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**D E C I S I O N**  
**of 6 September 1995**

**Case Number:** T 1032/93 - 3.5.2

**Application Number:** 89305011.2

**Publication Number:** 0343844

**IPC:** G11B 23/03

**Language of the proceedings:** EN

**Title of invention:**

Disc cartridge shutters and methods of producing same

**Applicant:**

SONY CORPORATION

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 52(2)(b), 56, 111(1)

**Keyword:**

"Substantially amended claims, reasons for rejection no longer applicable"

"Remittal to Examining Division for further prosecution"

**Decisions cited:**

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**Catchword:**

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Case Number: T 1032/93 - 3.5.2

**DECISION**  
**of the Technical Board of Appeal 3.5.2**  
**of 6 September 1995**

**Appellant:** SONY CORPORATION  
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Shinagawa-ku  
Tokyo 141 (JP)

**Representative:** Pilch, Adam John Michael  
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**Decision under appeal:** Decision of the Examining Division of the European  
Patent Office dated 3 August 1993 refusing  
European patent application No. 89 305 011.2  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** W. J. L. Wheeler  
**Members:** A. G. Hagenbucher  
B. J. Schachenmann

## Summary of Facts and Submissions

I. The Appellant contests the decision of the Examining Division to refuse European patent application No. 89 305 011.2. Claim 1 then on file concerned a disc cartridge shutter characterised by a coating applied at least to surface portions of its metal cover plates to provide a high reflectivity surface finish so that flaws or contamination thereon are less conspicuous. According to the Examining Division the coating served two purposes. The main contribution of the subject-matter of Claim 1 lay in the field of aesthetic creations which was excluded from patentability under Article 52(2)(b) EPC. As a secondary effect the coating prevented corrosion. In this respect Claim 1 lacked an inventive step. Even the effect provided by a decorative machining on the surface of the cover plates according to Claim 2 was just an aesthetic one. The independent method claims for producing the shutter stood and fell together with product Claim 1. Reference was made to

D1: EP-A-239 996,

which describes a known disk cartridge shutter.

II. In the course of the appeal proceedings, the Board referred to the following documents:

D2: EP-A-160 538,

D3: Römpps Chemie-Lexikon, 8th edition, pages 55, 1158, 1159, 2218, 2219,

D4: EP-A-144 783,

D5: EP-A-197 590 and

D6: EP-A-215 958.

III. Oral proceedings were held on 6 September 1995. The Appellant cancelled all the product claims and filed independent method Claims 1 and 2 and new description pages 3 and 4. Claims 1 and 2 are now worded as follows:

"1. A method of producing a shutter (6) for a cartridge (3) accommodating a disc (4) and having apertures (5) for exposing at least a portion of a signal recording surface of said disc (4), said shutter (6) being movably mountable on said cartridge (3) and comprising a pair of stainless steel cover plates (7) for opening or closing said apertures (5) and a stainless steel connecting plate (8) interconnecting said stainless steel cover plates (7), the method comprising:

subjecting one side of stainless steel plate material (20) to hairline processing by machining minute grooves or hairlines (13) parallel to one another;  
applying a coating (14) of an epoxy type resin paint or an acryl type resin paint on said one side of said stainless steel plate material (20) over said grooves or hairlines (13) so as to provide a high reflectivity surface finish for surface portions of the stainless steel cover plates (7) so that flaws and contamination thereon are less conspicuous;  
punching said stainless steel plate material (20) to form a plate piece in the form of the completed shutter (6) in a developed state; and bending the plate piece so that the sides having the coating (14) thereon are exposed to the outside to form the cover plates (7) and the connecting plate (8).

2. A method of producing a shutter (6) for a cartridge (3) accommodating a disc (4) and having apertures (5) for exposing at least a portion of a signal recording surface of said disc (4), said shutter (6) being movably mountable on said cartridge (3) and comprising a pair of stainless steel cover plates (7) for opening or closing

said apertures (5) and a stainless steel connecting plate (8) interconnecting the stainless steel cover plates (7), said method comprising: subjecting one side of stainless steel plate material (20) to hairline processing by machining minute grooves or hairlines (13) parallel to one another; punching said stainless steel plate material to form a plate piece in the form of the completed shutter (6) in a developed state; bending the plate to form the cover plates (7) and the connecting plate (8); and applying a coating (14) of an epoxy type resin paint or an acryl type resin paint at least to the outer lateral sides of the cover plates (7) over said grooves or hairlines (13) so as to provide a high reflectivity surface finish for surface portions of the stainless steel cover plates (7) so that flaws and contamination thereon are less conspicuous."

IV. The Appellant argued essentially as follows:

The new method claims defined manufacturing steps for the production of shutters keeping their appearance even after extended use. The sequence of manufacturing steps was of a technical nature. It was implicit - though not explicitly explained - from the desired function "that flaws and contaminations thereon are less conspicuous" that the paint coating should either be transparent so that the minute hairline grooves would show through as a background beneath the paint or that the paint should be applied so thinly that the hairlines beneath the paint would be reproduced in the paint surface so as to enhance the reflectivity of the surface. Figures 3 and 4A could not be relied upon to determine the effect on the surface of the hairlines because they were obviously drawn in a manner convenient for a draftsman rather than to scale. Particularly, Figure 4(A) gave no idea of

scale, except that such stainless steel shutters were very thin and the paint formed only a small proportion of the overall thickness.

In contrast to D4, which was the application underlying decision T 119/88, a colour was not mentioned in the specification of the present application and was not a relevant factor. In view of the use of stainless steel the paint was hardly used for avoiding corrosion but rather for providing a hard coating on the surface matted by hairline grooves to enhance reflectivity and reduce vulnerability to damage. The use of stainless steel and a paint together prevented any likelihood of rust or dust causing drop out of data stored on the disc. The claimed sequence of manufacturing steps was not rendered obvious by the cited prior art.

V. The Appellant requested that the decision under appeal be set aside and that the application be remitted for further prosecution on the basis of the following documents:

**Description:** pages 3 and 4 filed at the oral proceedings,  
pages 1, 2, and 5 to 7 as originally filed,  
page 4a filed with the letter of 4 September 1992

**Claims:** 1 and 2 filed at the oral proceedings

**Drawings:** 3 sheets (Figure 1, 2, 3, 4(A), 4(B) and 4(C)) as originally filed.

### Reasons for the Decision

1. The appeal is admissible.
2. After cancellation of the product claims in the oral proceedings the application now contains only method claims. These are based on the original Claims 7 to 9, which have been restricted by defining the plate material as stainless steel and by incorporating a hairline processing step as disclosed on original page 6. Description pages 3 and 4 have been adapted to the new claims. The amendments do not infringe Article 123(2) EPC.
3. With regard to the independent method claims - Claims 6 and 7 then on file - the first instance confined itself to stating in paragraph 8 of the impugned decision that these claims stood or fell together with Claim 1. As summarised in paragraph I above, an important part of the reasons for refusal was that Claim 1 was directed mainly to an aesthetic creation. The reasoning in paragraph 8 disregards the fact that a method of producing a product may comprise a technical invention and thus be patentable even if the product is an aesthetic creation. The Board notes that the Examining Division considered the original method claims in a communication in which the view was expressed that they did not involve an inventive step, because applying a coating to a sheet of metal prior to or after punching and bending it appeared to be well-known in the art and the description of the present application did not specify anything special or unexpected in this respect. However, the new claims present the step of coating in a more specific context of using stainless steel plate material and hairline processing which has not been explicitly considered by the Examining Division so far.

In order not to deprive the Appellant of the possibility of having these new method claims considered by two instances, the Board finds it appropriate to make use of its power under Article 111(1) EPC to remit the case to the first instance for further prosecution as requested by the Appellant.

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of Claims 1 and 2 filed at the oral proceedings on 6 September 1995.

The Registrar:

The Chairman:

M. Kiehl

W. J. L. Wheeler