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D E C I S I O N
of 12 October 2000

Case Number: T 0438/98 - 3.3.3

Application Number: 88111360.9

Publication Number: 0300372

IPC: C08J 5/18

Language of the proceedings: EN

Title of invention:

Minute-cellular polyester film provided with coating

Patentee:

Mitsubishi Polyester Film Corporation

Opponent:

Toyo Boseki Kabushiki Kaisha
Imperial Chemical Industries PLC

Headword:

-

Relevant legal provisions:

EPC Art. 54, 84, 111(1), 114(2), 123(2), 123(3)
EPC R. 88

Keyword:

"Claims - clarity (yes) - lack of support (not objectionable
in opposition/appeal proceedings)"
"Amendment under Rule 88 EPC not objectionable under
Article 123(3) EPC if complying with Article 123(2) EPC"
"Novelty - implicit disclosure (no)"

Decisions cited:

G 0004/95, T 0271/84, T 0153/85, T 0371/88, T 0200/89,
T 0673/89, T 0214/91

Catchword:

-



Case Number: T 0438/98 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 12 October 2000

Appellant:
(Opponent 01)

Toyo Boseki Kabushiki Kaisha
2-8, Dojima Hama 2-chome
JP-Kita-ku
Osaka (JP)

Representative:

Weber, Thomas, Dr.Dipl.-Chem.
Patentanwälte
von Kreisler-Selting-Werner
Postfach 10 22 41
D-50462 Köln (DE)

Other party:
(Opponent 02)

Imperial Chemical Industries PLC
Imperial Chemical House, Millbank
London SW1P 3JP GB)

Representative:

Humphries, Martyn
ICI Materials
Intellectual Property Department
P.O. Box 90
Wilton
Middlesbrough
Cleveland TS90 8JE (GB)

Respondent:
(Proprietor of the patent)

Mitsubishi Polyester Film Corporation
28-10, Hongo 1-chome
Bunkyo-ku
Tokyo (JP)

Representative:

TER MEER STEINMEISTER & PARTNER GbR
Patentanwälte
Mauerkircherstrasse 45
D-81679 München (DE)

Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office posted 24 February
1998 concerning maintenance of European patent
No. 0 300 372 in amended form.

Composition of the Board:

Chairman: C. Gérardin

Members: C. Idez
V. Di Cerbo

Summary of Facts and Submissions

- I. The mention of the grant of European Patent 0 300 372 in respect of European patent application No. 88 111 360.9 filed on 14 July 1988 and claiming the priority of 15 July 1987 of an earlier application in Japan (JP 17623/87), was announced on 21 September 1994 (Bulletin 94/38) on the basis of 3 claims.

Claim 1 read as follows:

"A film comprising a uniaxially or biaxially stretched minute cellular polyester film having an apparent specific density in the range of 0.4 to 1.3 and an opacifying power of not less than 0.2, and a coating applied to either one or both of the surfaces of said polyester film, said coating comprising at least one compound selected from the group consisting of thermoplastic polyesters soluble in organic solvents: water-dispersible thermoplastic polyesters containing sulfonates: alkyd type polyesters: acryl modified polyesters; polyurethane resins soluble in organic solvents or dispersible in water; polyisocyanate compounds; terminal blocked polyurethane resins; vinyl type resins soluble in organic solvents or dispersible in water; epoxy type resins; silicon type resins; urea type resins; and melamine type resins; and 0.01 to 10% by weight, based on the solid component of said coating, of at least one surfactant selected from the group consisting of anionic surfactants, cationic surfactants, amphoteric surfactants; and nonionic surfactants."

Dependent Claim 2 related to preferred amounts of surfactants in the coating composition and dependent

Claim 3 was directed to specific embodiments of the polyester film.

II. Notices of Opposition were filed on 10 June 1995 by Toyo Boseki Kabushiki Kaisha (Opponent I) and on 19 June 1995 by ICI Materials (Opponent II), respectively, both parties requesting the revocation of the patent in its entirety on the grounds of lack of novelty, including an objection of public prior use, and lack of inventive step.

The objections were essentially based on the following documents:

D1: GB-A-1 415 686,

D3: GB-A-1 264 338,

D7a: GB-A-1 497 101,

D7b: GB-A-1 499 706,

D12: Shell Chemicals Technical Bulletin ICS/69/28
"Teepol 610",

D15: ICI Technical Data Sheet MX TD 327 "Melinex"
Polyester Film,

D19: US-A-3 751 280 and

D20: English translation of JP-A-60 059 348;

as well as on the late-filed documents:

D16: High yield PET film, J.R. Newton 1984, ICI

Americas Inc, and

D18: Declaration of R.A. Rustin, employee of
Opponent II.

III. By an interlocutory decision issued in writing on 24 February 1998, the Opposition Division held that the grounds for opposition did not prejudice the maintenance of the patent in amended form as submitted with the letter of 16 June 1997, the amendments consisting in (a) the limitation to 0.1 to 3% by weight of the amount of surfactant and the indication that the thickness of the coating was 0.01 to 0.5 μm in Claim 1, (b) the deletion of Claim 2 and (c) the indication that the intrinsic viscosity of the polyester was not less than 0.4 in Claim 3.

In substance the Opposition Division took the view that:

- (i) The amendments in the claims complied with the requirements of Article 123(2) and (3) EPC;
- (ii) The evidence submitted by Opponent II (i.e. documents D15, D16 and D18) was not sufficient to prove a public prior use. On the one hand, D15 did not disclose the chemical "identity" e.g. composition of the commercial product "Melinex X 475" and, on the other hand, the late-filed documents D16 and D18 did not add anything of substance and had thus been disregarded pursuant to Article 114(2).
- (iii) The subject-matter of the amended Claims 1 and 2 was novel, since D1 did not explicitly disclose

a minute cellular polyester film with a coating having a thickness in the range of 0.01 to 0,5 μm .

- (iv) The subject-matter of amended Claims 1 and 2 involved an inventive step, since there was no indication in document D1, even taken in combination with documents D19 and D20, as to select the thickness of the coating and the amount of surfactant in the coating composition in order to obtain polyester films having excellent adhesive properties, in particular adhesion to printing ink, in combination with excellent whiteness, coating properties and opacifying properties.

IV. On 25 April 1998 an appeal was lodged by the Appellant (Opponent I) against this decision with simultaneous payment of the prescribed fee.

The arguments presented by the Appellant in the Statements of Grounds of Appeal filed on 25 June 1998 as well as in its subsequent submissions can be summarized as follows:

- (i) The surface roughness of the polyester film, which was an essential feature of the polyester film, was missing in Claim 1. Thus, this claim did not meet the requirements of Article 84 EPC.
- (ii) The objection of lack of novelty over D1 was maintained. Although this citation did not explicitly disclose a film having the required thickness, it had to be assumed that this

condition was implicitly fulfilled. As a further support for this objection a declaration by Mr C. Deverell (Document D22), one of the inventors of D1, was submitted with letter of 20 December 1999.

- (iii) Inventive step was also denied on the basis of the combination of D1 with document D21 (JP-A-59 174 423), a new citation considered in the form of an English translation. Although D21 had been submitted late, it should be admitted into the proceedings in view of its relevance. This document taught that the adhesion of transparent polyester films to printing inks could be improved by an adhesive coating.
- (iv) In response to the summons to oral proceedings the Appellant informed the Board on 5 September 2000 that it would be accompanied by two technical experts, one being a Manager at the Opponent's company and the other being the author of D22.

V. In its counterstatements, the Respondent (Patent Proprietor) argued essentially as follows:

- (i) The late-filed document D21 was not relevant and should be disregarded pursuant to Article 114(2) EPC.
- (ii) The wording "minute cellular polyester film" implied an extremely high surface roughness as compared to a non voided polyester film, but the roughness value was not an essential feature and its absence in the claims was not objectionable

under Article 84 EPC.

- (iii) Document D1, whether considered in isolation or in combination with other documents, neither explicitly nor implicitly described a polyester film having a thickness in the range of 0.01 to 0.5 μm . The common coating method used in D1 (off-line coating) would not lead to a coating thickness having the required values. This clearly appeared from the disclosure of D23 (Encyclopedia of Polymer Science and Engineering, Volume 3, 1985 pages 552-553). Following that citation, which illustrated common general knowledge, one would not necessarily and inevitably obtain such a small coating thickness by operating in accordance with these general methods.

- (iv) The person skilled in the art would not combine D1 with D21 for the following reasons:
 - (a) D21 only referred to transparent polyester films;
 - (b) the coating compositions used in D21 were very specific and did not always lead to good adhesion properties to printing ink and gelatin;
 - (c) the presence of a surfactant in the coating composition of Example 4 of D21 was purely accidental. There was no teaching concerning the function of the surfactant in D21; by contrast, in the patent in suit the presence of a

surfactant was an essential feature for obtaining a good adhesion to ink.

- (v) The technical experts should not be given permission to make additional technical contributions. On the one hand, oral proceedings were not a forum for presenting new or additional evidence; on the other hand, these experts could not be regarded as independent in view of their connection with the opponents and had an obvious interest in the revocation of the patent. Reference was made to the decision G 4/95 .

VI. Oral proceedings took place on 12 October 2000.

- (i) During the oral proceedings the following preliminary issues were considered successively: additional technical contribution by the experts accompanying the Appellant's representative, admissibility of late-filed documents and wording of the claims.

- (a) The question whether the technical experts accompanying the Appellant's representative should be allowed to make technical contributions was discussed in the light of the principles set out in the decision G 4/95. The Appellant's representative specified that these contributions would not go beyond the general information concerning the thickness of coating which a person skilled in the art would normally expect by using conventional methods.

(b) The admissibility of the late-filed documents D21 to D23 was discussed in view of their relevance, i.e. their possible influence on the ultimate outcome of the case.

(c) Although the amendments to the claims did not give rise to any objection, the wording of the claims was criticized as not comprising a number of features which were essential for the definition of the alleged invention.

(ii) Regarding the issue of novelty there was a consent between the parties that D1 disclosed all the features of the film as claimed, except the thickness of the coating. Various documents were relied upon, in particular D19 and D7b, to demonstrate that usual methods would inevitably lead to a coating thickness within the terms of the patent in suit (Appellant) or that this was not necessarily the case (Respondent).

VII. Opponent II, which had not filed an appeal, did not take an active part in the appeal procedure. In particular, although duly summoned at the oral proceedings, it did not appear at the hearing.

VIII. The Appellant requested that the decision under appeal be set aside and the patent be revoked.

The Respondent requested that the appeal be dismissed and that the patent be maintained as amended, alternatively that the case be remitted to the first instance, should the Board decide to admit document D21

into the proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. *Procedural matters*

As it appears from the Statements of Facts and Submissions the Board was faced with two procedural issues arising from the Appellant's written submissions (cf. point IV(iii) and (iv)).

- 2.1 The first issue concerns the oral submissions by persons accompanying the Appellant's representative.

According to the principles set out in the decision G 4/95 (OJ EPO 1996, 412), if during oral proceedings before a board of appeal a party wishes that, in addition to the complete presentation of its case by its professional representative, oral submissions should be made on its behalf by an accompanying person, the professional representative should (i) request permission for such oral submissions to be made in advance to the oral proceedings, (ii) state the name and qualifications of the person for whom this permission is requested, and (iii) specify the subject-matter on which this person wishes to speak; in any case, (iv) these oral submissions should be made under the control of the professional representative (cf. Reasons for the Decision, points 8 and 10).

There is no doubt that the Appellant's letter of 5 September 2000 announcing the presence of persons

accompanying the professional representative satisfied these principles, since it mentioned the names and qualifications of these persons and specified that their technical contributions could be made in addition to the submissions made by the professional representative or in answer to the questions by the Board of Appeal. From a procedural point of view, thus, there was no obstacle to technical contributions by these experts.

During oral proceedings, both were given the opportunity to provide additional information about conventional coating methods and the thickness of the resulting coatings. The Respondent, which eventually no longer objected to these submissions, was in fact able to provide counter-arguments to the points made by these experts, so that no imbalance occurred caused by their presence.

- 2.2 The second point concerns the late-filed documents D21 to D23 relied upon by the parties for the first time during the appeal proceedings.

The preliminary discussion of these new submissions brought to light that only D21 was sufficiently relevant to be admitted into the proceedings in the sense that it could affect the maintenance of the patent.

As pointed out by the Appellant, D21 which discloses the improved adhesion of a biaxially oriented polyester film to gelatin and printing ink obtainable by applying a coating within the terms of the patent in suit, was produced in reaction to the Opposition Division's argument supporting an inventive step and was mentioned

in the Statements of Grounds of Appeal, thus at the first opportunity given to the Appellant, so that there can be no question of a procedural abuse.

For these reasons the Board decided to admit D21 into the proceedings.

3. *Wording of the claims*

3.1 In its decision the Opposition Division merely referred to a number of passages supporting the amendments and concluded that the claims as amended complied with the requirements of Article 123(2) and (3) EPC. Whilst this conclusion applies without restriction to the amendments made in Claim 1, the Board deems it appropriate to consider the wording of present Claim 2 in further detail.

3.1.1 Present Claim 2, which originates from Claim 3 as granted, wherein the intrinsic viscosity of the polyester was required to be not less than 4", was filed on 16 June 1997. In the accompanying statement, the Respondent (then Patentee) justified the new range of intrinsic viscosity, i.e. not less than 0.4, by saying (cf. point 1 "Amendments") that this was the correction of an obvious typing error and that the new limit was adequately supported by the description as originally filed.

3.1.2 The admissibility of explanatory amendments of claims has been considered in several decisions of the boards of appeal. In T 271/84 (OJ EPO 1987, 405) the Board took the view that an amendment to a claim to clarify an inconsistency did not contravene Article 123(2) or (3) EPC if the amended claim had the same meaning as

the unamended claim on its true construction in the context of the specification (cf. Reasons for the Decision, point 2 in conjunction with Headnote II). Similarly, in T 371/88 (OJ EPO 1992, 157) the Board held that the amendment of a granted patent, whereby a restrictive term was replaced by a less restrictive term, did not contravene Article 123(3) EPC if it was quite clear from the descriptions of the patent and the application that the invention had always embraced the area defined by the two terms and it had never been intended to exclude it from the protection conferred by that patent (cf. Reasons for the Decision, point 2.5). Likewise T 200/89 of 7 December 1989, T 673/89 of 8 September 1992 and T 214/91 of 23 June 1992, all unpublished in OJ EPO, ruled that amending a claim to remove an inconsistency did not contravene Article 123(2) or (3) if the claim as corrected had the same meaning as the correct interpretation of the uncorrected claim in the light of the description.

- 3.1.3 According to established case law, thus, a prerequisite for an amendment to be admissible is that the granted claim properly construed could only be interpreted as the amended claim, which in the present case means that the amendment must both correspond to the correction of an obvious clerical error and satisfy the requirements of Article 123(2). Both conditions are obviously met, since (i) an intrinsic viscosity of not less than 4 is rather meaningless and (ii) the description of the application as originally filed specifies that the polyester is preferred to have an intrinsic viscosity of not less than 0.4, preferably 0.5 to 1.2 and more preferably 0.55 to 0.85 (cf. page 9, lines 6 to 99), which is also in line with the values in the examples.

3.1.4 For these reasons it can be concluded that the wording of Claim 2 is not objectionable under Article 123(3) EPC.

3.2 During oral proceedings the Appellant also emphasized a number of objections raised under Article 84 EPC in the Statement of Grounds of Appeal.

3.2.1 The first concerns an alleged lack of clarity arising from the amendments in the claims during the opposition proceedings.

As mentioned above, these amendments consist primarily in a narrower range defining the amount of surfactant and in the introduction of the thickness of the coating applied to the surface(s) of the polyester film. The Board is not aware of any unclarity resulting from these restrictive conditions, whether by themselves or in connection with other features, since the new weight range of 0.1 to 3% cannot be more obscure than the original range of 0.01 to 10% by weight; the same applies to a coating having a thickness of 0.01 to 0.5 μm with respect to a coating of originally unspecified thickness.

3.2.2 The second objection relates to the absence in Claim 1 of certain features which appear from the description as being prerequisites to obtain polyester films having the desired properties. According to the Appellant these features were the high surface roughness of the film as well as the crystallinity of the polypropylene which is incorporated into the polyester.

Even if the first can be regarded as an essential feature in view of the statement " The film used in the

present application is required to have the properties mentioned above" (cf. page 4, line 27 of the patent specification corresponding to page 11, lines 4/5 of the application as originally filed) specifically referred to by the Appellant, its absence, which has the effect that the definition of the film as claimed is not supported by the definition of the film as described, results in a discrepancy at most objectionable under Article 84 EPC. As conceded by the Appellant, however, this is not a ground for opposition.

- 3.2.3 In the same respect the Appellant put forward that in the absence of these essential features the films as defined in Claim 1 could not have the desired properties, which meant that the technical problem underlying the patent in suit was not effectively solved.

As pointed out by the Board, this argument cannot be accepted as an objection under Article 84 EPC in opposition appeal proceedings, since it is a preliminary issue to consider when assessing inventive step (Article 56 EPC), which was not to be decided in the present appeal proceedings.

- 3.2.4 It follows from these considerations that the requirements of Article 84 EPC must be regarded as met.

4. *Novelty*

It follows from the above Facts and Submissions that the question of public prior use is no longer an issue.

- 4.1 The Appellant, however, has maintained its objection of

lack of novelty against the claimed subject-matter as amended in opposition proceedings.

4.1.1 D1 concerns a process for the production of opaque and voided molecularly oriented and heat set linear polyester films, which comprises (i) forming a loosely blended mixture of particles of a linear polyester with from 3 to 25% by weight of a homopolymer or copolymer of ethylene or propylene, (ii) extruding the blend as a film, (iii) quenching and biaxially orienting the film by stretching it in mutually perpendicular directions, and (iv) heat setting the film (cf. Claim 1). These films have a paper-like texture which makes them suitable as paper substitutes for photographic prints, e.g. as supports carrying a photosensitive layer (cf. page 3, lines 43 to 99). There are general requirements regarding the thickness of the films (cf. page 3, lines 21 to 30), but no indication at all concerning the thickness of the coating layer.

4.1.2 According to Examples 1 to 5 polyethylene terephthalate granules are tumble blended with 5% by weight of granular polypropylene, the resulting blends are then extruded in the form of a film and rapidly quenched to render the polyester component amorphous, the films are subsequently stretched in both the machine direction and the transverse direction, and finally heat set under constant dimensions. The films so obtained are coated firstly with a vinylidene chloride copolymer, secondly with a gelatinous subbing layer and finally overcoated with a gelatinous light sensitive silver bromide emulsion (cf. page 4, lines 72 to 75; page 5, lines 2 to 8).

4.1.3 According to an alternative embodiment (cf. page 5,

lines 12 to 31) the opaque films obtained in Examples 1 to 5 are first coated (off-line coating) with a subbing layer comprising a mixture of a butadiene copolymer and gelatin, then overcoated with a gelatinous silver bromide emulsion, the subbing composition comprising 10 parts of a butadiene/styrene/itaconic acid copolymer, 1 part of gelatin, 1 part of an active ionic emulsifier available commercially under the registered trade mark "Teepol 610" and 88 parts of distilled water (parts by weight).

The product "Teepol 610" is identified in D12 as being a linear anionic surface active agent available in the form of a 34% aqueous solution of a sodium salt of a secondary alkyl sulphate, which is the active ingredient (cf. page 12, "Introduction"). As stated in the decision under appeal, this means that the above coating composition comprises 3% of the surfactant.

- 4.1.4 Thus, although the reference to D12 provides clarification concerning the amount of surfactant used in the alternative embodiment of D1, this still leaves open the question whether, by operating in accordance with the teaching of D1, one would inevitably obtain a coating having a thickness within the terms of the patent in suit.

- 4.2 The Appellant's argument that D19, which was granted to the same applicant as D1, described a coating agent with the same composition also applied on a polyester film in an amount leading to a thickness of 0.4 μm and that, consequently, the same result should be expected in the alternative embodiment of D1, cannot be accepted.

- 4.2.1 D19 is directed to a method for producing a photographic base which comprises (i) casting a flat polymeric film, (ii) uniaxially or biaxially stretching it, (iii) coating it with a subbing composition comprising a polymeric component and a gelatin like compound, and (iv) heat setting the resulting oriented and coated film (cf. Claim 1). The applied coat weight on each side of the finished film, e.g. after drying, orientation and heat setting, is preferably in the range from 1 to 7 mg/dm² (cf. column 5, lines 48 to 50).
- 4.2.2 The particular method described in Example 1 comprises (i) melt extruding polyethylene terephthalate to an amorphous film, (ii) stretching the film in the longitudinal direction, (iii) coating the film by a reverse roll coater under specific conditions with a subbing composition corresponding to that used in the alternative embodiment of D1, (iv) stretching the film transversely, and (v) heat setting the coating film. The coat weight of the subbing coating is said to be 4 mg/dm² per side on the finished oriented and heat set film (cf. column 6, line 48 to column 7, line 12).
- 4.2.3 In spite of the differences in terms of voiding and opacity between the films according to D1 and D19, which were emphasized by the Respondent (cf. statement of 4 March 1999, point 2.2.2), the alternative embodiment of D1 and Example 1 of D19 have in fact an important structural feature in common, both being characterized by the use of the same coating to promote adhesion between a polyester film and a layer to be adhered (cf. statement by the Appellant of 20 December 1999, point 2.2.2).

An essential aspect to consider, however, is the method

reported in D19 to apply the coating. According to the relevant Example 1 the polyester film is coated (on-line coating) with the subbing composition by a reverse roll coater, the peripheral speed of the coater roll being 40 ft/min and the speed of the film being 25 ft/min. In the Board's view, there can be no doubt that the resulting coat weight of 4 mg/dm² is closely related to these specific operating conditions. This also means that by changing these conditions - on-line/off-line coating as well as speed - one can expect a different coat weight, thus a different thickness.

This contrasts with the statement in D1 that the layer "may be applied by an suitable method known for the application of coatings to polyester film surfaces" (cf. page 3, lines 99 to 102). This absence of specific information can only mean that, unlike the thickness of the support which has to meet particular requirements, the thickness of the coating is not an essential feature of the films described in D1.

4.3 In support of the same objection the Appellant also relied on document D7b.

4.3.1 This citation describes coated film assemblies comprising a support film of a linear polyester and a glycidyl (meth)acrylate/(meth)acrylate/acrylonitrile copolymer priming layer applied to at least one surface of the support film in order to promote adhesion for functional coatings which may be superimposed upon the priming layer (cf. Claim 1 in conjunction with page 1, lines 20 to 24). The support film is preferably in the form of biaxially oriented and heat set films of polyethylene terephthalate (cf. page 1, line 82 to

page 2, line 2). The coating composition, which preferably also comprises a cross-linking agent and a catalyst (cf. Claim 20; page 2, line 102 to page 3, line 9), may be applied to the surface of the support film as an aqueous latex by any suitable known film coating technique (cf. page 2, lines 18 to 21). Depending on the end use of the coated film, the priming layer may have a thickness in the range of 0.01 to 20 μm , suitably in the range of 0.02 to 0.05 μm ; in practice, however, the thickness is often the result of a compromise between antagonistic requirements, good adhesion properties being achieved above a certain limit and propensity to the accumulation of static charges being avoided below another limit (cf. page 3, lines 29 to 52).

- 4.3.2 Two features have been considered in the examples more specifically.

The first concerns the presence of a non-ionic surfactant (0.5% by volume) in the composition used in Example 1 (cf. page 4, lines 5 to 16).

The second concerns the thickness of the various priming layers coated on polyethylene terephthalate films (cf. Example 13 in conjunction with Example 3). As pointed out by the Appellant, all the values reported in Table 2 are between 0.014 and 0.058 μm .

- 4.3.3 Whilst these values would appear to speak in favour of the Appellant's view, it has to be borne in mind that the range of thickness actually envisaged in this citation extends up to 20 μm , thus far above the range

required in the patent in suit. Thus it cannot be concluded that any coating obtained by following the teaching of D1 would inevitably meet all the requirements of Claim 1 of the patent in suit.

- 4.4 A further point to consider is in fact to what extent, in spite of the close similarity between the disclosure of D1 on the one hand, and the teachings of D19 and D7b on the other hand, it is legitimate to rely on the latter citations in order to interpret the former.

In this respect, the Board notes that the authors of D1 have not made any explicit reference to a prior document in order to clarify the question of the thickness of the coating, which is not even an essential feature of the known films (cf. point 4.2.3 above). Thus, the present situation does not correspond to that underlying the decision T 153/85 (OJ EPO 1988, 001), wherein a specific reference in a first or primary document to a second prior document made it possible to construe the primary document by incorporating part or all of the disclosure of the second document (cf. point 4.2, third paragraph). Furthermore, in the case of D7b the authors of D1 could not have envisaged to incorporate any specific feature from that citation, since the latter was filed (19 July 1976) even after the date of publication of D1 (26 November 1975).

- 4.5 The explanations given by the persons accompanying the Appellant's representative concerning the thickness of the coatings relied on the assumption that, in the patent in suit as well as in the prior art documents considered above, the layers were in fact monomolecular, thus had necessarily the same thickness.

This conclusion cannot be accepted for the following reasons. The first is that neither the patent in suit nor these documents have introduced the concept of monomolecular layer as the feature necessary to achieve the desired properties; there is thus no reason to reduce the issue of thickness to the interpretation of an undisclosed concept. The second is, even if comparable thicknesses are indeed to be found in the patent in suit and in the prior art documents, there is no identity of the ranges (patent in suit: 0.01 to 0.5 μm ; D19:1 to 7 mg/dm^2 calculated as 0.1 to 0.7 μm ; D7b:0.01 to 20 μm), but at most a large overlap.

This means that in the field of polyester films provided with a coating it has not been demonstrated that the coating inevitably has a thickness within the terms of the patent in suit.

4.6 For these reasons the Board comes to the conclusion that the claimed subject-matter as defined in Claim 1 and the dependent claims is novel.

5. *Conclusion*

In accordance with the Respondent's request not to discuss the issue of inventive step should document D21 be introduced into the proceedings, the Board, in the exercise of its discretionary power pursuant to Article 111(1) EPC, decides to remit the case to the first instance for further prosecution.

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.

The Registrar:

The Chairman:

E. Görgmaier

C. Gérardin