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D E C I S I O N
of 24 April 2001

Case Number: T 0094/98 - 3.4.2

Application Number: 88905075.3

Publication Number: 0338028

IPC: G09F 3/10

Language of the proceedings: EN

Title of invention:
Sheet and dispenser package therefor

Patentee:
MINNESOTA MINING AND MANUFACTURING COMPANY

Opponent:
Beiersdorf Aktiengesellschaft

Headword:

-

Relevant legal provisions:
EPC Art. 54, 56

Keyword:
"Novelty (yes)"
"Inventive step (yes)"

Decisions cited:
T 0633/97

Catchword:

-



Case Number: T 0094/98 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 24 April 2001

Appellant: MINNESOTA MINING AND MANUFACTURING COMPANY
(Proprietor of the patent) 3M Center
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St. Paul
Minnesota 55133-3427 (US)

Representative: VOSSIUS & PARTNER
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D-81675 München (DE)

Respondent: Beiersdorf Aktiengesellschaft
(Opponent) Unnastrasse 48
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Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 25 November 1997
revoking European patent No. 0 338 028 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: M. A. Rayner
V. Di Cerbo

Summary of Facts and Submissions

I. The appellant (=patent proprietor) has appealed against the decision of the opposition division revoking European patent number 338 028 (application number 88 905 075.3, International Publication No. WO 88/09983).

In the proceedings before the opposition division, reference was made, amongst others, to the following documents:

D1: US-A-4 637 149

D4: US-A-3 583 358

The opposition division considered the subject matter of claims 1 to 4 before it to lack an inventive step but the subject matter of claims 5 to 13 to involve an inventive step. Claims 14 to 16 had not been opposed. The patent in dispute concerns sheets adapted for marking portions of documents and the opposition division found that the subject matter of claim 1 differed from the disclosure of document D1 only by the minor details of the sheet being an elongated layer and having only one adhesive free end. The basic concept of the subject matter of claim 1 was thus known from document D1 and modification of these minor details to reach the subject matter of claim 1 was obvious, since the same advantages of the concept were taught in document D1.

II. The appellant requested setting aside of the decision, maintenance of the patent and on an auxiliary basis

oral proceedings.

According to the appellant, there is no disclosure in document D1 that the adhesive and adhesive free portions of the sheet are at respective end portions. The technical problem having regard to document D1 is the provision of a sheet adapted for marking portions of a document which can be easily removed from a document without damage to the latter. The essential central adhesive section and likely obscuring of the document consequent to colouring of tabs arranged laterally of the central section according to the teaching of document D1 lead away from the solution provided by the invention.

III. The respondent requested dismissal of the appeal and on an auxiliary basis oral proceedings. According to the respondent, the feature that the sheet is elongate is known from document D4. Since the choice of an appropriate shape is a matter of simple choice for the skilled person and both documents are in the same technical field, this subject matter lacks an inventive step. The respondent also made reference to document

D6: DE-A-3 537 433

as disclosing a self adhesive sheet which can be written on, with a paper or foil carrier of which the whole or part is for being covered with an adhesive, the rest of it being a tab, which can be used to adhere repeatedly to a substrate such as paper.

The response to the statement setting out the grounds of appeal included the following statement:

"With respect to claims 5-13, we do not agree with what the Opposition Division decided, but we will not argue insofar, as long as those claims remain in their present version."

IV. Oral proceedings were appointed, consequent to the auxiliary requests filed. In an annex to the summons to oral proceedings, the board informed the parties that it was intended, if possible, to resolve all outstanding issues enabling a decision to be taken at the end of the oral proceedings. The board further informed the parties that late submissions of any description from either side, especially if so complex as to delay unduly or prevent resolution of the case at the oral proceedings, ran the risk of not being taken into consideration by the board.

V. During the oral proceedings, the appellant requested maintenance of the patent on the basis of a main request filed during the oral proceedings or alternatively on the basis of auxiliary requests 1 to 4 filed with submissions before the oral proceedings. The appellant outlined his view of advantages of the invention, that the sheet can be written upon, sticks reliably with no loose parts, does not obscure text and yet is readily removable. The flag of document D1 on the other hand is not elongate. Moreover, the square shape with a diagonal central adhesive strip means there are two tabs, which entails a protruding tab being likely to be struck by other pages and removal contacting a finger with the page, both of which are liable to cause damage. The writable central area is rather small and the coloured portions are likely to be inconvenient, for example when photocopying. The marker tab of document D4 is not transparent and there is no

reason to combine the teachings of documents D1 and D4.

VI. The respondent maintained his request for dismissal of the appeal and argued during the oral proceedings that the square shape is only "preferable" according to lines 50 to 51 of document D1 and it was simple for the skilled person to choose the elongate shape. Column 6, lines 29 to 30 explicitly concerns elimination of the "adhering" corners, rendering shape changing obvious.

VII. After discussion about claims 1 to 4 of the main request had come to an end, the respondent requested introduction of his case against claims 5 to 13 into the oral proceedings, the statement about claims other than claims 1 to 4 in the response to the statement setting out the grounds of appeal being to be understood as meaning that only if the decision of the opposition division were to be maintained would no arguments against claims 5 to 13 be presented.

The appellant objected against any request for admission of arguments against claims 5 to 13 into the proceedings because these claims had not been changed and the respondent had declared in advance that in this case no such arguments would be presented. Therefore the appellant was not prepared for introduction of claims 5 to 13 into the proceedings.

VIII. Claim 1 according to the main request of the appellant is worded as follows:-

Main request

1. A sheet (10) comprising a single elongate layer

(11) of flexible polymeric material having opposite major side surfaces and first and second opposite ends (14,15), and having a coating (16) of repositionable pressure sensitive adhesive on a second end portion (18) of one of the side surfaces adjacent said second end (15) while being free of adhesive on both of said side surfaces along a first end portion (19) thereof adjacent said first end, both of said end portions being adapted to be written on, wherein said sheet (10) is adapted for marking portions of documents in that said first end portion (19) is coloured to make said first end portion (19) visually distinctive, said layer (11) of polymeric material has a thickness in the range of 0.0038 to 0.0076 centimeter, and said adhesive coated second end portion (18) is substantially transparent when adhered to a substrate.

{Note: The wording of the remaining independent claims of the main request and that of the independent claims of the subsidiary request is not given since it is not relevant to the present decision either because the claims concerned were not opposed [claim 14] or for the reasons given in sections 5 and 6 below [claims 5,9].}

IX. At the end of the oral proceedings, the board gave its decision.

Reasons for the Decision

1. The appeal complies with the provisions mentioned in Rule 65(1) EPC and is therefore admissible.
2. *Admissibility of amendments (Article 123(2) EPC)*

Compared with claim 1 as granted, present claim 1 has been cast in the one part form and the wording "is coloured to make said first end portion (19)" has been inserted before "visually distinctive". Moreover, inconsequential amendments have been effected in that the first occurrence of "said" has been replaced by "the" and the second occurrence of reference numeral "14" has been omitted. The only substantive amendment (coloured first end portion) is a limitation, so that Article 123(3) is satisfied. Support for this amendment is provided in the documents as filed (see for example lines 5 and 6 of the published International application) and the amendments to the description are for discussion of the prior art and adaptation to the claims in accordance with Rules 27(1)(b) and (c). Article 123(2) EPC can thus also be considered satisfied.

3. *Novelty*

3.1 According to document D1, a flag is of a semi-rigid unitary construction and is made of a thin (1.5 mil=0.00381 cm) elastomeric material, preferably a polyester, forming a small preferably substantially square sheet with substantially rounded corners. A central adhesive section runs diagonally across the reverse side of the flag and defines a longitudinal axis of adhesion and the axis of functional symmetry of the flag with two symmetrical tapered adhesive free tabs with rounded edges. A pressure sensitive semi-permanent adhesive allows the flag to be applied to a surface, removed, and reapplied there or elsewhere. In use, the flag can be applied to a margin of a sheet of paper with the axis of adhesion parallel to the edge of

the sheet with one of the adhesive free tabs extending freely outward from the edge of the flagged sheet. The protruding indexing tab functions as a bookmark while the overlaying tab indicates a section of text. If the protruding tab is struck by a foreign object along a line parallel to the axis of adhesion after being affixed to a page of a book to be indexed, the taper of the protruding rounded tab causes it to act as a cam allowing deflection following striking rather than transmitting the striking force to the flagged sheet. The taper of the overlaying tab also facilitates removal without damage to the flagged host by increasing transverse bendability. The adhesive free overlaying tab is lifted from the face of the flagged host and peeled back outwardly relative to the edge of the host thus levering the central adhesive section from the flagged host and eliminating traumatization of the flagged host in terms of shearing force. The rounded corner of the overlaying tab allows the tab to be caught by the thumb or finger without jabbing the delicate flesh under the nail. For indexing a single number, word, phrase, sentence or other section of material in the middle of a reference, a flag is applied directly over such information which is seen through the transparent central area and highlighted above and below by the tabs or a printed line defining the edge of the flag. Flags may be prepared in such a way as to permit user writing in the tab area instead of these being imprinted with number or letters.

Accordingly, the subject matter of claim 1 is novel over the disclosure of document D1 by virtue of the sheet comprising an elongate layer having opposite major side surfaces and first and second opposite ends. In consequence, the coating of repositionable pressure

sensitive adhesive is on a second *end* portion of one of the side surfaces adjacent said second end, both of said side surfaces along a first *end* portion thereof adjacent said first end being free of adhesive.

Likewise, said adhesive coated second *end* portion is substantially transparent when adhered to a substrate.

- 3.2 According to document D4, a tab comprises a strip of paper, card stock paper, sheet plastic or similar material, which is formed with its sides converging at one end to form a pointer, the opposite end having its corners bevelled to avoid sharp corners. A layer of pressure sensitive adhesive extends somewhat over half of the underside of strip including the end forming the pointer, the other end of strip which is uncoated being grasped for removing the tab from a sheet of printed material. A line on the tab is used to indicate the portion which may be grasped. The line is slightly removed from the adhesive coating to permit some flexing between the portion of the uncoated end that is being grasped and the beginning of the pressure sensitive adhesive layer. The line may indicate the boundary between areas of two different colours, the portion to be grasped may be in the natural colour of the strip or it may be coloured in a contrasting colour. An uncoloured portion has the advantage that it is possible to apply any suitable indicia by pen or pencil to identify the purpose of the tab. A plurality of the tabs are mounted on a sheet backing paper formed of any material having a smooth, relatively "glossy" surface until use. A tab is affixed to a page so that the pointer is directed to a portion of the page in question and the outer uncoated portion projects beyond the edge of the paper. The tabs can be extremely thin,

even thinner than the paper of the document in which they are to be placed. Prior to use, the various tabs are mounted within a cover in the form of a folder simulating a match book cover.

Accordingly, the subject matter of claim 1 is novel over the disclosure of document D4 by virtue of the choice of layer of polymeric material having a thickness in the range of 0.0038 to 0.0076 centimeter and the repositionable adhesive coated second end portion being substantially transparent when adhered to a substrate.

- 3.3 According to document D6, a removable adhesive sheet comprises a substrate of fibrous material such as paper or cloth. In addition to these, there may also be used a film of which the surface is smooth such as polyethylene or polyester. The substrate permits hand-writing or printing thereon and has an adhesive layer that is capable of repeated rebonding to any place which is most convenient to a user.

Accordingly, the subject matter of claim 1 is novel over the disclosure of document D6 by virtue of the sheet being adapted for marking portions of documents in that first end portion is coloured to make it visually distinctive, the choice of layer of polymeric material having a thickness in the range of 0.0038 to 0.0076 centimeter and said adhesive coated second end portion (18) being substantially transparent when adhered to a substrate.

4. *Inventive step*

4.1 Document D1 has been taken by the first instance and the parties to be closest prior art, an assessment with which the board concurs because a document flag with a transparent adhesive portion is provided. The problem solved by the novel features of claim 1 relating to the elongate configuration and adhesive on an *end* portion can be seen as improving the marking function and releasable yet secure attachment of the sheet. These improvements derive from there being nothing to the side of the adhesive portion opposite the visually distinctive portion, i.e. no portion like the second tab taught by document D1 which is both unadhered (loose) and a visual obstruction.

The question of inventive step hinges on whether the provision of two tabs is an essential feature of the teaching of document D1. If this is the case, dispensing with the second tab cannot have been obvious to the skilled person on the basis of document D1 and would not have been merely a simple choice. The board reached the conclusion that the second tab is indeed an essential feature of the flag of document D1 for the following reasons. Firstly, the symmetry of the marker is stressed so that it can be used equivalently either way round, thus necessarily requiring a tab on either side of the middle adhesive portion. Moreover, it is important to peel towards the edge of the paper from the middle, which is only possible by grasping a second adhesive free portion over the paper. Document D1 in fact specifically teaches against tabs which are removed from a sheet by peeling inwardly because these are said to apply a shearing force to the edge of the page at the longitudinal extremes of these tabs thereby potentially tearing the flagged host.

It is thus not the exact shape of the flag which is critical, but its symmetry and the two tabs. In this connection, the board agrees that the strictly square shape of the flag is for example changed by rounded corners. Such rounded corners do not however indicate that the second tab is not essential as is apparent from consideration of the reasons given in document D1 as to why the corners are rounded. The first reason is to enable the tab constituting the marking index and protruding from the paper to offer a camming action when struck. There is no question in this context of clipping off this tab entirely as there would then be no index so that camming would no longer be relevant. A second reason for rounding of the corners concerns the adhered corners of the diagonals with respect to easing removal consequent to transverse force. Rounding of the adhered portion is not however relevant to the unadhered tabs. Thus neither of these reasons can be taken to indicate that the second tab is not essential.

Another problem with the flag of document D1 consequential to the presence of two tabs is that because the adhesive part, upon which is normally written, is in the middle, it is without a "free side". Thus it is difficult to place it such that text is not obscured by one or other of the unattached tabs. For example, all markers shown in the figures also carry alphanumeric information on the tabs and where the text of a document can be seen (Figure 8), it is at least partially obscured by this information as well as by the shape/colour of the unattached tab itself. Yet just this feature is valued in document D1, for example one tab as index the other as pointer or for midpage marking one tab above and the other below, rendering it hardly likely that the skilled person would consider

dispensing therewith.

Therefore, the board considers the concept shared between document D1 and the subject matter of claim 1 to exhaust itself in a transparent adhesive portion, on the other hand essentially different concepts are provided by the "two tabs with central adhesive" teaching of document D1 and "the single tab with adhesive at an end" subject matter of the patent in dispute. Therefore, the board reached the view that the subject matter of claim 1 would not have been reached in an obvious way from the teaching of document D1.

- 4.2 The disclosure of document D4 is not so pertinent to the subject matter of claim 1 because it does not teach a transparent adhesive portion, rendering use of the tab for marking text in a document limited. The tab is shown marginally located and its main function is to replace a paper clip in pointing to a place to sign. Thus, while the disclosure of document D4 is in a similar field and is indeed closer to claim 1 of the patent in dispute than document D1 in relation to the positioning of adhesive, it cannot contribute to a solution of the problem of obscured underlying text. More significantly, any combination of the teachings of documents D1 and D4 is intrinsically not obvious because the skilled person when starting from document D1, knows, as explained in section 4.1 above (symmetry, grasping for removal and so on), that two tabs are essential and would therefore have dismissed the "single tab" teaching of document D4 as incompatible.

The board also observes that starting from document D4, the inherent incompatibility would have prevented any combination of the documents. This route would in any

case not have been obvious because the problem to be solved over document D4 would have involved making the tab transparent, which in the context of document D4 would run counter to main idea of the visibility of the arrowhead pointing to the place for signature. Only hindsight in the knowledge of the present invention could suggest that materials disclosed in document D4 could be made transparent for making reading underlying text possible for a modified tab.

Therefore, the board formed the view that the subject matter of claim 1 would also not have been reached in an obvious way by the skilled person even taking account of the teaching of document D4.

4.3 Document D6 discloses a repositionable adhesive, but the sheet is not transparent and so would obscure underlying text and in any case is less relevant than document D4 because the disclosure relates to a more general labelling sheet not specifically concerned with a sheet coloured for marking documents. Therefore the board concluded that the teaching of document D6 does not affect its view that the subject matter of claim 1 would not have been obvious to the skilled person.

4.4 Accordingly the subject matter of claim 1 is considered as involving an inventive step and therefore to satisfy Article 56 EPC. The same conclusion applies to claims 2 to 4 in view of their dependence from claim 1.

5. *Claims 5 to 13 (Admissibility of late request)*

5.1 Admission of arguments against claims 5 to 13 (identically worded with the version submitted with the

main request initially filed with the appeal) into the oral proceedings is a new request, in the sense that it was made for the first time at the oral proceedings and contrary to the explicit statement of the respondent in the response to the statement setting out the grounds of appeal that arguments were not to be presented against claims 5 to 13 in the version presented. This statement of the respondent is unambiguous and therefore the board sees no room for attaching an implied condition thereto that it was subject to the negative decision of the opposition division in relation to claims 1 to 4 being maintained. The argument of the respondent in this direction during the oral proceedings is not therefore convincing.

5.2 While it is the duty of parties, their representatives and the appeal board to prepare thoroughly for the issues up for discussion in the oral proceedings and to be prepared for the arguments of the parties formulated during such proceedings, the further that new requests diverge from what could reasonably have been expected in the light of the written procedure before the oral proceedings, the more unlikely it is that the board in fairness to all the parties would find itself in a position to admit them. Since the board and the other party were confronted with a request previously ruled out by the respondent himself, this divergence reaches a maximum in the present case resulting in the request being a surprise to the other party and the board.

5.3 The considerations involved with late requests in general are, in the view of the board, convincingly set out in point 2 of the reason for decision T 633/97, from which it can be concluded that once oral proceedings have been arranged in appeal cases, the

decision to admit new requests into the procedure hinges neither on a fixed time limit for their submission nor on their merit, but should instead be governed primarily by a general interest in the appeal proceedings being conducted in an effective manner, i.e. in dealing with as many of the issues raised by the parties as possible, while still being brought to a close within a reasonable time. In these circumstances, new requests should normally be disregarded if the complexity of the technical or legal issues raised is such that neither the board nor the other party can be clearly expected to deal with them without adjournment of the oral proceedings.

5.4 In the present case, the request made during the oral proceedings had to be rejected without further consideration as to its merits, since it would have involved introduction at that late stage of subject matter not previously considered at all in the appeal proceedings. Thus the technical issues were too complex for the appellant to have been able to discuss them "off the cuff" within the timeframe of the oral proceedings and the appellant could not have been expected to have been prepared in advance for this request. The request thus falls squarely within the meaning of a late submission of the sort referred to by the board in the annex to the summons to oral proceedings as running the risk of not being taken into consideration by the board.

5.5 Therefore, the board resolved this risk to the disadvantage of the respondent and did not admit the request of the respondent to introduce his case against claims 5 to 13 into the oral proceedings.

5.6 In this situation the board has no reason to call the decision of the first instance with respect to claims 5 to 13 into question.

6. *Auxiliary requests*

Having regard to the positive view of the board in relation to the main request, consideration of the auxiliary requests of the appellant is not necessary.

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 patent in amended form as follows:

Claims 1 to 16 filed during the oral proceedings;

Description, columns 1 to 4 and page 2a as filed during the oral proceedings; columns 5 to 9 as in the patent specification;

Drawings as in the patent specification.

The Registrar:

The Chairman:

P. Martorana

E. Turrini