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**Datasheet for the decision
of 19 December 2023**

Case Number: T 3068/19 - 3.2.05

Application Number: 14722073.5

Publication Number: 3003732

IPC: B44C1/17

Language of the proceedings: EN

Title of invention:

Textured heat transfer label

Applicant:

Illinois Tool Works Inc.

Relevant legal provisions:

EPC Art. 83, 84, 111(1), 113, 116, 123(2)

RPBA 2020 Art. 11, 12(8)

Keyword:

Amendments - allowable (yes)

Sufficiency of disclosure (yes)

Claims - previous clarity objections overcome (yes)

Remittal (yes)

Decision in written proceedings



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Case Number: T 3068/19 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 19 December 2023

Appellant: Illinois Tool Works Inc.
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Glenview, IL 60025 (US)

Representative: Meissner Bolte Partnerschaft mbB
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 3 July 2019
refusing European patent application No.
14722073.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman P. Lanz
Members: M. Holz
A. Bacchin

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse European patent application No. 14 722 073.5 (the "application").
- II. The decision under appeal is based on the examining division's view that the requirements of Article 83 EPC were not met with respect to the claims filed on 15 February 2018. The examining division concluded that the application did not provide a sufficient disclosure that would allow the skilled person to arrive at the claimed textured heat transfer label or a substrate having a transferred label with a raised textured surface (see point 12.4 of the Reasons for the decision under appeal).
- III. In a communication pursuant to Rule 100(2) EPC dated 24 May 2022, the board set out its preliminary view that, in particular, the requirements of Articles 84 and 83 EPC were not met with respect to the claims filed on 15 February 2018.
- IV. On 28 September 2022, the appellant (applicant) submitted observations regarding the objections raised under Articles 84 and 83 EPC with respect to the claims filed on 15 February 2018 and filed amended claims 1 to 4 as an auxiliary request.
- V. In a further communication pursuant to Rule 100(2) EPC dated 13 April 2023, the board maintained its objections under Articles 84 and 83 EPC with respect to the claims filed on 15 February 2018 and set out its preliminary view that these objections were, however,

overcome by the claims filed on 28 September 2022 as the auxiliary request.

- VI. On 21 June 2023, the appellant withdrew its previous main request (corresponding to the claims filed on 15 February 2018) and requested that the case be remitted to the examining division for further prosecution.
- VII. The appellant's requests are that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution.
- VIII. Claim 1 as filed on 28 September 2022, according to the only request on file, reads as follows:

"A method of transferring a marking to a substrate (22'), comprising steps of:

- providing a substrate (22') to be marked;*
- making a heat transfer label (10'); and*
- applying the heat transfer label (10') to the substrate (22'),*

wherein the making-step comprises the following sub-steps in a sequenced order:

- printing a textured layer (14') including a raised portion (30') and an unprinted portion (32') on a carrier (12');*
- curing the textured layer (14'); and*
- printing a background layer (16') over the cured textured layer (14') on the carrier (12'), and wherein the step of applying the heat transfer label (10') to the substrate (22') comprises the following sub-steps in a sequenced order:*

- placing the heat transfer label (10') on the substrate (22'), such that the background layer (16') faces the substrate (22');*

- applying heat and pressure on the carrier (12'), such that the background layer (16') softens and adheres to the substrate (22'); and

- removing the carrier (12'), wherein the textured layer (14') remains attached to the background layer (16'), such that the textured layer (14') is transferred to the substrate (22'), wherein, in the making-step, the background layer (16') is disposed over the textured layer (14') so as to extend across both the raised portion (30') and the unprinted portion, and wherein, in the step of applying heat and pressure on the carrier (12'), the background layer (16') is subjected to heat and pressure, so that it softens and becomes tacky, so that adhesion between the background layer (16') and the substrate (22) is greater than an adhesion between the background layer (16') and the carrier (12')."

Reasons for the Decision

1. Decision in written proceedings

The decision is to be issued in written proceedings without oral proceedings being held.

In accordance with Article 12(8) of the Rules of Procedure of the Boards of Appeal of the European Patent Office in the version applicable as from 1 January 2020 (RPBA 2020, see OJ EPO 2019, A63, and OJ EPO 2021, A35), which applies to the appeal at hand in accordance with Article 25(1) and (2) RPBA 2020, the board may, subject to Article 113 and 116 EPC, decide on the case at any time after the filing of the statement of grounds of appeal.

The order of this decision complies with the appellant's main request. The findings of this decision correspond to those indicated in the communication under Rule 100(2) EPC dated 13 April 2023, in which all of the appellant's submissions were taken into account and on which the appellant had the opportunity to react.

The issuance of the decision in written proceedings without oral proceedings being held thus complies with the requirements of Articles 113(1) and 116(1) EPC (see also "Case Law of the Boards of Appeal", 10th edition, 2022, III.B.2.7.3).

2. **Compliance with Article 123(2) EPC**

The only claims presently on file are claims 1 to 4 as filed on 28 September 2022 as the auxiliary request.

The board considers that the requirements of Article 123(2) EPC are met with respect to these claims.

Claim 1 as filed on 28 September 2022 combines steps of making a label (see, in particular, claim 10 as filed, including additional features disclosed in, for example, claim 7 and Figures 1, 2 and 4 to 11 as filed) with steps of applying the label to a substrate (see, in particular, paragraph [0052] of the description as originally filed) as disclosed in combination in the application as originally filed. The additional features of claims 2 to 4 as filed on 28 September 2022 have a basis in claims 11 to 13 as originally filed.

3. **Objection under Article 83 EPC**

The decision under appeal is based on the examining division's conclusion that the application did not provide a sufficient disclosure that would allow the skilled person to arrive at the claimed textured heat transfer label or a substrate having a transferred label with a raised textured surface (see point 12.4 of the Reasons). Consequently, in the examining division's view the application did not meet the requirements of Article 83 EPC.

In contrast to the claims on which the decision under appeal is based (i.e. the claims filed on 15 February 2018), the claims filed on 28 September 2022 as the auxiliary request do not define a feature relating to a textured heat transfer label or a substrate having a transferred label with a raised textured surface.

The objection under Article 83 EPC on which the decision under appeal is based is therefore overcome by the claims filed on 28 September 2022.

4. **Objections under Article 84 EPC raised by the board against the claims filed on 15 February 2018**

In the communication pursuant to Rule 100(2) EPC dated 24 May 2022, the board raised objections under Article 84 EPC against the claims filed on 15 February 2018. These objections have been overcome by the only claims now on file for the following reasons:

- 4.1 In point 7.3 of the above-mentioned communication, the board set out its view that it was not apparent whether the wording "... *providing a raised textured surface*" included in claim 1 as filed on 15 February 2018 referred to the state before or after the transfer to a substrate, or to both states.

The contested wording is not present in the claims currently on file, i.e. in claims 1 to 4 as filed on 28 September 2022 as the auxiliary request.

- 4.2 In point 7.4 of its communication, the board raised a clarity objection against claim 1 as filed on 15 February 2018, which is directed to a textured heat transfer label, and against claim 7 as filed on 15 February 2018, which is directed to a method of making a textured heat transfer label. The board explained that it was not apparent what degree of adhesion between the background layer and the carrier had to be present in the claimed heat transfer layer such that it could be determined that this adhesion would be less effective than the adhesion between the background layer and an arbitrary substrate, irrespective of the material and surface properties of the substrate.

A similar feature is included at the end of claim 1 as filed on 28 September 2022 as the auxiliary request. However, unlike the method of claim 7 as filed on 15 February 2018, the method of claim 1 as filed on 28 September 2022 explicitly includes a step of applying the heat transfer label to the substrate. By performing the method of this claim, it is possible to determine whether the adhesion between the background layer and the substrate is more effective than an adhesion between the background layer and the carrier,

as defined in claim 1 as currently on file. The skilled person is thus able to determine whether a specific method falls within the scope of claim 1 now on file. By including the method step of applying the heat transfer label to the substrate, the requirement defined at the end of claim 1 now on file does not refer to an arbitrary substrate but specifically to the substrate to which the heat transfer label is applied in the course of the claimed method.

5. **Conclusions**

Since the only objection on which the decision under appeal is based has been overcome by the claims filed on 28 September 2022 as the auxiliary request, the decision under appeal has to be set aside.

The present set of claims also overcomes the objections under Article 84 EPC that were raised by the board with its communication of 24 May 2022. However, whether or not the further requirements of the EPC (for example with respect to novelty and inventive step) are met still has to be examined. The board has therefore decided to comply with the appellant's request and remit the case to the examining division for further prosecution (see Article 111(1), second sentence, second alternative, EPC and Article 11 RPBA 2020).

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:



N. Schneider

P. Lanz

Decision electronically authenticated