paragraph 2 of document (1), addressed by Appellant 2, to mean that the **maximum** photosensitivities should be within the specified ranges, and that these ranges of (maximum) photosensitivities should be different in each of the light-sensitive layers, i.e should not overlap.

As to consistency with further technical facts, Appellant 2's interpretation of the teaching of document (1) is not in line with his submissions in the Statement of Grounds for Appeal on page 2, paragraph 1. Here he stated that these infrared sensitivities of the layers have a long tail of up to 300 nm to the shorter wavelengths of the maximum peak and up to 70 nm to the longer wavelengths. He emphasized that "when sensitizing two or more layers of material to the infrared, there will **invariably** be overlap between the sensitivities of the layers leading to the problem of poor colour separation" (emphasis added). This submission was supported by Appellant 1 during oral proceedings as reflecting technical reality in the sense that the available infrared-sensitizing dyes show a broad sensitization causing "invariably", i.e. unavoidably, some overlap of the photosensitivities of the different infrared-sensitive layers which gives rise to poor colour separation. The Appellant 2's interpretation of the teaching on page 8, paragraph 2 of document (1) is inconsistent with that.

3.3.3 Therefore, the Board is not convinced by the Appellant 2's interpretation of document (1) in this respect. The Board takes the view that there is some overlap of the photosensitivities of the different infrared-sensitive layers in the photographic element of document (1), leading invariably to the deficiency of poor colour separation.

3.4 The objective problem underlying the patent in suit lies, thus, in overcoming the deficiency of the closest

prior art document (1), i.e. poor colour separation. It is identified in the patent specification as aiming at providing a construction of the layers that prevents or reduces the exposure of layers by radiation intended to expose only one other layer (page 2, lines 39, 40), that is to improve colour separation.

- 3.5 The patent in suit suggests, as the solution to this problem, to incorporate between the two infrared-sensitive layers a filter layer absorbing infrared radiation in a range overlapping the region of maximum sensitivity of the upper emulsion layer without absorbing more than forty percent of the infrared radiation to which the emulsion layer underneath is sensitized (see point III above).

In view of Appellant 2's declaration during oral proceedings that the upper limit of forty percent is not intended to provide any inventive ingenuity, this feature is disregarded in assessing inventive step (see decision T 22/81, OJ EPO 1983, 226, points 5.1 and 7 of the reasons).

- 3.6 The specification of the patent in suit demonstrates e.g. in examples 2 and 3, that the claimed invention achieves improved colour separation. According to page 9, line 58 to page 10, line 5 and page 10, lines 18 to 22 of that specification, full density colour and pure colour separation is achieved in the presence of a filter layer between the infrared-sensitive layers; in its absence, however, no pure colour separation was observed. Thus, the Board is satisfied that the problem underlying the patent in suit has been successfully solved. This finding has not been challenged by Appellant 1.

- 3.7 It remains to be decided whether or not embodiment 2) as claimed involves an inventive step.

3.7.1 It is a matter of course that the skilled man seeking to improve colour separation of the photographic elements of document (1) would turn his attention to that prior art in the photographic field dealing with the same technical problem. Appellant 2 accepted in his Statement of Grounds of Appeal on page 2, paragraph 4 that photographic elements in the visible region employing filter layers above light-sensitive layers to absorb unwanted radiation belong to the state of the art. For example document (4) deals with photographic elements in the visible region and teaches that colour separation can be improved by the appropriate selection of filter layers incorporated between light-sensitive layers (column 1, lines 19 to 42; column 2, lines 8 to 15). A filter layer absorbing green and positioned between a green- and a red-sensitive layer reduces the undesirable green sensitivity of the red-sensitive sub-layer. The red-sensitivity of the sub-layer is "satisfactorily obtained", i.e. the red light passes through the filter layer (column 2, line 35; figures 1 and 3).

The Board concludes from the above that the state of the art gives the man skilled in the art a concrete hint on how to solve the problem underlying the patent in suit as defined in point 3.4 above, namely by incorporating a filter layer between light-sensitive layers which absorbs in the range of the light-sensitive upper layer and lets through the radiation for the light-sensitive layer underneath, i.e. the solution proposed by the patent in suit. The fact that document (4) refers to visible and the patent in suit to infrared light, i.e. two wavelength ranges of light adjacent to each other, does not alter this conclusion. This is in line with the fact that Appellant 2 did not present any argument based on the wavelength as such. The skilled man, aware of the improved colour separation taught in document (4) for visible light, would not have restricted the known teaching to the

visible region, but would have tried to apply it likewise in the infrared region, since the same (physical) principles apply to both regions of light.

3.7.2 Appellant 2 emphasised in his Statement of Grounds of Appeal that "a man skilled in the art would **automatically discount** the possibility of employing filter layers in the infrared region for the purpose of colour separation". This submission amounts to the allegation that a prejudice existed preventing the skilled person from following the teaching of document (4). However, the party who wishes to rely on a prejudice has the onus of proving its existence (see decision T 119/82, OJ EPO 1984, 217). Furthermore, in the absence of corroborating evidence, this allegation cannot be accorded the necessary general validity (see decision T 19/81, OJ EPO 1982, 51). Appellant 2 satisfied neither of these two requirements. Therefore, the Board is unable to agree with the argument submitted by Appellant 2.

3.7.3 The Board concurs with the argument of Appellant 2 that there may have been some difficulties for the skilled person to find and to select suitable filter dyes in the infrared region, due for example to some interference of the filter dye with the wavelength radiation required to expose the infrared-sensitive sub-layer, or to the various requirements to be met by a filter dye (cf. documents (4), column 1, lines 55 to 59, and (5), page 1, lines 20 to 23).

However, embodiment 2) as defined in claim 3 defines the filter layer exclusively by its effect to be achieved, specific filter dyes not being indicated in the claim. The use of a functional definition of the filter layer in the claim indicates that the skilled man is aware of and able to choose suitable filter dyes by routine tests. Moreover the patent specification indicates on page 8, lines 1 to 5 filter dyes to be

materials well known to the photographic chemist and identifies prior art documents disclosing suitable filter dyes. Additionally, the subject-matter of embodiment 2), for which protection is sought, is formulated such that it encompasses filter layers transparent to, i.e. not interfering with, the wavelength of radiation to which the infrared-sensitive sub-layer is designed to be sensitive. In this latter case the above difficulty of interference addressed by Appellant 2 would of course not occur.

In these circumstances the Board cannot agree with Appellant 2's argument that due to some difficulties the skilled person would encounter, he would not have considered incorporating a filter layer between the infrared-sensitive layers in order to improve colour separation. The skilled person had a clear incentive from document (4) to do so; nothing was submitted from which the Board could reasonably conclude that difficulties encountered were not surmountable by routine work and without inventive ingenuity. When assessing inventive step it is not necessary to establish that the success of an envisaged solution of a technical problem was predictable with certainty. In order to render a solution obvious it is sufficient to establish that the skilled person would have followed the teaching of the prior art with a reasonable expectation of success (see decisions T 249/88, point 8 of the reasons; T 1053/93, point 5.14 of the reasons; neither published in OJ EPO).

- 3.7.4 Appellant 2 submitted that the problem underlying the patent in suit needed reformulation in view of the fact that the filter layer incorporated between the layers sensitive to the infrared region had the additional effect of altering the speed of the infrared-sensitive layer underneath the filter. This speed differential between the layers could be used as the basis of colour separation. Therefore, the problem should be correctly

formulated to reflect this effect. The inventive step, so he argued, might be present in the formulation of the problem to be solved, the solution being obvious once the problem was clearly stated.

However, the alleged effect of altering the speed of the infrared-sensitive sub-layer does not represent the objective problem underlying the subject-matter of the patent in suit as defined in point 3.4 above, but is part of its solution. This effect does indeed represent a new technical insight which could only have been gained once the filter layer was incorporated. It is to be noted that modifying the speed in the different infrared-sensitive layers is another solution to the problem of improving colour separation, claimed separately as embodiment 1) in claim 3. Moreover, to incorporate parts of the solution offered by the invention into the definition of the problem is inadmissible. It is established jurisprudence of the Boards of Appeal that the technical problem addressed by the invention must be formulated in such a manner that there are no pointers to the solution, otherwise an ex post facto view being taken of inventive activity (see decisions T 229/85, OJ EPO 1987, 237; T 99/85, OJ EPO 1987, 413). Therefore the Board cannot accept Appellant 2's argument.

3.8 Therefore, in the Board's judgement, embodiment 2) as the claimed solution to the problem underlying the contested patent is obvious. Consequently, the subject-matter of claim 3 does not involve an inventive step.

3.9 Since a decision can only be taken on a request as a whole, none of the further claims need to be examined. In these circumstances the appeal relating to Appellant 2's main request must be dismissed for lack of inventive step pursuant to Article 56 EPC.

Auxiliary Request

4. *Amendments (Article 123(2) EPC)*

4.1 Appellant 2 has carried out amendments to the claims in the course of appeal proceedings (see point V above). In case of such amendments, they must be fully examined by the Board as to their compatibility with the requirements of the EPC, in particular the provisions of Article 123 EPC (see decision of the Enlarged Board of Appeal G 9/91, OJ EPO 1993, 408, point 19 of the reasons).

4.2 In order to determine whether or not an amendment offends against Article 123(2) EPC it has to be examined whether technical information has been introduced which a skilled person would not have objectively and unambiguously derived from the application as filed (see decisions T 288/92, point 3.1 of the reasons; T 680/93, point 2 of the reasons; neither published in OJ EPO).

4.2.1 Appellant 2 has amended claim 3 such that the filter layer absorbs infrared radiation to which the underlying emulsion layer is sensitized. He alleged that this amendment has a basis in Examples 5 to 7 and 8 to 10 disclosed in the specification of the patent in suit.

4.2.2 Examples 5 to 7 refer to a single-colour photographic element having one single light-sensitive layer, whereas claim 3 of the patent in suit refers to a full-colour photographic element having at least three light-sensitive layers. Example 10 does not comprise any filter layer, in contrast to the subject-matter claimed. Therefore these examples are not suitable to support the amendment made to claim 3. Examples 8 and 9 refer to full-colour photographic elements and disclose two filter dyes having specific chemical structures.

Any particular property, e.g. the specific absorption property as defined in amended claim 3, is closely related to the very chemical structure of the filter dyes used in these examples. The projection of any particular property from these two filter dyes onto filter dyes in general as claimed in claim 3 amounts to an undue generalisation, given the fact that it is not unambiguously derivable therefrom for the skilled person.

4.2.3 The said examples 5 to 7 and 8 to 10 disclose on page 40, paragraph 3 and page 45, paragraph 2 of the application as filed that the specific filter dyes used therein are suggested to alter the photographic speed of infrared-sensitive layers. However, the amendment made to claim 3 does not consist in requiring the filter dyes to alter the photographic speed of infrared-sensitive layers, but to possess a specific absorption property. These examples of the application as filed do not disclose a direct and unambiguous correlation between the photographic speed of infrared-sensitive layers and the specific absorption property of filter dyes, as now defined in amended claim 3.

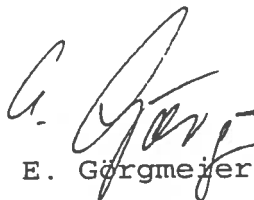
4.3 Therefore, in the Board's judgement, the result of this amendment is that the skilled man is presented with information which is not directly and unambiguously derivable from the application as filed.

4.4 The Board concludes that claim 3 as amended extends the subject-matter claimed beyond the content of the application as filed, thus contravening Article 123(2) EPC. In these circumstances, Appellant 2's auxiliary request must be rejected as well.


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

1. The appeal of Appellant 1 is rejected as inadmissible.
2. The appeal of Appellant 2 is dismissed.

The Registrar:


E. Görgmeier

The Chairman:


A. Nuss

11

12

13

14

