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**Datasheet for the decision
of 8 July 2014**

Case Number: T 2025/13 - 3.4.03

Application Number: 06758725.3

Publication Number: 1908043

IPC: G09F3/00, A61L15/46

Language of the proceedings: EN

Title of invention:

ANTIMICROBIAL COATING FOR IDENTIFICATION DEVICES

Applicant:

ZIH Corporation

Headword:

Relevant legal provisions:

EPC Art. 123(2), 153(2)

EPC R. 71(3)

EPC 1973 Art. 111(1)

Keyword:

Amendments - added subject-matter (no)

Decisions cited:

G 0003/89

Catchword:



**Beschwerdekammern
Boards of Appeal
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Case Number: T 2025/13 - 3.4.03

**D E C I S I O N
of Technical Board of Appeal 3.4.03
of 8 July 2014**

Appellant: ZIH Corporation
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 15 April 2013 refusing European patent application No. 06758725.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: G. Eliasson
Members: S. Ward
T. Karamanli

Summary of Facts and Submissions

- I. The appeal is against the decision of the Examining Division refusing European patent application No. 06 758 725 on the ground that claim 1 of the sole request then on file did not meet the requirements of Article 123(2) EPC.
- II. With the notice of appeal the appellant filed amended claims 1-16. Oral proceedings were requested "should the Board of Appeal be of the opinion that the application and the invention to which it relates do not meet the requirements of the European Patent Convention".
- III. The Board sent a communication under Rule 100(2) EPC indicating that the objections of the Examining Division appeared to have been overcome by amendment. However, a new objection under Article 123(2) EPC was raised in connection with the amended claims.
- IV. With a letter dated 27 May 2014 new claims 1-16 were filed and the appellant requested "that the case be remitted to the Examining Division for issuance of a communication according to Rule 71(3) EPC."
- V. Claim 1 filed with the letter dated 27 May 2014 reads:
- "A wristband (10) comprising:
a face stock (13);
a protective coating (14), said protective coating (14) is hydrophobic;
a thermal chemical imaging layer (32) positioned between, and adjacent to, said face stock (13) and said protective coating (14); and*

an ultraviolet curable antimicrobial coating (11) positioned adjacent to said protective coating (14), said ultraviolet curable antimicrobial coating (11) supports pass through of direct thermal printing such that indicia can be printed on the thermal chemical imaging layer (32) through said ultraviolet curable antimicrobial coating (11) proximate to said thermal chemical imaging layer (32)."

Claim 12 filed with the letter dated 27 May 2014 reads:

"A method of constructing a wristband comprising: providing a face stock (13) having a thermal chemical imaging layer (32) directly positioned onto at least a portion of at least one surface of said face stock (13); applying a hydrophobic protective coating (14) onto the chemical imaging layer (32); and positioning an ultraviolet curable antimicrobial coating (11) adjacent to said protective coating (14) such that said protective coating (14) is positioned between, and adjacent to, said thermal imaging layer (32) and said ultraviolet curable antimicrobial coating (11); said ultraviolet curable antimicrobial coating (11) supports pass through of direct thermal printing such that indicia can be printed on the thermal chemical imaging layer (32) through said ultraviolet curable antimicrobial coating (11) proximate to said thermal chemical imaging layer (32)."

VI. The Examining Division found essentially as follows:

Claim 1 is based on original independent claim 18 in amended form, the amendments being as follows:

"1. the feature 'the antimicrobial coating is ultraviolet curable' has been added

2. the feature 'the ultraviolet curable antimicrobial coating is receptive to a direct thermal printing process such that indicia can be printed through said ultraviolet curable antimicrobial coating proximate said thermal chemical imaging layer' has been added

3. the feature 'indicia imprinted on said chemical layer using direct thermal printing' has been removed from the claim".

Feature 1 had a valid basis in the application as filed in original claim 23. However, neither feature 2 nor feature 3 was disclosed in the claims of the application as originally filed, nor could any basis be found in the description.

The passages of the description cited by the applicant (now the appellant) as a basis, namely page 2, lines 10-13; page 10, lines 27-28 in combination with figure 9; page 11, lines 6-13; and page 12, lines 7-11 all refer to a wristband, and not to an "identification device" as defined in claim 1. Moreover, this described embodiment further comprises a "protective layer 14" (see e.g. figures 5 and 9) which is absent from claim 1. Features 2 and 3 therefore involve a generalisation of one specific embodiment of the description as originally filed.

Furthermore, the wording "being receptive to" as directed to an "ultraviolet curable antimicrobial coating" is not disclosed in the application as originally filed.

VII. Under the heading "Obiter dictum" the Examining Division also argued that independent method claim 13 contravened Article 123(2) EPC for essentially the same reasons mentioned for claim 1, and that dependent claims 4 and 17 did not find a valid basis in the application as originally filed as the feature "Triclosan" was only disclosed as being present in an antimicrobial coating which was "water based" but not in an antimicrobial coating which was "UV curable" (cf. page 9, line 24 to page 10, line 9).

VIII. The appellant's arguments may be briefly summarised as follows:

In response to the findings of the Examining Division a "wristband" was now recited in the claims instead of an "identification device", and a "protective" coating had also been included in the claims.

The phrase "being receptive to" had been replaced by "said ultraviolet curable antimicrobial coating (11) supports pass through of direct thermal printing..." (emphasis added by the appellant). This was supported by claim 26 and by page 2, lines 12-13 of the application as filed.

The further objection raised by the Board in the communication under Rule 100(2) EPC had been overcome by amending claim 1 to incorporate the feature "*indicia can be printed **on the thermal chemical imaging layer** through said ultraviolet curable antimicrobial coating*" (emphasis added by the appellant). Independent claim 12 had been amended analogously.

Reasons for the Decision

1. The appeal is admissible.
2. *The Content of the Application as Filed*
 - 2.1 Before examining whether the amendments made to the claims comply with Article 123(2) EPC it is necessary to have a clear picture of the subject-matter constituting the content of the application as filed, i.e. the PCT application published as WO 2006/116670 (Article 153(2) EPC).
 - 2.2 In this regard, apparent errors in the formal dependencies of certain claims were already noted in the international phase (see Item VIII, points 2-4 of the Written Opinion of the International Searching Authority).

The application as filed comprises independent claims 1, 18, 26 and 33, each followed by a series of dependent claims. As would normally be expected, the dependent claims 2-17 all depend on claim 1, or on claims which ultimately depend on claim 1.

However, claims 19-25, which might typically be expected to depend on independent claim 18, in fact depend on claim 17, which is itself dependent on claim 1. A similar situation arises in the case of claims 27-32 which directly follow independent claim 26, but in fact are formally dependent on claim 25 (or claims dependent thereon), which is itself dependent on claim 17 (and via claim 17 on claim 1). Similarly, claim 34 is not formally dependent on independent claim 33 which directly precedes it, but on claim 32 (which refers back to dependent claim 25).

This unusual and, if the dependencies are taken at face value, apparently illogical layout for the claims points to an error in the labelling of the dependencies.

This error may be confirmed by looking into the subject-matter of the claims as originally filed. Claims 19 and 20 (formally dependent on claim 17) refer to "said thermal chemical imaging layer", a feature which is absent from claim 17, but present in independent claim 18. Claims 27-29 and 32 refer to the "method of claim 25", despite the fact that claim 25 is a claim to an identification device and not a method. Dependent claim 34 (formally dependent on claim 32) also refers to "the thermal chemical imaging layer" which is absent from claim 32, but present in independent claim 33.

Moreover, it is noted that in the set of claims filed with the letter dated 3 October 2008 these discrepancies in the claim dependencies were eliminated.

- 2.3 In relation to Article 123(2) EPC, "what matters is what a skilled person would objectively have derived from the description, claims and drawings of a European patent application on the date of filing" (G 3/89, OJ EPO 1993, 117, Reasons, point 2). For the reasons given above, the Board has no doubt that a skilled person reading the application as filed would immediately recognize that a clerical error had been made in the dependencies of the claims, and that claims 19-25 are intended to refer back to claim 18, claims 27-29 and 32 are intended to refer back to claim 26 and claim 34 is intended to refer back to claim 33.

The application as filed will therefore be interpreted in this manner for the purposes of examination for compliance with the requirements of Article 123(2) EPC.

3. *Article 123(2) EPC*

3.1 Some of the objections raised in the contested decision were based on the finding that certain passages of the description concerning a wristband having a protective coating had been cited by the applicant-appellant as a basis for claim 1. However, the subject-matter of claim 1 on which the contested decision was based was not limited to a wristband and did not include a protective coating, and therefore the Examining Division found that claim 1 constituted an unallowable generalisation of the originally disclosed material.

Current claim 1 is limited to a wristband and includes a protective coating, and hence the specific objections mentioned in the previous paragraph have been overcome by amendment. Whether further objections under Article 123(2) EPC remain - or whether new objections arise as a result of amendments made - will now be examined in detail.

3.2 The application discloses a first embodiment employing thermal transfer printing onto the antimicrobial layer, and a second embodiment employing direct thermal printing onto the thermal chemical imaging layer through the antimicrobial layer (see e.g. page 2, lines 6-13 and claim 1 as originally filed). The present claims are restricted to the second alternative (direct thermal printing).

3.3 Consequently, the Board considers that a first possible starting point for examining claim 1 for compliance with Article 123(2) EPC would be the second alternative of claim 1 as originally filed ("indicia imprinted...through said antimicrobial layer") in combination with claims 2 and 3. An alternative starting point would be independent claim 18 as originally filed (seen as the basis for claim 1 in the contested decision), which also concerns an identification device which is directly thermally printed.

The Board finds it appropriate to base its analysis on the subject-matter of the second alternative of claim 1 as originally filed and claims dependent thereon. It is pointed out, however, that the subject-matter of claim 18 (and claims dependent thereon) is essentially an alternative presentation of the same material, and may also be relevant.

3.4 In the following the Board has added labels (a)-(g) to the features of current claim 1 and omitted reference signs; the features of original claim 1 are in normal type, the amendments by addition are in bold type, and the amendments by excision are in "strike through".

3.4.1 Feature (a)

A **wristband** [~~identification device~~] comprising:

- Basis: claim 13 as filed. See also, for example, claim 25 as filed (noting the dependency errors mentioned above); page 2, second, fourth and fifth paragraphs; page 4, lines 18-26; page 5, third paragraph; and page 7, second paragraph.

Feature (b)

a face stock;

Feature (c)

a protective coating [~~positioned at least one of proximate or adjacent to at least a portion of at least one surface of said face stock~~], **said protective coating is hydrophobic;**

- Basis: The combination of a protective coating and a wristband follows from original claims 1 and 13. See also, for example, the fourth paragraph on page 2; page 4, lines 18-26; and the second paragraph on page 7.
- The positional details of the protective coating defined in original claim 1 may be omitted as a more precise definition of this subject-matter is included in features (d) and (e), below.
- The feature that the protective coating "is hydrophobic" is based on claim 8 as filed (see also page 7, second paragraph).

Feature (d)

a thermal chemical imaging layer positioned between, and adjacent to, said face stock and said protective coating; and

- Basis: claim 2 as originally filed.

Feature (e)

an **ultraviolet curable** antimicrobial coating positioned **adjacent to** [~~on at least a portion of~~] said protective coating

- Basis: the antimicrobial coating being *ultraviolet curable* is disclosed in original claim 11 (see also original claim 23 and page 2, lines 18-22).
- It may be doubted whether the amendment from "on at least a portion of" to "adjacent to" implies any substantial change, but in any event claim 19 (which is, when properly construed, dependent on claim 18) discloses that the protective layer and the antimicrobial layer are positioned "adjacent to" each other.
- It may also be noted that, taken together, features (d) and (e) define that the four layers are *adjacent* to each other *in the following order*: face stock/thermal chemical imaging layer/protective coating/antimicrobial coating. Such a structure is also disclosed in figure 9 and in the final paragraph on page 10.

Feature (f)

said ultraviolet curable antimicrobial coating supports pass through of direct thermal printing

- Basis: direct thermal printing is disclosed in claim 3 as originally filed; literal support for the phrase "supports pass through" may be found on page 2, lines 11-13. Further basis for the role of the antimicrobial coating in direct thermal printing is explained below (see Feature (g)).

Feature (g)

such that indicia can be printed on the thermal chemical imaging layer through said ultraviolet curable antimicrobial coating proximate to said thermal

chemical imaging layer [~~indicia imprinted ... through said antimicrobial layer using a printing process~~].

- Printing "through" the antimicrobial coating is disclosed in claim 1 as originally filed, and direct thermal printing "through" the antimicrobial layer is also disclosed on page 2, lines 8-11 and 20-22.

- Moving from a device having indicia imprinted on the chemical layer by direct thermal printing (as in the combination of original claims 1 and 3) to a device (wristband) on which indicia *can be printed* on the chemical layer by direct thermal printing is supported at least by the paragraph bridging pages 10 and 11. The Examining Division's objection that this passage and the passage cited above in connection with feature (f) are insufficiently general, as they are limited to an embodiment in which the device is a wristband and also comprises a protective layer has been rendered moot by the incorporation of these limiting features into claim 1.

- Further support is provided by those parts of the original application disclosing the process by which direct thermal printing results in the indicia, which therefore implicitly disclose the device before and after the printing takes place (for example, page 2, lines 6-22; page 12, lines 3-11 and claim 26 in combination with claim 31).

- That the antimicrobial coating is "proximate to" said thermal chemical imaging layer is an adoption of wording found in claim 18 as originally filed; this feature is in any event essentially redundant

as the positional relationship of these layers has already been precisely defined earlier in the claim.

3.5 The Board is therefore satisfied that current claim 1 meets the requirements of Article 123(2) EPC.

4. *Other claims*

Independent method claim 12 may be considered to be based on original method claim 26 (or 33), together with amendments essentially corresponding to those found to satisfy the requirements of Article 123(2) EPC in relation to claim 1.

Dependent claims 4 and 17 which were objected to by the Examining Division have been excised (with a consequent renumbering of other claims).

No objection under Article 123(2) EPC was raised in the contested decision against the subject-matter of present dependent claims 2-11 and 13-16, and the Board finds these claims to be satisfactorily based on dependent claims as originally filed.

5. *Further Procedure*

5.1 The appellant requested "that the case be remitted to the Examining Division for issuance of a communication according to Rule 71(3) EPC."

A communication under Rule 71(3) EPC is only issued when it has been decided that all requirements for the grant of a patent have been met. In the present case, the application was refused on the sole ground that the requirements of Article 123(2) EPC were not met,

without consideration of these other requirements. The Board therefore considers it appropriate to remit the case to the department of first instance under Article 111(1) EPC 1973 to consider and decide upon these other matters.

For the avoidance of any doubt, the Board stresses that it has decided *only* that claims 1-16 filed with the letter dated 27 May 2014 meet the requirements of Article 123(2) EPC. All other matters are left open to be decided by the Examining Division.

Oral proceedings were requested only if the Board found that the "application and the invention to which it relates do not meet the requirements of the European Patent Convention". Hence, oral proceedings before the Board were not required in the present case.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated