

Publication in the Official Journal ~~Yes~~ / No

File Number: T 125/89 - 3.2.3

Application No.: 83 306 303.5

Publication No.: 0 106 695

Title of invention: Method of providing a surface effect in a release coating
and a release paper product

Classification: B05D 3/06, B05D 5/08, D21H 5/02

D E C I S I O N
of 10 January 1991

Applicant:

Proprietor of the patent: Scott Paper Company

Opponent: Leonhard Kurz GmbH & Co.

Headword:

EPC Article 56, 104(1), 113(1), 116(1)

Keyword: "Inventive step (affirmed for method), unconditional right for oral
proceedings (affirmed)"

Headnote



Case Number : T 125/89 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 10 January 1991

Appellant : Leonhard Kurz GmbH & Co.
(Opponent) Schwabacher Straße 482
8510 Fürth/Bayern (DE)

Representative : Pöhlau, Claus, Dipl.-Phys.
Patentanwälte
Louis, Pöhlau, Lohrentz & Segeth
Kesslerplatz 1
8500 Nürnberg (DE)

Respondent : Scott Paper Company
(Proprietor of the patent) Industrial Highway Tinicum Island Road
Tinicum Township
Delaware County, PA 19113 (US)

Representative : McCall, John Douglas
W.P. Thompson & Co.
Coopers Building
Church Street
Liverpool L1 3AB (GB)

Decision under appeal : Decision of Opposition Division of the European
Patent Office dated 30 January 1989 rejecting
the opposition filed against European patent
No. 0 106 695 pursuant to Article 102(2) EPC.

Composition of the Board :

Chairman : C.T. Wilson
Members : F. Brösamle
W. Moser

Summary of Facts and Submissions

- I. European patent application No. 83 306 303.5, filed on 18 October 1983 and published on 25 April 1984 under publication No. 0 106 695, was granted with six method and four product claims.

Claim 1 (method) as granted reads as follows:

"1. A method of providing a desired surface effect in a release coating on a substrate, comprising the steps of:
A. applying a coating of an electron beam radiation curable composition or material to a side of a substrate (7);
B. pressing the coated side of the substrate against a replicative surface (18) having a desired surface effect to cause the surface of the coating to conform to the replicative surface (18);
C. irradiating the coating with electron beam radiation directed first through the substrate (7) to partially cure the coating sufficiently to enable it to be removed from the replicative surface (18) securely attached to the substrate and with the replicated surface effect in the coating being maintained; and
D. stripping the substrate from the replicative surface (18) with the partially cured coating adhered to the substrate; characterised by the further step of
E. irradiating the partially cured coating a second time, out of contact with the replicative surface (18), with electron beam radiation without first applying additional coating composition or material over the first coating."

This Claim 1 is followed by dependent method Claims 2 to 6.

II. The patent was opposed in due time and form on 17 July 1987; the Opponent requested revocation of the patent on the grounds of Articles 54 and 56 EPC in the light of the following documents:

- (A) US-A-4 289 821 and
- (B) US-A-3 918 393,

document (B) being incorrectly cited in Opponent's letter of 16 March 1988 as US-A-3 981 398, see page 4, paragraph 3, being, however, correctly cited in the Search Report and in the patent in suit.

III. By a decision of 30 January 1989 (not 19 December 1988) the Opposition Division rejected the opposition pursuant to Article 102(2) EPC and upheld the European patent No. 0 106 695 as granted.

IV. The Appellant (Opponent) appealed against this decision on 18 February 1989 and paid the appeal fee on that day. The Statement of Grounds of Appeal was received on 14 April 1989.

The Appellant requested the revocation of the attacked patent and argued that document (A) is a novelty destroying document since the second curing station "6" is a must whereas the second coating station is optional. With these features the method of granted Claim 1 in the Appellant's contention is completely anticipated. Even if document (A) were not interpreted as a novelty destroying document the Appellant argues that granted Claim 1 would be obvious in respect of (A). With document (B) it should be demonstrated that a two-step curing per se is known in the prior art.

- V. The Respondent (proprietor of the patent) contended however, that document (A) does not anticipate the teaching of granted Claim 1 or render this teaching obvious so that he requested to dismiss the appeal.
- VI. In the communication pursuant to Article 11(2) RPBA dated 31 October 1990 the Board gave its provisional opinion of the case i.e. that granted Claims 7 to 10 (product claims) were felt to prejudice the maintenance of the patent, since in the Board's contention document (A) is a novelty destroying document with respect to the subject-matter of Claim 7 (Articles 100(a) and 54 EPC).
- VII. With letter of 14 December 1990 the Respondent withdrew granted Claims 7 to 10 so that in the oral proceedings held on 10 January 1991 the Respondent defended the patent in amended form, namely on the basis of granted Claims 1 to 6 and the description and drawing as granted.
- VIII. The Appellant, however, argued for lack of novelty of the subject-matter of Claim 1 in the light of document (A), and apart from that objection, felt that there was at least a direct lead from the teaching of document (A) to the subject-matter of Claim 1. Claim 1 not being valid, granted Claims 2 to 6 would fall likewise. During the oral proceedings it was stated by the Appellant that the attacked patent does not literally disclose the problem to be solved by the invention so that from the indication of the drawbacks of the prior art it must be derived that the problem to be solved by the invention was:
- (a) to maintain the replication of the grooved roll (18) when curing the coating and
 - (b) to consider the necessity of good release properties of the final product.

Bearing in mind these two aspects of the problem to be solved the Appellant was of the opinion that document (A) contains enough information to lead a skilled person directly to the method of Claim 1, namely to obtain good release properties without a topcoat and to obtain a complete replication of the grooved roll and to maintain this replication in the curing stations by splitting up the curing into a primary (partly) and a final curing (two-stage process).

Having regard to the legal position taken by the Opposition Division, see communication of 27 June 1988, remark 3, it was observed by the Appellant that this was not in agreement with the provisions of the EPC, and the Board's opinion to this finding was expressly asked for.

The parties essentially maintained their previous requests, namely revocation of the patent even in its amended form (Appellant) and maintenance of the patent in the form as set out above under VII, paragraph 1 (Respondent).

Reasons for the Decision

1. The appeal is admissible.
2. Granted Claims 1 to 6 meet the requirements of Article 123(2) EPC since only reference signs were introduced into the claims (Claims 1, 4, 5 and 6).

Since the granted Claims 1 to 6 are defended unamended they also meet the requirements of Article 123(3) EPC so that overall the requirements of Article 123 EPC are met.

3. The nearest prior art document to be considered is without any doubt document (A). Claim 1 is completely delimited over this piece of prior art and is therefore not open to an objection under Rule 29(1)(a) and (b) EPC.
4. In document (A) there is disclosed a method of providing a desired surface effect in a release coating on a substrate which is characterised by the steps that pursuant to Claim 1 of (A) a first coating is applied and partially cured, that following the stripping of the substrate from the replicative surface of roll "22" a further coating (reference signs "5" and "15") is applied and that this further layer is cured while the curing of the first layer is completed.

The "first coating" of document (A) can comprise two coating steps, namely in station "2" and in station "4", both applications of coatings being, however, before these contact roll "22" which acts as a replication roll.

The teaching of document (A) is also characterised by the application of a curing in one step only, see Examples I, II, III and IV of (A) according to column 6, line 31 to column 8, line 10 thereof, which examples make it absolutely clear that only one curing is envisaged, see also column 3, lines 24 to 28 of (A).

In document ~~(A)~~ it is also disclosed, see column 3, lines 40 to 44, to apply an after-coating to the first coating after it is partially cured and then curing both coatings i.e. curing the after-coating and simultaneously finishing the partial curing of the first coating. As can be seen from the single Figure of (A) the after-coating is carried out in station "5" with the application roll "15", while "6" represents the second radiation station carrying out the curing of the after-coating and the final curing of the first coating.

In column 4, lines 43 to 46 of (A) it is disclosed that the after-coating station "5" is "optional" and would only be used when it is desired to put a top coat over the coating composition already on coated paper "9" which is already at least partially cured.

From lines 53 to 57 of column 4 of (A) it can be seen why the first coating is only partially cured and then finished cured at the after-curing station "6" along with the second coating. The reason for the provision of a two-step curing is given in lines 56/57 of column 4 of (A): "This provides better adherence of the second coating to the first".

In agreement with the arguments brought forward by the Respondent the Board is of the opinion that document (A) does not disclose the possibility of omitting the after-coating station "5" whilst maintaining the second radiation station "6" for double-curing a single coating.

It is the firm conviction of the Board that such an interpretation of document (A) is not justified and if allowed would be the result of inadmissible hindsight.

5. As stated above under point 3, the subject-matter of Claim 1 is different from the teaching of (A) in that its feature "E" cannot be seen from (A). The subject-matter of Claim 1 is thus novel within the meaning of Article 54 EPC.
6. The Appellant has repeatedly stated that even if document (A) were not seen as a novelty destroying document it would exclude the patentability of the subject-matter of Claim 1 since (A) would lead a skilled person directly to the subject-matter of Claim 1.

- 6.1 Basically the Board already sees a contradiction in the chain of arguments of the Appellant due to the fact that document (A) should be either a novelty destroying document or at least a document which renders obvious the subject-matter of Claim 1. It is found that the Appellant's finding in respect of document (A) is not free from inadmissible hindsight since the teaching of (A) is seen in the light of the claimed invention. Reading (A) it is obvious that this document in itself is not free from inconsistencies and that different parts of it point to different directions as set out above under point 4. In this situation, however, it cannot be accepted to pick out particular parts of the document and base an argument on them rather than considering the document as a whole.
- 6.2 In this context the Appellant argued that the document under discussion has to be seen in the light of the two aspects of the present invention, namely maintenance of the replication of the used roll on the coating and achievement of a product with good release properties.
- 6.3 From column 6, lines 15 to 19 of (A) the Appellant derives that the skilled person would be taught that an after-coating would deteriorate the degree of replication ("some degree of replication is lost...") and that a skilled person consequently would be pushed to delete the after-coating if one of the aspects of the problem to be solved is considered, namely to maintain good replication. It is further derived from (A) that only the after-coating would have to be deleted, but not the after-curing in station "6" so that in total, in the Appellant's opinion, document (A) contains the teaching of applying one coating and two curing steps. Concerning the application of a two-step curing, the Appellant argues that the skilled person would derive this teaching from column 6, lines 8 to 10 and column 4, line 66 to column 5, line 5 of (A), namely to

cure the coating in the absence of the replication surface and to partially cure the coating to permit it to be removed from the replication roll.

6.4 The Respondent strongly contested this chain of argumentation and came to the conclusion that (A) either teaches to carry out the coating/curing in its simplest way by applying one coating only and cure this coating in one curing step or to apply a second coating and carry out a second curing step.

6.5 The Board accepts the findings of the Respondent for the following reasons:

In (A), see Examples I to IV, a single coating is applied to the substrate and cured in a single step, so that these examples represent the "simplest form of the invention", see also column 6, lines 6/7 of (A) where it is stated that when practicing the simplest form of the invention according to document (A) the surface replication is outstanding.

As can be seen from Claim 1 and the single Figure as well as from column 3, lines 40 to 43 and lines 43 to 57 of column 4 of (A), one of the embodiments of (A) is characterised by the application of a second coating and a two-step curing. If the alternative "one coating/one curing" is the simplest form of the invention pursuant to (A), then the two coatings and two curing steps represent another embodiment possibly leading to better results. At any rate there is an identity in the steps of coating and curing either one/one or two/two but never one/two in document (A).

From column 4, lines 53 to 57 of (A) it can clearly be seen that partial curing in (A) is applied to provide

"better adherence of the second coating to the first". The Board is convinced that from this passage of (A) it is absolutely clear that in (A) an after-curing is only envisaged when an after-coating is applied i.e. when bonding problems might arise.

6.6 The solution according to Claim 1 is not characterised by "bonding problems" since a two-step layer is not envisaged in Claim 1. The outstanding and surprising solution to the problem of the present invention is based on the omission of the second coating step of document (A) though the properties of good replication and good release are aimed at, see problem to be solved as mentioned above under VIII.

6.7 The teaching of document (A) does not, therefore, to the Board's conviction, render obvious the method of attacked Claim 1, if this document is seen without the benefit of hindsight but rather as it is. The Board, therefore, cannot accept Appellant's argument that Claim 1 of document (A) -in which a two-step coating and a two-step curing is clearly taught - has to be disconsidered and that exclusively other parts of the document in suit should count for the assessment of inventive step, in particular in the light of the two aspects of the problem to be solved of the present invention.

~~6.8 Document (B) was not discussed in detail during the oral proceedings and no particular argument of the Appellant was based on (B) besides the general statement that in (B) a two-step curing per se is known, if specific properties of an article are required. The two-step curing per se is, however, not the gist of attacked Claim 1 so that (B) cannot destroy the validity of Claim 1 even if (B) should be combined with the teaching of (A).~~

- 6.9 The Board comes therefore to the conclusion that the method defined in granted Claim 1 is not anticipated by the prior art so that this independent method claim is valid, (Articles 54 and 56 EPC), whereby granted Claims 2 to 6 can be maintained unamended.
- 6.10 Though granted Claims 7 to 10 (product claims) have been deleted from the attacked patent, the Board is of the opinion that page 4, lines 4 to 10 ("The invention is also...of the first application") of the attacked patent can be maintained since - according to Article 64(2) EPC - the product directly obtained by a claimed process is automatically protected. The description and the drawing of the attacked patent can therefore be upheld unamended.
7. During the oral proceedings before the Board the Appellant expressly asked for the legal position and the comments of the Board concerning the communication pursuant to Article 101(2) and Rule 58(1) to (3) EPC of the Opposition Division dated 27 June 1988, point 3 in particular.

The position of the first instance was as follows:

"If a party which has asked for oral proceedings does not, during the proceedings, bring forward new and substantial arguments, the Opposition Division may consider if a different apportionment of costs would be appropriate (Article 104(1) EPC)."

The position of the Board - as already expressed during the oral proceedings of 10 January 1991 - is that the parties have an absolute right to be heard, Articles 113(1) and 116(1) EPC. These Articles of the EPC are clearly not restricted to "new and substantial arguments" so that the above findings of the Opposition Division are not supported by the EPC, since the parties

have a right even to repeat known arguments or to stress arguments already brought forward or to link already presented arguments in a specific combination or chain of arguments without contravening the provisions of Articles 113(1) and 116(1) EPC. The application of the provisions of Article 104(1) EPC has therefore to be restricted to cases of clear abuse of the proceedings, but not to "normal" cases in which each party shall meet the costs he has incurred.

The legal position of the Board has been made clear above. On the other hand, since the Board deems the present appeal not to be allowable the reimbursement of appeal fees, which incidentally was not requested by the Appellant, may not be ordered 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 first instance with the order to maintain the European patent 0 106 695 on the basis of the following documents:

Claims 1 to 6 as granted;
Description and drawing as granted.

The Registrar:



N. Maslin

The Chairman:



C.T. Wilson