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D E C I S I O N
of 15 July 1999

Case Number: T 0694/98 - 3.2.4

Application Number: 94923054.4

**International
Publication Number:** WO 95/03990

IPC: B65H 35/00

Language of the proceedings: EN

Title of invention:

Method and equipment for the substantially silent unwinding of
a self-adhesive tape from the dispenser reel

Applicant:

Syrom 90 S.p.A.

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 111(1)

Keyword:

"Remittal to the first instance on the basis of the auxiliary
request"

Decisions cited:

-

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: T 0694/98 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 15 July 1999

Appellant: Syrom 90 S.p.A.
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Representative: Mannucci, Gianfranco, Dott.-Ing.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 10 March 1998
refusing European patent application
No. 94 923 054.4 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. A. J. Andries
Members: M. G. Hatherly
R. E. Teschemacher

Summary of Facts and Submissions

- I. On 8 May 1998 the appellants (applicants) filed an appeal against the decision of the examining division dispatched on 10 March 1998 to refuse the European patent application No. 94 923 054.4 (International Publication No. WO-A-95/03990). The appeal fee was paid on 9 May 1998 and the statement of grounds of appeal was received on 12 June 1998.
- II. In its decision the examining division found that the subject-matter of claim 1 according to the main request and claim 1 according to the auxiliary request infringed Article 123(2) EPC.
- III. In the statement of grounds of appeal the appellants requested that the case be remitted to the department of the first instance for further prosecution on the basis of the above-mentioned claims and requested oral proceedings should the Board of Appeal intend to reject the main request.

The board explained in the communication sent on 11 May 1999 that it considered the main request to be unallowable, that it had therefore appointed oral proceedings and that it considered also the auxiliary request unallowable, adding that if amended claims were filed which clearly did not infringe Articles 123(2) and 84 EPC then it might be possible to cancel the oral proceedings and to remit the case to the first instance for further prosecution (Article 111(1) EPC)).

The appellants withdrew the request for oral proceedings and in the letter of 14 June 1999 asked for

the case to be remitted to the first instance for further prosecution on the basis of a new independent claim 1.

On 6 July 1999 the board faxed a communication explaining that, in formulating this claim 1 to meet objections under Article 123(2) EPC, the appellants had removed parts of claim 1 of the auxiliary request filed with the appeal but thereby had returned fairly closely to an earlier version of claim 1 objected to by the examining division for lack of inventive step. The board concluded it did not consider it appropriate to remit the case with this claim 1 to the first instance and that the oral proceedings would take place as scheduled.

The appellants' letter of 7 July 1999 confirmed that the representative would not attend the oral proceedings and enclosed a new claim 1 for an auxiliary request.

IV. Claim 1 of the main request reads:

"An adhesive tape dispensing equipment in which a tape wound on a reel (5) is unwound from the back surface of the underlying layer, including: a supporting structure (1) with a handle (1A); on said supporting structure a support shaft (3) for a tape reel (5); on said supporting structure (1) a pressure roller (7) around which the tape unwound from said reel is deflected; characterized by:

- an element (612) which is movable angularly about a hinge axle (610) supported by said supporting structure

(1) and parallel to the axis of said shaft (3) and which carries, at a distance from said hinge axle, an additional tape supporting and deflecting member (616), said supporting and deflecting member being positioned and forced to press on the periphery of the reel (5) to reduce to a minimum the free section of the trajectory of the tape (N) from the point P of detachment from the reel (5) to the first point of contact with the said support and deflection member (616);

- a sleeve (620) arranged coaxial with said hinge axle (610) and

- an elastic means (618) urging said additional tape supporting and deflecting member (616) against said reel (5); said elastic means (618) being housed within a seat (620A) in said sleeve (620)."

Claim 1 of the auxiliary request has all the wording of claim 1 of the main request and adds at the end the feature:

"whereby when the reel (5) is nearly empty, the tape unwound from the reel (5) is deflected around said deflection member (616) and around said sleeve (620)."

V. The following prior art documents were referred to in the appeal proceedings:

D1: DE-A-3 311 170

D2: EP-A-0 178 696

D3: US-A-3 567 557

- VI. The oral proceedings took place on 15 July 1999. The appellants did not appear but, since they were duly summoned, the oral proceedings were continued without them, in accordance with Rule 71(2) EPC. At the end of the oral proceedings the present decision was taken.
- VII. In writing the appellants requested that the examining division's decision be set aside and that the case be remitted to the department of the first instance for further prosecution on the basis of claim 1 filed with the letter of 14 June 1999 (main request) or claim 1 filed with the letter of 7 July 1999 (auxiliary request).

Reasons for the Decision

1. The appeal is admissible.
2. *Claim 1 of the main request - inventive step*
- 2.1 As set out in section 5 of the board's communication of 6 July 1999, D1 discloses (see Figure 1) in the wording of claim 1 of the main request:

An adhesive tape dispensing equipment in which a tape wound on a reel (15) is unwound from the back surface of the underlying layer, including: a supporting structure (2, 3); on said supporting structure a support shaft (13) for a tape reel (15); on said supporting structure (2, 3) a pressure roller (11) around which the tape unwound from said reel is deflected; with:

- an element (17) which is movable angularly about a hinge axle (16) supported by said supporting structure (2, 3) and parallel to the axis of said shaft (13) and which carries, at a distance from said hinge axle, an additional tape supporting and deflecting member (20), said supporting and deflecting member being positioned and forced to press on the periphery of the reel (15) to reduce to a minimum the free section of the trajectory of the tape from the point of detachment from the reel (15) to the first point of contact with the said support and deflection member (20); and
- an elastic means (22) urging said additional tape supporting and deflecting member (20) against said reel (15).

2.2 Claim 1 of the main request specifies the following features which are not disclosed by D1:

- (a) the supporting structure (1) has a handle (1A),
- (b) a sleeve (620) is arranged coaxial with said hinge axle (610), and
- (c) said elastic means (618) is housed within a seat (620A) in said sleeve (620).

2.3 The handle, feature (a), was seen as obvious by the examining division, see section 2 of the communication of 22 May 1996 and section 2 of the communication of 27 January 1997. The board agrees. The examining division relied on there being classifications, problems and fields common to the present application

and D1, stating that the skilled person would investigate both automatic and hand-operated tape dispensers and would start from D1 rather than from D3 which addressed a different problem.

While the appellant signalled his readiness in section 3 on page 3 of the letter of 7 July 1999 to limit the application to the subject-matter disclosed in Figures 11 and 12, the amendments are not on file and the present description (i.e. that as originally filed) refers on page 1, lines 4 to 9, to the invention relating to "dispensers of the manual type or ... dispensers of the automatic type". Similar information can be found nine and ten lines from the bottom of page 1, in lines 17 to 20 of page 4, and in the second paragraph of page 8 of the originally filed description.

Moreover, the word "handle" in the claim is insufficient to specify that the claimed tape dispensing equipment actually is of the manual i.e. hand-operated, portable type. It is almost certain that the equipment of D1, although not of the hand-operated type, has a handle somewhere on the supporting structure for doing something or other. Alternatively, even if it did not have a handle, it would be obvious to provide one for some purpose or other, without thereby changing the equipment to the hand-operated type.

Further, it is not possible to determine which is the problem which is presented by the prior art and is solved by the handle since the latter's function is not clear from the claim and the handle seems to have no

relationship with the other features of the claim.

- 2.4 Regarding features (b) and (c) referred to in the above section 2.2, the board pointed out in the communication of 6 July 1999 that D2 discloses a similar adhesive tape dispensing equipment to that of D1.

A lever arm 15 shown in Figure 1 of D2 corresponds to the element 612 of the present claim 1 and to the arm 17 of D1. The lever arm 15 of D2 is biased by a spring 24 (i.e. elastic means) acting between the frame and the lever arm 15. This spring 24 is shown in more detail in Figure 3 as being wound around a fulcrum 14 (i.e. hinge axle) between two sleeves inserted in the sides 3 of the frame.

The board finds that it would be obvious to the skilled person to replace the gas spring arrangement 22 of D1 by the coil spring arrangement 24 of D2, particularly in view of the third paragraph of page 6 (hand-written number) of the description of D1.

Claim 1 of the main request specifies that the elastic means is housed within a seat in a sleeve whereas in D2 the elastic means (spring 24) is housed between two sleeves.

The board however cannot see a precise and inventive difference here. The claim specifies "**a** sleeve" but this does not exclude there being more than one sleeve (e.g. two sleeves as provided in D2). Quite why the space between the two sleeves in D2 should not be a seat and quite what the significance is in the present application of **a** sleeve is not clear to the board (in

the absence from the claim of any more details of the sleeve and its function).

2.5 For the reasons set out in sections 2.1 to 2.4 above, the board finds that it would be obvious for the skilled person starting from D1 to arrive at equipment satisfying claim 1 of the main request.

2.6 Accordingly claim 1 of the main request is unallowable (Articles 52(1) and 56 EPC) and the main request as a whole is unallowable.

3. *Claim 1 of the auxiliary request*

3.1 Amendments

3.1.1 This claim contains all of the originally filed independent claim 5 plus parts of the originally filed claims 6, 8 and 9. The other features of the claim preceding the word "whereby" (five lines from the bottom of the claim) can best be derived from Figures 11 and 12 and the relevant parts of the description (in particular the paragraph bridging pages 7 and 8 but also those other passages that plainly also apply the embodiment of Figures 11 and 12).

3.1.2 The board explained in its communication sent on 11 May 1999 what the skilled person would, and what he would not, derive from the drawings of the present application. In section 3.3 of this communication the board stated that:

"It is not in dispute that the skilled person looking

at Figure 11 would realise that, when the reel 5 of tape is nearly empty, the oscillating element 612 and shaft 616 are in the dotted line position and that in this position the tape unwound from the reel 5 is deflected around said deflection member 616 (not 116), and around a sleeve 620 coaxial with said hinge axle 610."

Thus the board sees a basis in the originally filed application for the wording in claim 1 of the auxiliary request following the word "whereby" (five lines from the bottom of the claim).

- 3.1.3 Accordingly the board finds that claim 1 of the auxiliary request is not objectionable under Article 123(2) EPC.

- 3.2 Thus, while the application was refused by the examining division for contravention of Article 123(2) EPC, this objection no longer applies to claim 1 of the auxiliary request. Moreover the examining division's arguments in the file do not deal with all the features of claim 1 of the auxiliary request, nor of course with all the arguments made in the appellants' letter of 7 July 1999.

- 3.3 While the claim is still not clearly restricted to equipment of the manual type, it does make clear the function of the sleeve. In the letter of 7 July 1999 the appellants explain why the elastic means is housed within a seat in the sleeve, why the possibility of the tape contacting the sleeve influences the positioning of the hinge axle, why the positioning of the hinge axle influences the compactness of the equipment to

make it suitable for manual use, and why the claimed subject-matter differs from the disclosures of D1 and D2.

- 3.4 The examining division has not taken a position on the subject-matter of claim 1 of the auxiliary request, in particular having regard to inventive step.

The board considers it appropriate, in view of the above comments and in order not to deprive the appellants of one instance of jurisdiction, to remit the case to the first instance for further prosecution on the basis of claim 1 of the auxiliary request.

The board notes that the appellants have agreed to limit the dependent claims, description and drawings to the subject-matter disclosed in Figures 11 and 12.

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 on the basis of claim 1 filed with the letter of 7 July 1999 (auxiliary request).

The Registrar:

The Chairman:

N. Maslin

C. Andries