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D E C I S I O N
of 18 January 2002

Case Number: T 0957/97 - 3.3.6

Application Number: 91121570.5

Publication Number: 0507998

IPC: D21H 19/60

Language of the proceedings: EN

Title of invention:

A coated substrate and method of making same

Patentee:

MOORE BUSINESS FORMS, INC.

Opponent:

Sihl GmbH

Headword:

Sizing degree/MOORE

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Admissibility of an amendment amounting to a so-called disclaimer (no - points 2.2 to 2.5)"

"Amendment not having support in the original application and aiming at distancing the patent further from the state of the art by way of disclaimer is not admissible (point 2.5)"

Decisions cited:

T 0323/97

Catchword:

-



Case Number: T 0957/97 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 18 January 2002

Appellant: MOORE BUSINESS FORMS, INC.
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Representative: Fleischer, Holm Herbert, Dr.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 16 July 1997
revoking European patent No. 0 507 998 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Krasa
Members: L. Li Voti
C. Holtz

Summary of Facts and Submissions

- I. The present appeal is from the decision of the Opposition Division to revoke European patent No. 0 507 998 relating to a coated substrate for toner recording.

The patent as granted contained sixteen claims, wherein independent claim 13 read as follows:

"13. A coated substrate comprising:

a substrate having coated thereon a composition of 50 to 95 parts by dry weight of a particulate silica and 5 to 50 parts by dry weight of polyvinyl alcohol binder in a coating weight of less than 3.0 g/m² per side of the substrate, characterised in that the substrate is paper having a Stockigt sizing degree before coating of greater than 7 and after coating is suitable as a toner recording medium."

- II. A notice of opposition was filed against the patent, wherein the Opponent (Respondent) sought revocation of the patent on the grounds of Article 100(a) EPC, in particular because of alleged lack of novelty and inventive step of the claimed subject-matter.

The opposition was based *inter alia* upon the following document:

(1): US-A-4 900 620.

- III. In its decision, the Opposition Division found that the claimed invention as amended during the proceedings did not fulfil the patentability requirements of the EPC.

In particular it found that the subject-matter of claims 1 of the main and first auxiliary requests lacked novelty in the light of document (1) and that the claims of the second auxiliary request contravened the requirements of Article 123(3) EPC.

With regard to the amended claim 1 of the first auxiliary request the Opposition Division held moreover

that the application as filed did not contain any specific support for a paper substrate having "a Stockigt sizing degree before coating of greater than 25 seconds";

and whereas the Union Camp OCR bond paper tested in the experimental evidence filed by the Patent Proprietor (Appellant) with letter of 5 June 1997 possessed a Stockigt sizing degree of greater than 30 seconds, the patent in suit did not specify the brand of paper used in the illustrative examples; therefore it could not be taken as proven that the paper substrate used in example 1 of the patent in suit corresponded to the Union Camp paper tested by the Appellant;

the amendment amounted, however, to an acceptable disclaimer over document (1) and complied therefore with the requirements of Article 123(2) EPC.

IV. An appeal was filed against this decision.

The Appellant submitted with the statement of the grounds of appeal modified sets of claims as auxiliary requests, wherein claim 1 of the third auxiliary request read as follows:

"1. A toner recording medium comprising:

a substrate having coated thereon a toner receptive composition of 50 to 95 parts by dry weight of a particulate silica and 5 to 50 parts by dry weight of polyvinyl alcohol binder in a coating weight of less than 3.0 g/m² per side of the substrate, characterised in that the substrate is paper having a Stockigt sizing degree before coating of greater than 30 seconds".

At the oral proceedings held before the Board on 18 January 2002, which were not attended by the Respondent, the Appellant withdrew all prior requests filed in writing and submitted as the only request a new set of claims.

Claim 1 of this request reads as follows:

"1. A coated substrate comprising:

a substrate having coated thereon a composition of 50 to 95 parts by dry weight of a particulate silica and 5 to 50 parts by dry weight of polyvinyl alcohol binder in a coating weight of less than 3.0 g/m² per side of the substrate, characterised in that the substrate is paper having a Stockigt sizing degree before coating of greater than 30 seconds and after coating is suitable as a toner recording medium."

This request was accompanied by eight dependent claims containing particular embodiments of the claimed coated substrate.

V. As regards the admissibility of this request the Appellant submitted orally *inter alia* that:

- the application as filed did not contain a specific support for a paper having a Stockigt sizing degree before coating of greater than 30 seconds but did suggest the use of a substrate having a Stockigt sizing degree of greater than 7;
- the wording "paper having a Stockigt sizing degree before coating of greater than 30 seconds" amounted to an admissible disclaimer over the content of document (1) disclosing in its comparative example 2 a coated paper substrate having a Stockigt sizing degree of 30 seconds;
- therefore the claims of this request complied with the requirements of Article 123(2) EPC.

VI. With regard to the admissibility of this so-called disclaimer which was already contained in the wording of claim 1 of the third auxiliary request, filed with the statement of the grounds of appeal (withdrawn at the oral proceedings), the Respondent had submitted in writing in essence that:

- a limitation of claim 1 to a paper substrate having a Stockigt sizing degree before coating of greater than 30 seconds had no explicit support in the application as filed;
- the experimental report filed by the Appellant at the first instance with letter of 5 June 1997 could not be taken as evidence that the paper substrate used in the examples of the patent in suit had a Stockigt sizing degree greater than 30 seconds;

- therefore the amendment to claim 1 was not an admissible disclaimer and contravened the requirements of Article 123(2) EPC.

VII. The Appellant requested that the decision be set aside and the patent maintained on the basis of claims 1 to 9 as filed at the oral proceedings as the main and only request.

The Respondent requested that the appeal be dismissed.

VIII. At the end of the oral proceedings, the chairman announced the decision of the Board.

Reasons for the Decision

1. *Procedural issues*

The Appellant filed the request upon which this decision is based at the oral proceedings before the Board that were not attended by the Respondent.

Claim 1 of this request is similar to that of the third auxiliary request submitted in writing with the statement of the grounds of appeal (see point IV above), withdrawn at the oral proceedings, and differs therefrom only insofar as the wording of claim 1 has been readapted to that of granted claim 13.

This request had the goal of overcoming possible deficiencies found in the wording of the previous third auxiliary request and amounted therefore in the Board's view to a fair attempt to defend the patent.

Moreover, it did not lead to a substantial change of the subject-matter of the proceedings which would have needed reconsideration by the absent Respondent.

This late filed request was thus accepted for examination by the Board.

2. *Article 123(2) EPC*

2.1 Claim 1 of this request differs from claim 13 as granted (see point I above) only insofar as the Stockigt sizing degree of the paper substrate before coating has been modified from "greater than 7" to "greater than 30 seconds".

As also admitted by the Appellant the application as filed did not contain any explicit support for this new range but simply indicated that the used substrate would have "generally" a sizing degree of greater than 7 (page 3, lines 52 and 53). Moreover the experimental work submitted by the Appellant at the first instance with letter of 5 June 1997 cannot be considered to be representative for the paper substrate used in the examples of the patent in suit, since the latter is silent about the brand of paper used in the examples (see point III above) which, consequently, are not indicative of a Stockigt sizing degree above 30 seconds.

Therefore, the examples in the application as filed cannot serve as a basis for the suggested amendment either.

2.2 As admitted by the Appellant, this limitation in Stockigt sizing degree has the purpose to exclude the

subject-matter disclosed in document (1), ie a coated paper having a sizing degree before coating of up to 25 seconds (column 4, lines 20 to 23) and the coated paper of comparative example 2 of the same document, which specifically discloses a paper substrate having a Stockigt sizing degree of 30 seconds, coated with 2g/m² of a composition comprising 100 parts of fine silica particles, 50 parts of polyvinylalcohol binder, 20 parts of polyethylenimine quaternary ammonium salt and 1 part of sodium polyacrylate.

This amendment which does not find support in the application as filed amounts therefore to a so-called disclaimer over the teaching of document (1).

- 2.3 Disclaimers not having support in the application as filed have been accepted in the past by the Boards of Appeal only in exceptional cases, for example in order to make a claimed subject-matter novel by delimiting it against a so-called "accidental" anticipation. Such a disclaimer was considered to be admissible if the disclaimed subject-matter, which found support in that anticipation, belonged to a remote technical field and did not help in solving the technical problem underlying the claimed invention (see T 0323/97, to be published in the OJ EPO, point 2.2 of the reasons for the decision).

It is in this respect doubtful whether the amendment in the questioned claim 1 is fully supported by the content of document (1) which, for example, does not disclose any coated paper having a Stockigt sizing degree greater than 25 seconds and lower than 30 seconds.

Since the appeal fails for other reasons given below, this needs, however, not to be considered further.

- 2.4 The Board finds in the present case that document (1) cannot be considered to be an "accidental" anticipation since ink-jet recording and toner recording are closely related technical fields (see the patent in suit, page 2, lines 49 to 52) and the skilled person, faced with the problem of finding a qualitative better paper for toner recording, would necessarily have taken into account any coated printing paper known from the technical field of ink-jet recording and would have evaluated its physical characteristics and suitability for toner recording.

Therefore, already on these grounds the disclaimer of claim 1 has to be considered as inadmissible.

- 2.5 Moreover, any amendment to a claim, including a disclaimer, has to be governed by Articles 123(2) and (3) EPC. Because of the above considerations (point 2.4) the Board sees the disclaimer in question as aiming at distancing the patent further from the state of the art. In this respect the Board finds that the restriction of a technical feature which has to be considered when it comes to the evaluation of inventive step cannot be seen as a mere waiver of protection. On the contrary, its admissibility would give the patent proprietor an unwarranted advantage and would consequently contravene Article 123(2) EPC (see T 0323/97, points 2.3 to 2.5 of the reasons for the decision).

- 2.6 Therefore, the limitation to granted claim 13, which does not find any support in the application as filed,

is inadmissible under Article 123(2) EPC.

The Appellant's main and only request must thus be rejected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

P. Krasa