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D E C I S I O N
of 7 July 1998

Case Number: T 0929/94 - 3.4.1

Application Number: 88307489.0

Publication Number: 0304242

IPC: G09F 3/02

Language of the proceedings: EN

Title of invention:
Adhesive label or leaflet assemblies

Applicant:
Denny Bros. Printing Limited

Opponent:
-

Headword:
Adhesive label/DENNY BROS. PRINTING LTD

Relevant legal provisions:
EPC Art. 113(1), 115, 111(1)
EPC R. 67

Keyword:
"Burden of proof for the fact alleged"
"Procedural violation - yes"
"Remittal - yes"
"Third party observations - sufficiently relevant"

Decisions cited:
T 0270/90, T 0838/92, T 0859/90, T 0250/92, T 0750/94,
T 0951/92

Catchword:

-



Case Number: T 0929/94 - 3.4.1

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 7 July 1998

Appellant: Denny Bros. Printing Limited
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Representative: Perkins, Sarah
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 25 August 1994
refusing European patent application
No. 88 307 489.0 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: G. Davies
Members: R. K. Shukla
G. Assi

Summary of Facts and Submissions

I. European patent application No. 88 307 489.0 claims the priority date of 13 August 1987 from a GB patent application No. 87 192 17. Following the filing of this European patent application, the Examining Division issued a communication, dated 9 September 1993, which raised an objection to the grant of a patent on the basis of lack of inventive step having regard to a prior art document,

D1: EP-A-0 232 054.

According to paragraphs 3, 4 and 4.1 of this communication, one of the distinguishing features of the assembly claimed in claim 1 (filed with the letter of 15 February 1993), in relation to the assembly known from document D1, i.e. that the extending parts of the adhesive sheet means are adherent directly to the carrier strip, did not involve an inventive step, since label assemblies not having a support web were "widely known". No prior art document disclosing a label assembly without a support web was cited in the communication in support of the above statement.

In a reply dated 11 January 1994, the applicant contested the objection raised by the Examining Division, and in particular, stated that,

"The Examiner's unsupported statement that label assemblies not having a support web "are widely known" is not a proper factor in a ground of rejection. It is

necessary for the Examiner to produce support for his statement or withdraw it".

- II. In its decision dated 25 August 1994, the Examining Division refused the application on the ground of lack of inventive step of the claimed subject-matter. The decision is based inter alia on the reasons communicated in paragraphs 3, 4, and 4.1 of the communication mentioned above, and states that label assemblies not having a support web are widely known. No prior art document is cited in the decision to support the above statement.

In connection with the applicant's submission regarding the unsupported assertion about what was "widely known", it is stated in paragraph 3.3, Reasons of the Decision, that -

"It is, however, not a requirement of the EPC that prior art should always be backed up by documents. Of course such support should normally be provided, except in very clear cases. The present case is considered to be such a very clear case. (Also, if the applicant had indeed stated that in his knowledge webless assemblies were not known, the examiner would normally have tried to obtain written support of the fact. The applicant has, however, not stated that he believes webless assemblies not to be known.)"

- III. The applicant filed an appeal on 4 November 1994, paying the appeal fee the same day, and filed the statement of grounds of appeal on 29 December 1994. With the notice of the appeal, the applicant filed five

sets of claims, each of the sets containing claims 1 to 8, and amended pages of the description for each set of the claims, forming respectively a main request and four auxiliary requests.

In connection with the statement in the decision under appeal regarding what was well known in the art, the applicant made essentially the following submissions in the grounds of the appeal:

There was no suggestion in the prior art relied upon by the examining division that, in a leaflet assembly, a support web may be dispensed with. It might be that label assemblies not having a support web are widely available now. This, however, was not the case at the priority date of the present application. From the reply, dated 11 January 1994, to the official communication dated 9 September 1993, the obvious inference was that the applicant did not accept the examiner's view that leaflet assemblies without webs were known at the priority date of the application. For the record, the applicant stated that it was of this view and asked the examining division to support its contention in respect of webless leaflet assemblies. Furthermore, it would not have been obvious to the skilled person at the priority date of the application to omit the support web from the leaflet assembly known from document D1.

IV. In accordance with Article 115 EPC, third party observations were filed by Mr. Peter Jenkins of Page, White and Farrer on 21 June 1995 concerning the patentability of the invention having regard to the

following documents, in addition to document D1 cited during the examination proceedings:

D2: EP-A-0 192 444 (cited in the European Search Report)

D3: EP-A-0 180 365 (cited in the European Search Report)

D4: US-A-4 621 442

D5: EP-A-0 043 179

D6: EP-A-0 275 670 (priority claimed - 22 December 1986; published on 27 July 1988)

D7: GB-A-2 115 775

D8: GB-A-2 141 994

D9: FR-A-2 219 845.

The third party made essentially the following submissions:

(i) Contrary to the submissions by the applicant, as can be seen from US-A-4 621 442 (D4) webless leaflet assemblies were known in the art at the priority date of the application.

(ii) Claim 1 of each of the main and auxiliary Requests was obvious having regard to D4 and D2, D3 or D5.

(iii) Independent method claim 7 of each of the requests was not entitled to the claimed priority date, since the priority document did not provide support for any method steps claimed. D6 which was published on 27 July 1988, i.e. before the filing date of the application (12 August 1988), was thus comprised in the state of the art according to Article 54(2) EPC for the method claims.

(iv) Claim 7 of each of the five requests did not involve an inventive step having regard to D6 and D4.

(v) An essential feature of the invention as claimed in claim 1, and as described in the application as filed, was that, in the adhesive leaflet assembly, the edge of the back sheet opposite the folded edge between the front sheet and the back sheet is tacked to the adhesive sheet means or to the rear surface of the front sheet. This feature is omitted from claim 1 of each of the five requests, so that claim 1 of all the requests contravene Article 123(2) EPC and the provisions of Article 84 EPC.

V. The third party observations were communicated to the applicant for his comments, if any, in accordance with Article 115(2) EPC. The applicant did not make any comments on these observations.

VI. In its communication, the Board informed the applicant of its following provisional views:

- (i) The decision under appeal was based on an unsubstantiated statement regarding what was comprised in the state of the art at the priority date despite the fact that the applicant had contested such a statement, so that the decision should be set aside.

- (ii) An entirely new case based on new facts and evidence had been presented against the patentability of the claimed invention by the observations and supporting material filed by a third party following filing of the appeal. Such new material was sufficiently relevant that the Board intended to introduce it into the appeal proceedings.

In the above communication, the applicant was invited to state whether it would prefer the Board to carry out the examination of the substantive issues of the appeal having regard to the third party observations, so as to avoid delaying a final decision or whether it wished the case to be remitted to the first instance under Article 111 EPC for examination of and decision upon the new material filed by the third party, in order to avoid a loss of an instance of examination.

VII. In response, the applicant asked that the case be remitted to the first instance for consideration of the third party observations.

Reasons for the Decision

1. The appeal is admissible.

2. *Legal considerations*

2.1 It is the established case law of the boards of appeal that, in opposition proceedings before the EPO, each party carries the burden of proof for the facts it alleges (see, e.g. T 270/90, OJ 1993, 725; T 838/92; T 859/90; T 250/92). Moreover, it follows from the decision T 750/94 (OJ EPO 1998, 31) that, in *ex parte* proceedings, when the applicant challenges *prima facie* evidence concerning a fact, i.e. the nominal publication date of a document, and submits evidence to displace such *prima facie* evidence, the burden of proof shifts to the examining division to establish that the document was "made available to the public" within the meaning of Article 54(2) EPC on that date. As also stated in that decision, "A European patent should not be refused or revoked unless the grounds for refusal or revocation are fully and properly proved" (point 4 of the reasons).

In the present case, in the Board's view, the obvious inference from the following statements in the applicant's reply, dated 11 January 1994, to the official communication dated 9 September 1993,

"The Examiner's unsupported statement that label assemblies not having a support web "are widely known" is not a proper factor in a ground of rejection. It is

necessary for the Examiner to produce support for his statement or withdraw it."

was that the applicant did not accept the view expressed in the official communication, that label assemblies without a support web were known (before the priority date of the application in suit). Under these circumstances, the burden of proof for the fact alleged lay clearly with the Examining Division. The Examining Division, however, did not produce any evidence for the alleged fact nor did it withdraw the statement concerning the alleged fact, in response to the applicant's reply dated 11 January 1994. Under these circumstances, contrary to the opinion of the Examining Division in paragraph 3.3 of the "Reasons for the Decision" (see paragraph II above), it was not clear that leaflet assemblies without a support were known within the meaning of Article 54(2) EPC.

Furthermore, it is clear from the summary of the facts in paragraphs II above that, in the decision under appeal, the finding of lack of inventive step was based essentially on an alleged fact that leaflet assemblies without a web support were well known in the art. The reasoning which led to this finding of the alleged fact formed part of the essential legal and factual reasoning which led to the decision to refuse the application, but was not communicated to the applicant. According to Decision T 951/92 (OJ EPO 1996, 53), in the context of the examination procedure, the word "ground" in Article 113(1) EPC should be interpreted as referring to the essential reasoning, both legal and factual, which leads to the refusal of the application.

In the present case, therefore, the "ground", in the sense of Article 113(1) EPC, was not communicated to the applicant before the decision under appeal was issued.

Consequently, during the proceedings before the examining division, the applicant did not have an opportunity to present comments upon this "ground" for refusing the application, as required by Article 113(1) EPC, and a substantial procedural violation, therefore, occurred. The decision under appeal has, therefore, to be set aside.

- 2.2 In the present case, the applicant has not requested refund of the appeal fee in accordance with Rule 67 EPC. In the Board's judgement, however, such reimbursement of the appeal fee is clearly equitable by reason of the substantial procedural violation.

3. *Third party observations*

The observations filed by a third party following the filing of the appeal comply with the requirements of Article 115(1) EPC. A preliminary examination by the Board of these observations and the supporting material mentioned in paragraph IV above shows that an entirely new case based on new facts and evidence has been presented against the patentability of the claimed invention in these observations. In the Board's view, such new material is sufficiently relevant for it to be introduced into the appeal proceedings. Moreover, in order to preserve the applicant's right to review through appeal of any adverse decision of the first

instance, the Board, in the exercise of its power under Article 111(1) EPC, considers it appropriate to remit the case for examination of and decision upon such new material, as requested by the applicant.

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 having regard to the third party observations filed on 21 June 1995.
3. The appeal fee shall be refunded.

The Registrar: The Chairman:

M. Beer

G. Davies