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**Datasheet for the decision
of 26 April 2021**

Case Number: T 1661/16 - 3.2.06

Application Number: 06733373.2

Publication Number: 2010118

IPC: A61F13/15, B65H23/188

Language of the proceedings: EN

Title of invention:

METHOD AND ARRANGEMENT FOR DETECTION OF A SYNCHRONIZING MARK
BEING USED IN SYNCHRONIZED POSITIONING OF AT LEAST ONE
ESSENTIALLY CONTINUOUS MATERIAL WEB

Patent Proprietor:

Essity Hygiene and Health Aktiebolag

Opponents:

Kimberly-Clark Worldwide, Inc.
The Procter & Gamble Company

Headword:

Relevant legal provisions:

EPC Art. 84, 112(1) (a)
RPBA 2020 Art. 13(1)

Keyword:

Claims - main request (no)

Referral to the Enlarged Board of Appeal - (no) - uniform application of law

Amendment to appeal case - exercise of discretion - state of the proceedings - amendment detrimental to procedural economy (yes)

Decisions cited:

G 0001/91, G 0003/14

Catchword:

see Reasons 1.4.1 to 1.4.5



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Case Number: T 1661/16 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 26 April 2021

Appellant: The Procter & Gamble Company
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Respondent: Essity Hygiene and Health Aktiebolag
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Representative: Nederlandsch Octrooibureau
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Party as of right: Kimberly-Clark Worldwide, Inc.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
31 May 2016 concerning maintenance of the
European Patent No. 2010118 in amended form.**

Composition of the Board:

Chairman M. Harrison
Members: T. Rosenblatt
 A. Jimenez

Summary of Facts and Submissions

- I. The appellant (opponent 2) filed an appeal against the interlocutory decision of the opposition division, in which it found that European patent No. 2 010 118 in an amended form met the requirements of the EPC. It requested that the decision under appeal be set aside and the patent be revoked.
- II. In its reply to the appeal, the respondent (patent proprietor) requested dismissal of the appeal (main request) or, as an auxiliary measure, that the patent be maintained in an amended form according to one of the concurrently submitted auxiliary requests 1 to 7.
- III. With its letter of 29 June 2017 the appellant raised further objections against the auxiliary requests.
- IV. With its communication dated 19 August 2019 the parties were summoned to oral proceedings.
- V. Further auxiliary requests (entitled "main requests B and C" and "auxiliary request 4B") were submitted by the respondent with its letter dated 19 December 2019.
- VI. In a further submission, the appellant opposed *inter alia* the admittance of these latter requests.
- VII. In a communication pursuant to Article 15(1) RPBA 2020, the Board informed the parties of its provisional opinion that the appellant's objections under Article 84 EPC against the independent claims of the respondent's main request appeared to have merit (see paragraphs 2.1 and 2.2 of the Board's communication). The Board further opined that the auxiliary requests 1

to 7 failed to remedy *inter alia* the clarity objections (see paragraph 5.1 of the Board's communication). Concerning the other requests ("main requests B and C", "auxiliary request 4B"), admittance into the proceedings appeared questionable under Article 13(1) RPBA 2020 (see paragraph 5.2 of the Board's communication). The Board also indicated that, in view of the objections under *inter alia* Article 84 EPC having been raised in the appeal grounds, no reason could be seen to admit other requests into the proceedings.

- VIII. Further comments were then submitted in a subsequent letter from the respondent.
- IX. The oral proceedings were held by videoconference on 26 April 2021. The party as of right, opponent 1, was not present or represented, as announced in their letter dated 12 April 2021. During the oral proceedings, the respondent submitted two sets of amended claims, each labelled "First auxiliary request", the second, subsequently filed set replacing the first. Except for its initially filed main request and this second version of the first auxiliary request submitted at 14:15h during the oral proceedings, the respondent withdrew all other requests previously filed (i.e. initially filed auxiliary requests 1 to 7, "main requests B and C" and the combinations of these latter amendments together with the amendments of auxiliary requests 1 to 7 as had been alluded to in writing, and "auxiliary request 4B").
- X. The appellant (opponent 2) requested that the decision under appeal be set aside and the European patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed and the patent be maintained in the form found to meet the requirements of the EPC by the opposition division (main request) or, alternatively, on the basis of the first auxiliary request filed at 14:15h during the oral proceedings and that the questions put forward during the oral proceedings be referred to the Enlarged Board of Appeal.

XI. The aforementioned questions, submitted by email during the oral proceedings, to be referred to the Enlarged Board of Appeal, read as follows:

"1. In opposition proceedings, where the patent has been amended and the opposition division has dealt with an objection of lack clarity to the amended text and no substantive issues of novelty, inventive step, added matter or sufficiency hinge on the amendment (benign issue of clarity), is this to be considered a matter of the 'discretion' of the opposition division that should only be exceptionally overruled by a Board of Appeal ?

2 Does the answer to question 1 depend on whether the issue is a linguistic matter or a legal/technical matter?"

XII. The party as of right, opponent 1, made no request.

XIII. The subject-matter of independent claims 1 and 7 of the main request have the following wording:

"1. Method for detection of a synchronizing mark (6) being used in synchronized positioning of at least one continuous material web (2), for manufacturing products (20) that comprise a printed motif (5; 5'), which said material web (2) is intended to be divided into a

nominal division length (L_N), where the nominal division length (L_N) being defined between two transverse positions (7, 8) that delimit a particular product, where said material web (2) comprises synchronizing marks (6) with a periodicity (L_S), which method comprises:

establishing a longitudinal detection zone (24) along a side edge of the material web, said longitudinal detection zone (24) including part of the printed motif (5; 5') and the synchronizing mark (6),
detection of the respective synchronizing mark (6) for positioning the respective motif (5; 5') in a predetermined position on the respective product (20), which detection is carried out in said longitudinal detection zone (24) in a machine direction of said material web (2):

characterized in that said method comprises:
detection of said synchronizing mark (6) by distinguishing its colour or colour combination from colours or colour combinations of the printed motif (5; 5') in the rest of said detection zone (24), wherein the synchronizing mark is printed in a colour or colour combination that is different from any section of the printed motif in said detection zone (24)."

"7. Arrangement for detecting a synchronizing mark (6) that is utilized for synchronized positioning of at least one continuous material web (2) for manufacturing products (20) that comprise a printed motif (5; 5'), which said material web (2) is intended to be divided into a nominal division length (L_N) where the nominal division length (L_N) being defined between two transverse positions (7, 8) that delimit a particular product, where said material web (2) comprises synchronizing marks (6) with a periodicity (L_S), which arrangement comprises

a detector (10) for detecting the respective synchronizing mark (6) in a machine direction of said material web (2), and
a computer-based control unit (13) arranged for said synchronization, whereby part of the respective motif (5; 5') is positioned in a longitudinal detection zone (24) along a side edge of the material web, said longitudinal detection zone including part of the printed motif and the synchronizing mark, characterized in that
the control unit (13) is arranged to detect said synchronizing mark (6) by distinguishing its colour or colour combination from colours or colour combinations of the printed motif in the rest of said detection zone (24),
and in that the synchronizing mark is printed in a colour or colour combination that is different from any section of the printed motif in said detection zone (24)."

Claim 1 of the first auxiliary reads as follows (mark-up of the amendments with respect to the main request added by the Board):

"Method for detection of a printed [sic] synchronizing mark (6) being used in synchronized positioning of at least one continuous material web (2), for manufacturing products (20) that comprise a printed motif (5; 5'), which said material web (2) is intended to be divided into a nominal division length (L_N), where the nominal division length (L_N) being defined between two transverse positions (7, 8) that delimit a particular product, where said material web (2) comprises synchronizing marks (6) with a periodicity (L_S), which method comprises:

establishing a longitudinal detection zone (24) along a side edge of the material web, said longitudinal detection zone (24) including part of the printed motif (5; 5') and the synchronizing mark (6), detection of the respective synchronizing mark (6) for positioning the respective motif (5; 5') in a predetermined position on the respective product (20), which detection is carried out in said longitudinal detection zone (24) in a machine direction of said material web (2) :

characterized in that said method comprises:
detection of said synchronizing mark (6) by distinguishing its colour or colour combination from colours or colour combinations ~~of the printed motif (5; 5')~~ in the rest of said detection zone, including colours or colour combinations of the printed motif (5; 5') in the rest of said section detection zone (24), wherein the synchronizing mark is ~~printed~~ in a colour or colour combination that is different from any section of the printed motif in said detection zone (24)."

Independent claim 7 was deleted in the first auxiliary request.

XIV. The arguments of the appellant may be summarised as follows:

Main request - claim 7 - Article 84 EPC

The last feature added to independent claim 7 gave rise to a lack of clarity. Claim 7 was directed to an arrangement for detecting a synchronising mark, but neither the continuous web nor the synchronising mark with which it was printed, was a part of the claimed entity. The claimed invention was thus defined in terms

of a feature (i.e. the continuous web having a printed synchronising mark) which was not a part of the claimed entity (i.e. the arrangement). The first feature in the characterising portion of claim 7 already defined that the detector had to be suitable for distinguishing those features which followed in the second feature of the characterising portion. Since the preamble of claim 7 already defined that the detection was made in regard to a printed motif, it was unclear whether and what kind of a further limitation was implied for "the arrangement" by the final feature and in particular by the condition that the synchronising mark "is printed".

First Auxiliary request - Article 13(1) RPBA 2020

The submission of this request was not a reaction to something that was discussed during the oral proceedings for the first time. The request should not be admitted.

- XV. The arguments of the respondent may be summarised as follows:

Main request - claim 7 - Article 84 EPC

The claim had to be read by the skilled person with a mind willing to understand. The final feature in claim 7 related to the suitability of the arrangement for the detection of the characteristics of the web. No clarity objection would have been raised if the same feature had been defined in the claim's preamble. The fact that the feature might not actually make clear what it added in terms of further structural limitations to the arrangement did not mean that it was fundamentally unclear.

The opposition division had already considered the feature to be clear for a skilled person. No other aspect of the impugned decision, like for example novelty or inventive step, hinged on the alleged ambiguity. The alleged ambiguity of the added, entirely benign wording was thus merely of a linguistic nature.

Interpreting the grammatical context and language of a claim was very much a subjective exercise of discretion. Revisiting such discretionary aspects of first instance decisions would thwart the objective of the appeal procedure contrary to what was intended by the new RPBA. In cases where the point of contention was a matter of language rather than law, clarity could not be considered substantive. Consequently, there could not be "a judicial review" of language *per se* when considering Article 12(2) RPBA 2020, but only of the effect it could have on a substantive aspect of the case. In the event that the Board still considered itself obliged to review the discretion exercised by the first instance department on this point, this would be considered a significant departure from the established case law. Such departure would merit a question to the Enlarged Board of appeal (see above XI.).

First Auxiliary request - Article 13(1) RPBA 2020

This auxiliary request should be admitted since it was a response to objections discussed during the oral proceedings.

Reasons for the Decision

Main request - Article 84 EPC

1. Independent claim 7 lacks clarity (Article 84 EPC).
- 1.1 Article 84 EPC sets out: "The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description."

The requirement of clarity of Article 84 EPC of an amendment is a substantive requirement which has to be met when maintenance of a patent in amended form is requested (Article 101(3)(a) EPC). This is long established case law, confirmed for example by the Enlarged Board's decisions G 1/91 (Reasons 5.2, OJ EPO 1992, 253) and G 3/14 (OJ EPO 2015, A102). G 10/91 (Reasons 19, OJ EPO 1993, 420) is also clear on the understanding that amendments made (to a granted patent) shall fulfil the requirements of the EPC.

- 1.2 Claim 7 of the main request is directed to an arrangement for detecting a synchronizing mark (6) that is utilized for synchronized positioning of at least one continuous material web (2) for manufacturing products (20) that comprise a printed motif (5; 5'). It is undisputed that the material web and its properties are not structural features of the claimed arrangement. Instead, the references to the material web, the printed motif, the synchronising marks and their respective colours and colour combinations only imply structural and functional limitations in as far as the suitability of the claimed arrangement for the detection of the synchronizing mark and its distinction

from the printed motif are concerned.

- 1.3 The last feature in the claim, however, leaves it unclear to the skilled person what further structural or functional limitation could be implied to the claimed arrangement. In fact, the first feature in the characterising portion is directed to the suitability of the control unit to detect the synchronizing mark by distinguishing its colour or colour combination from colours or colour combinations of the printed motif in the rest of the detection zone. The second feature in the characterising portion, i.e. the last feature of the claim, added during the opposition procedure, "in that the synchronizing mark is printed in a colour or colour combination that is different from any section of the printed motif in said detection zone (24)", again, relates to the same colour properties of the synchronising mark on the web used to define the suitability of the control unit in the preceding feature. The only difference in this added wording compared to the first feature of the characterising portion lies in the definition that the synchronizing mark "is printed".

The Board notes that, contrary to the first feature in the characterising portion, the added feature does not even refer to the control unit or the detector. It is exclusively directed to properties of the web which, as such, is not a feature of the arrangement.

According to the preamble of claim 7 the motif on the web is a printed motif. The skilled person understands that, according to the combination of features preceding the last feature of the claim, the detector and the control unit of the arrangement are already suitable to distinguish the synchronising mark from a

printed motif and consequently must be able to detect printed features on the web (as also argued by the appellant). It remains then entirely unclear to the skilled person which further structural or functional limitation to the arrangement, its control unit or the detector could be implied by a synchronizing mark which is printed. The respondent was unable to indicate what kind of limitation was implied.

1.4 Instead the respondent's arguments were based on its perception that the objection addressed only linguistic aspects which did not amount to a fundamental lack of clarity. The Board is, however, not convinced by the arguments submitted in this regard for the following reasons.

1.4.1 As set out already above (Reasons 1.1), there can be no doubt after more than 40 years of jurisprudence of the Boards of Appeal that the requirement of clarity of Article 84 EPC for an amendment is a substantive requirement. Any conclusion of the opposition (or, should the case be such, the examining) division in this regard which has been given in a reasoned decision can be challenged by the adversely affected party and then be reviewed by the Board of Appeal.

1.4.2 Despite being specifically asked to cite any such case law, the respondent was unable to indicate any such decision and the Board is not aware of any such decision, which would support its underlying contention that different types or quality of clarity objections ("linguistic or benign" versus "fundamental") existed, let alone that a decision on clarity by an opposition division could be considered a "matter of discretion" and that the Board only had a limited power of review in such cases. The two decisions cited by the

respondent (T 820/14, T 1816/11) are entirely irrelevant on this latter aspect (i.e. concerning its contention that a decision on clarity is a matter of discretion).

Distinguishing between the perceived quality of clarity objections and making a "judicial review" (noting that Article 12(2) RPBA 2020 refers to a "review in a judicial manner") of a clarity objection dependent on its potential impact on other requirements (for example inventive step) has no basis whatsoever in the EPC. The Board cannot find anything of relevance in this regard in Article 12(2) RPBA 2020 either, which was notably referred to simply in a general manner by the respondent.

- 1.4.3 Even if the Board were to concur with the respondent that interpreting the grammatical context and language of a claim may be considered a "subjective" exercise, it would nevertheless not be an exercise of discretion. The subjective component in the task of interpretation is, anyway, eliminated by taking the position of the skilled person. The crucial question here is not whether the wording of the added feature would be perceived (fundamentally) as unclear, which may be seen differently by different readers. Rather, the objection raised by the appellant boils down to the questions addressed to the skilled person of whether the added feature (i.e. the feature added after grant) introduces a further structural or functional limitation to the claimed arrangement and, then, what such limitation is. This question can be answered objectively: the skilled person cannot see any clear, further structural or functional limitation implied by the amendment to the claimed arrangement. It can objectively be concluded that amended claim 7, which shall define the matter for

which protection is sought, is not clear in this regard, because it is not clear what limitation to the matter for which protection is sought is being made by the amendment. The claim thus lacks clarity, contrary to Article 84 EPC.

- 1.4.4 The appellant argued that it was not required to specify what the structural limitation was. It was sufficient, in its view, that some limitation may be present in terms of the "suitability" of the control device or the detector for the situation given, and that if no limitation was recognised or apparent, the clarity of the claim was not as such affected.

The Board however does not concur. The meaning, in terms of the limiting effect, of features introduced into a claim must be clear in order that the claim as a whole is clear. To argue (as the respondent does) that it is not relevant whether a limitation might or might not be present, does not overcome such objection, it simply emphasises that fact that the claim is not clear. The respondent's further argument that it was not a person skilled in the art and could thus not establish whether any limitation was present, or what it might be, does not in any way address the fundamental lack of clarity present.

- 1.4.5 Hence, the conclusion of the opposition division in regard to the requirement of clarity under Article 84 EPC given in its reasoned decision and challenged by the adversely affected party is open to a review by the Board of Appeal, irrespective of the potential impact of the relevant feature on the assessment of other requirements of the EPC (which anyway has not been established).

1.4.6 Finally, the respondent's argument relating to the hypothetical situation of whether a similar clarity objection would have been successful or not in the case that the same feature had been added in the claim's preamble, in some sort of "suitable for"-clause, lacks relevance. The amended claim on which the Board had to judge did not comprise such an amendment.

Request for a referral of questions to the Enlarged Board of Appeal

2. For the reasons given below, the Board refused the respondent's request for a referral of two questions to the Enlarged Board of Appeal (see Summary of Facts and Submissions XI.).

2.1 According to Article 112(1)(a) EPC, in order to ensure uniform application of the law, or if a point of law of fundamental importance arises the Board of Appeal shall, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes.

2.2 No decision by the Enlarged Board of Appeal is however required in the present case.

The questions might arguably be considered as being of interest due to the possibly high number of decisions of opposition divisions based on clarity objections. However, the Board finds that the case law has been uniformly applied on the particular aspect raised in the questions. The respondent did not indicate any conflicting case law and the Board is not aware of such conflicting decisions either. Moreover, the Board has

no difficulty in deciding the questions by itself (see Reasons 1.4.1 to 1.4.5). It is noted that the second question is dependent on the first question, and since the answer to the first question is already apparent from the Board's reasoning above, the second question lacks all relevance to the case in hand.

First auxiliary request - Article 13(1) RPBA 2020

3. The Board exercised its discretion under Article 13(1) RPBA 2020 not to admit the first auxiliary request into the proceedings.
- 3.1 During the oral proceedings the respondent subsequently submitted two sets of amended claims, both entitled "First auxiliary request". The first version replaced the first auxiliary request submitted with their reply to the appeal grounds, whereby the second, later version in turn replaced the first version after it had been discussed.
- 3.2 The only remaining first auxiliary request was thus filed after the reply to the appeal and constitutes an amendment to the respondent's appeal case. It may be admitted only at the discretion of the Board (Article 13(1) RPBA 2020).
- 3.3 The introduction of the term "prnted" in the first line of the method claim 1 (which was confirmed by the respondent to have meant "printed") and the corresponding deletion of "printed" in the last feature of the claim in the terminology "is printed" were stated to have been made to overcome a clarity objection raised in the appeal grounds (see paragraphs (11) and (12)). The appellant had challenged the opposition division's conclusions in paragraph 15 of

the impugned decision. In its preliminary opinion the Board had also indicated that this objection appeared to have merit (see paragraph 2.1).

- 3.4 No reason was given by the respondent as to why the proposed amendment could not have been submitted earlier in the appeal procedure (noting that Article 13(1) RPBA 2020, 3rd sentence, states that a "party shall provide reasons for submitting the amendment at this stage of the appeal proceedings").

Also, no new aspect in regard to the clarity objection made against the independent method claim with the grounds of appeal had arisen from the discussions during the oral proceedings.

Lastly, the respondent had numerous opportunities to submit appropriate amendments in the written part of the proceedings (see Summary of Facts and Submissions II. to VIII.).

Under these circumstances the Board finds the submission of the first auxiliary request at the latest possible stage in the proceedings, as being far too late and consequently detrimental, not least, to procedural economy. For this reason the Board exercised its discretion as stated above.

4. Absent any request which meets the requirements of the EPC, the patent must be revoked (Article 101(3)(b) EPC).

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is refused.
2. The decision under appeal is set aside.
3. The patent is revoked.

The Registrar:

The Chairman:



D. Grundner

M. Harrison

Decision electronically authenticated