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DECISION
of 24 June 2003

Case Number: T 0329/01 - 3.2.5

Application Number: 92916164.4

Publication Number: 0551522

IPC: B43L 19/00

Language of the proceedings: EN

Title of invention:
Device for transferring film

Patentee:
SEED RUBBER COMPANY LTD.

Opponent:
Kores Holding Zug AG
BIC

Headword:
-

Relevant legal provisions:
EPC Art. 56, 123(2)
EPC R. 71(a)

Keyword:
"Extension beyond the content of the application as filed,
auxiliary requests 1, 5 to 7, 11 and 13 (no)"
"Inventive step, main request, auxiliary requests 1, 1a, 2 to
4, 5, 5a, 6, 6a, 7, 7a, 8 to 11, 11a, 12, 13, 13a, 14 (no)"
"Late filed auxiliary requests 4a, 4b (not admitted)"

Decisions cited:
T 0351/93, T 0629/90, T 0563/89, T 0213/87, T 1105/98

Catchword:
-



Case Number: T 0329/01 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 24 June 2003

Appellant: Kores Holding Zug AG
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 18 January 2001
rejecting the opposition filed against European
patent No. 0551522 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: W. R. Zellhuber
Members: W. Widmeier
M. B. Günzel

Summary of Facts and Submissions

- I. The appellant (opponent 01) lodged an appeal against the decision of the Opposition Division rejecting the opposition against European patent No. 0 551 522.

Opposition was filed against the patent as a whole, based on Article 100(a) EPC (lack of inventive step, Article 56 EPC) and on Article 100(c) EPC.

The Opposition Division held that the grounds for opposition mentioned in Article 100(a) and (c) EPC did not prejudice the maintenance of the patent as granted.

- II. Oral proceedings before the Board of Appeal were held on 24 June 2003.

The appellant requested that the decision under appeal be set aside and that European patent No. 0 551 522 be revoked.

As main request the respondent (patent proprietor) requested that the appeal be dismissed.

As auxiliary requests the respondent requested that the decision under appeal be set aside and the patent be maintained with any of the auxiliary requests 1 to 3 and 5 to 14 filed with letter dated 23 May 2003 and any of the auxiliary requests 1a, 4, 4a, 4b, 5a, 6a, 7a, 11a and 13a filed during oral proceedings in the following order 1, 1a, 2, 3, 4, 4a, 4b, 5, 5a, 6, 6a, 7, 7a, 8, 9, 10, 11, 11a, 12, 13, 13a, 14.

The appellant's request, for putting into the minutes certain remarks allegedly made by the respondent, was dismissed. The chairman referred to Rule 76(1) EPC, according to which the minutes shall contain the essentials of the oral proceedings.

As announced on 2 April 2003 the other party (opponent 02) was not represented at the oral proceedings.

III. The following documents were in particular referred to by the parties:

E3: FR-A-2 643 351

E4: EP-A-0 427 870

IV. Claim 1 of the main request reads (feature numbering added):

"1. A coating film transfer tool comprising:

- (i) a pay-out reel (15, 41), being rotatably provided in a case (11) and holding a coating film transfer tape (19),
- (ii) a coating film transfer head (18) including a peak portion (32) having a linear outer edge, and being projected at the front end of the case (11), for pressuring the coating film transfer tape (19) paid out from the pay-out reel (15, 41) onto a transfer area, and
- (iii) a winding reel (16, 42), being rotatably provided in the case (11), and having an axis parallel to that of the pay-out reel

(15, 41), for recovering the coating film transfer tape (19) after use, being led around the peak portion (32) of the head (18) having a linear outer edge,
(iv) wherein the linear outer edge of the peak portion (32) of the head (18) is arranged in a direction perpendicular to the axes of the reels (15, 16, 41, 42)."

V. Claim 1 of all auxiliary requests relates to a coating film transfer tool comprising a combination of features out of the following feature list, wherein features (i) to (iv) are the features of claim 1 of the main request, features (i') and (iv') are modified features (i) and (iv) of claim 1 of the main request and features (a1) to (g) are additional features:

(i') "a pay-out reel (15, 41), being rotatably provided in a case (11) and holding the coating film transfer tape (19)"

(iv') "wherein the linear outer edge of the peak portion (32) of the head (18) is arranged in a direction perpendicular to a plane defined by the two axes of the reels (15, 16, 41, 42)"

(a1) "a coating film transfer tape (19) comprising a base film and a coating layer made of a corrective paint or an adhesive on one surface of the base film and optionally a release agent layer between the base film and the coating layer"

- (a1') "a base film and a coating layer made of a corrective paint or an adhesive on one surface of the base film and optionally a release agent layer between the base film and the coating layer"
- (a2) "a coating film transfer tape (19) comprising a base film and a coating layer made of a corrective paint or an adhesive on one surface of the base film and a release agent layer between the base film and the coating layer, wherein an adhesive layer is provided on the corrective paint opposite to the base film"
- (a2') "a base film and a coating layer made of a corrective paint or an adhesive on one surface of the base film and a release agent layer between the base film and the coating layer, wherein an adhesive layer is provided on the corrective paint opposite to the base film"
- (b) "the coating film transfer tape (19) is twisted by an angle of 90° at the upstream side of the head (18) and the downstream side of the head (18), respectively"
- (c) "twisting means (21, 22, 23) for twisting the coating film transfer tape (19) is provided between the head (18) and both the reels (15, 16, 41, 42) and the coating film transfer tape (19) is twisted by this twisting means by an angle of 90° at the upstream side of the head (18) and the downstream side of the head (18), respectively"

- (d) "both the reels (41, 42) are engaged with each other, and the winding reel (42) is interlocked with the pay-out reel (41) in automatic winding type"
- (e) "a coating film transfer tape (19) being constituted by forming a release agent layer on one side of a base film, forming a white corrective paint layer thereon, and applying a pressure sensitive adhesive layer further thereon"
- (f) "wherein the twisting means comprises a guide pin (22, 23) on both the upstream side and the downstream side of the head (18), respectively, for twisting the tape between the head (18) and the guide pins (22, 23) by 90°"
- (g) "whereby the coating film transfer tape (19) comprises on one side of a substrate film of plastic such as polyester film and acetate film a release agent layer of vinyl chloride-vinyl acetate copolymer and low-molecular polyethylene, a white corrective paint layer thereon and a pressure-sensitive adhesive agent top thereof"

The following list indicates the features and their order of claim 1 of each of the twenty-two auxiliary requests:

- Auxiliary request 1: (a1), (i'), (ii) to (iv)
- Auxiliary request 1a: (a2), (i'), (ii) to (iv)
- Auxiliary request 2: (i) to (iv), (b)

Auxiliary request 3: (i) to (iv), (c)

Auxiliary request 4: (i) to (iv), (c), (d)

Auxiliary request 4a: (i) to (iv), (c), (f), (d)

Auxiliary request 4b: (i) to (iv), (c), (f), (d),
(g)

Auxiliary request 5: (a1), (i'), (ii) to (iv), (b)

Auxiliary request 5a: (a2), (i'), (ii) to (iv), (b)

Auxiliary request 6: (a1), (i'), (ii) to (iv), (c)

Auxiliary request 6a: (a2), (i'), (ii) to (iv), (c)

Auxiliary request 7: (a1), (i'), (ii) to (iv),
(c), (d)

Auxiliary request 7a: (a2), (i'), (ii) to (iv),
(c), (d)

Auxiliary request 8: (e), (i'), (ii) to (iv)

Auxiliary request 9: (e), (i'), (ii) to (iv), (b)

Auxiliary request 10: (e), (i'), (ii) to (iv), (c)

Auxiliary request 11: (a1'), (i'), (ii) to (iv),
(c), (d)

Auxiliary request 11a: (a2'), (i'), (ii) to (iv),
(c), (d)

Auxiliary request 12: (i) to (iii), (iv')

Auxiliary request 13: (a1), (i'), (ii), (iii),
(iv')

Auxiliary request 13a: (a2), (i'), (ii), (iii),
(iv')

Auxiliary request 14: (e), (i'), (ii), (iii),
(iv').

VI. In the written and oral proceedings the appellant argued essentially as follows:

(a) *Main request*

Document E4 which represents the closest prior art shows a coating film transfer tool with a pay-out reel and a winding reel having parallel axes from which the subject-matter of claim 1 of the main request differs in that the linear outer edge of the peak portion of the transfer head is arranged in a direction perpendicular to the axes of the reels. Document E3 discloses a transfer tool for applying an adhesive correction tape. Both the tools shown in documents E3 and E4 are comparable office equipment tools which are often produced by one and the same manufacturer. Thus, a person skilled in the art dealing with a one-reel device as shown in document E3 is familiar also with two-reel transfer devices as shown in document E4 and vice versa. Also Mr Hofmeister's expert opinion speaks

of comparable devices with respect to the devices of these documents. Consequently, a person skilled in the art, intending to improve the ergonomics of the tool of document E4, will consider document E3. This document suggests turning the applicator head by 90 degrees and thus twisting the tape on its way to the applicator element by 90 degrees in order to improve the ergonomic quality of the tool. The person skilled in the art will apply the teaching of document E3 to the tool of document E4. There are no prejudices which might have hindered a person skilled in the art from twisting a transfer tape by 90°, and there were no specific technical problems to be solved. The guiding and twisting means and the pulling forces to the tape mentioned by the respondent are irrelevant and not the subject of the claim. The commercial success is no indication of an inventive step. The commercial success of the tool of claim 1 of the patent in suit is not caused by the 90°-twist of the tape. All such tools have had expanding sales figures in the recent years. Thus, the subject-matter of claim 1 lacks an inventive step.

(b) *Auxiliary requests 1, 1a*

Claim 1 of auxiliary request 1 is not in accordance with Article 123(2) EPC. In the application as filed the release agent layer is not described as an option. The tape is described as always having a release agent layer. Consequently, the subject-matter of claim 1 extends beyond the application as filed. The same applies to claim 1 of auxiliary requests 5, 6, 7, 11 and 13.

A tape as additionally specified in claim 1 of auxiliary requests 1 and 1a is a normal correction tape which is also shown in document E4. The additional features cannot therefore be considered to be inventive.

(c) *Auxiliary request 2*

The additional feature of claim 1 of auxiliary request 2 is already comprised in claim 1 of the main request, because it is a consequence of the orientation of the outer edge of the transfer head.

(d) *Auxiliary request 3*

The twisting means of the tool of the patent in suit are not the pins 21, 22, and 23. Figure 1 of the patent in suit shows that these pins do not twist the tape. The tape is twisted by the edge of the transfer head. Consequently, claim 1 of auxiliary request 3 lacks clarity. Apart from that, twisting means are known from document E4. The embodiment shown in Figures 1 to 3 of document E4 comprises twisting means 11 and 12. The tape is twisted by less than 90°, however, it is shown that the tape may be twisted without problems so that a person skilled in the art will use such twisting means also for a 90° twist, if necessary, without performing an inventive step.

(e) *Auxiliary request 4*

Claim 1 of auxiliary request 4 additionally comprises the feature that the two reels are interlocked with each other. However, this feature is also already known

from document E4 so that it cannot give rise to an inventive step.

(f) *Auxiliary requests 4a, 4b*

Auxiliary requests 4a and 4b should be rejected as late filed.

(g) *Auxiliary requests 5 to 11a and 13 to 14*

The features of claim 1 of auxiliary requests 5 to 11a and 13 to 14 have already been discussed so that no further comments are necessary.

(h) *Auxiliary request 12*

The amendment made in claim 1 of auxiliary request 12 with respect to claim 1 of the main request is not comprehensible since, according to claim 1 of the main request, the axis of the winding reel is parallel to the axis of the pay-out reel. The two axes thus define a plane. Consequently, the assessment of inventive step remains unchanged.

VII. In the written and oral proceedings the respondent argued essentially as follows:

(a) *Main request*

Document E4 represents the closest prior art. In all embodiments shown in this document the edge or the axis of the transfer element is parallel to the axes of the reels. Thus, the handling of such a tool is inconvenient as described in column 1, lines 45 to 51

of the patent in suit. Document E3 relates to a different kind of tool. It shows an adhesive tape applicator with only one reel from which the adhesive tape is supplied to an applicator roller. The tape is then cut and not rewound as the transfer tape of document E4 after the coating has been separated and applied to the substrate. Thus, a skilled person who in that case is a designer, trying to improve the ergonomic properties of the tool of document E4, would not consider document E3. For more difficult technical details this person would engage another expert. This other expert may consider document E3. However, he would recognize that the tool of this document does not rewind a tape and he would come to the conclusion that an applicator twisted by 90° would not work in combination with a tool as shown in document E4 because of the problems that arise with the twist of the sensitive tape. The pulling forces that are exerted on the tape when twisting it twice would destroy the coating and the tape. Anyway, even if applying the teaching of document E3, the expert would not arrive at the subject-matter of claim 1 of the patent in suit because he would not know what to do with the transfer tape after its coating has been released from the carrier tape and applied to the substrate. The conclusion the expert would gather from document E3 is to rebuild the tool of document E4 to a one-reel device. Thus, the subject-matter of claim 1 of the main request is based on an inventive step.

A further indication for the inventive step is the great commercial success which was achieved with the tool of the patent in suit and which is a consequence

of the feature that the edge of the transfer head is perpendicular to the axes of the reels.

(b) *Auxiliary requests 1, 1a*

The application as filed refers in the introductory part in general terms to a coating film transfer tape. The further description relates to special embodiments with optional features. Thus, claim 1 of auxiliary request 1 is in accordance with Article 123(2) EPC. The same applies to claim 1 of auxiliary requests 5 to 7, 11 and 13.

The additional feature in claim 1 of auxiliary requests 1 and 1a emphasizes the difference with respect to prior art and shows that the tape is of delicate nature so that a person skilled in the art would refrain from twisting it. Document E4 shows a great variety of embodiments so that it is not clear from this document which kind of tape belongs to which embodiment. Anyway, there is no twist of the tape by 90°.

(c) *Auxiliary request 2*

The additional feature of claim 1 of auxiliary request 2 emphasizes that the tape is twisted both upstream and downstream of the head. Admittedly, the feature is a consequence of the orientation of the edge of the transfer head so that this feature is implicitly already comprised in claim 1 of the main request.

(d) *Auxiliary request 3*

The tool of document E3, although twisting the tape once by 90°, does not comprise twisting means and does not therefore suggest the additional feature of claim 1 of auxiliary request 3.

(e) *Auxiliary request 4*

The double twist of the tape produces pulling forces. In order to avoid tearing of the tape there must be a suitable interlock between the pay-out reel and the winding reel. Moreover, the additional feature of claim 1 of auxiliary request 4 has to be considered in combination with the other features. This combination is the invention.

(f) *Auxiliary requests 4a, 4b*

Auxiliary requests 4a and 4b should be allowed even in that late stage of the proceedings because the amendments made in claim 1 of these requests result in allowable claims.

(g) *Auxiliary requests 5 to 11a and 13 to 14*

No further comments need to be made with respect to auxiliary requests 5 to 11a and 13 to 14.

(h) *Auxiliary request 12*

The additional feature of claim 1 of auxiliary request 12 emphasizes the arrangement of the edge of the transfer head with respect to the axes of the reels.

Reasons for the Decision

1. *Main request*

- 1.1 Document E4 represents the closest prior art. This document (cf. in particular column 1, line 45, to column 2, line 10, and Figures 1 to 10) discloses a coating film transfer tool with the features (i), (ii) and (iii) of claim 1 of the main request (numbering according to that of paragraph IV above). The subject-matter of claim 1 differs from this prior art by feature (iv).
- 1.2 As described in column 1, lines 45 to 51, of the patent in suit, the disadvantage of a tool as shown in document E4 is its inconvenient handling. The problem to be solved by the subject-matter of claim 1 is therefore to enhance the ergonomic properties of the tool (cf. column 1, lines 52 to 57, of the patent in suit). This problem is solved by turning the transfer head so that its edge is perpendicular to the axes of the tape reels. With this orientation of the transfer head the tool can be held in use like a pen.
- 1.3 Document E3 discloses an adhesive tape dispensing tool. This tool comprises a pay-out reel for supplying an adhesive tape to an applicator roller whose axis is perpendicular to the axis of the reel (cf. page 2, lines 23 to 31, and Figures 1 to 3). Due to that orientation of the applicator the tool can be held in use like a pen or marker (cf. page 1, line 25, to page 2, line 4). Thus, in order to enhance the

ergonomic properties of a tape dispensing tool, document E3 teaches that the applicator element should be turned by 90°.

- 1.4 The respondent argued that a person skilled in the art confronted with the problem of improving the ergonomics of the tool of document E4 would not consider document E3 because the tools of these two documents belong to different technical fields and, moreover, the skilled person who has to improve the tool of document E4 is a designer rather than a technician. This argument cannot be accepted. Should the person entrusted with the improvement of the tool of document E4 really be a designer without technical skills, then he has to contact another expert with the necessary skills because the improvement of the tool is not just a matter of visual design. The technical expert accompanying the respondent at oral proceedings admitted on behalf of the respondent that the designer will consult the technician. He admitted further that the tools of documents E3 and E4 are comparable devices. Indeed, both devices are office equipment, and many office equipment manufacturers produce both types of tools. Furthermore, both documents are classified in the same IPC class. Consequently, there exist several links between the field of one-reel tools and the field of two-reel tools so that a person skilled in the art will seek and will consider document E3 when trying to find a solution to the problem of improving the ergonomics of the tool of document E4.

The teaching given by document E3 is as evident as it is simple. It instructs the person skilled in the art to turn the orientation of the tape applicator head by 90 degrees so that its axis is perpendicular to the axis of the tape reel. Then the tool can be held in use like a pen.

The Board cannot see an obstacle which would prevent the skilled person who tries the solution shown in document E3 for a one-reel device from also trying it in a two-reel device. The nature of the transfer tape cannot prevent the skilled person from simply trying it out. Moreover, document E4 already shows in the embodiment of Figures 1 to 3 that such a transfer tape may be twisted. The twist shown in these figures is not a 90° twist. Anyway, it demonstrates that twisting the tape is possible and that it is easy to do so up to 90°. The patent in suit does not mention any problems which may arise due to the twist of the tape and, apart from the turned head, the tool according to claim 1 does not comprise any features beyond those already disclosed in connection with the tool of document E4.

The respondent further argued that the commercial success of the tool according to the patent in suit and the licences requested for the production of this tool are an indication of inventive step. Various decisions of the Boards of Appeal came to the conclusion that commercial success and licences are not necessarily indications of inventive step (cf., for example, T 351/93, point 5.6 of the Reasons; T 629/90 [OJ 1992, 654], point 4.3 of the Reasons; T 563/89, point 5.12 of the Reasons; T 213/87, point 6.5 of the Reasons). In the present case, where the problem-solution approach,

starting from document E4 and applying the teaching of document E3, leads the person skilled in the art straightly to the subject-matter of claim 1, the commercial success cannot indicate an inventive step. Anyway, the respondent could not prove that the commercial success of the tool is a consequence of the ergonomic improvement of the tool. As admitted by the respondent during oral proceedings, tools of the type shown in document E4 and tools according to the patent in suit share between them the market and the sales figures for the tools shown in document E4 had also been increasing.

1.5 The Board concludes therefore that the subject-matter of claim 1 of the main request does not involve an inventive step.

2. *Auxiliary request 1*

2.1 The appellant argued that the application as filed discloses a transfer tape which always has a release layer so that claim 1 of auxiliary request 1 comprising the release layer only as an option infringes Article 123(2) EPC. It is true that in the description of the preferred embodiments in the application as filed the transfer tape always has a release layer. However, in the introductory part of the description of the application as filed (cf. column 1, lines 3 to 7) reference is made to a coating film such as a corrective coating layer and an adhesive layer on a coating film transfer tape without making reference to the presence of a release layer.

The Board is therefore satisfied that claim 1 of auxiliary request 1 is in accordance with Article 123(2) EPC. The same applies to claim 1 of the other auxiliary requests comprising this feature (auxiliary requests 5, 6, 7, 11 and 13).

2.2 The transfer tape as specified additionally in claim 1 of auxiliary request 1 (feature (a1)) comprises a base film and a coating layer of a corrective paint or an adhesive. Such a tape is a normal transfer tape which is also used in the tool of document E4 (cf. the Abstract and column 1, lines 3 to 13). The use of such a tape in a tool having the modified transfer head cannot therefore give rise to an inventive step.

3. *Auxiliary request 1a*

The transfer tape of claim 1 of auxiliary request 1a comprises additionally a release agent layer between the base and the coating layer (feature (a2)). However, such a release layer is state of the art according to document E4 (cf. column 15, lines 44 to 51) and cannot give rise to an inventive step either.

4. *Auxiliary request 2*

Claim 1 of auxiliary request 2 specifies that the tape is twisted by an angle of 90° at the upstream side of the head and the downstream side of the head, respectively (feature (b)). This feature is already comprised in claim 1 of the main request because it is a consequence of the twisted head. If the outer edge of the transfer head is perpendicular to the axes of the tape reels then, necessarily, the tape is twisted

upstream and downstream of the head by 90°. Claim 1 of auxiliary request 2 is therefore technically identical to claim 1 of the main request and the same conclusion as to inventive step applies.

5. *Auxiliary request 3*

The appellant considered claim 1 of auxiliary request 3 to lack clarity because elements 21, 22, and 23 designated in the claim as twisting means do not twist the tape. However, claim 1 of auxiliary request 3 does not specify the twisting means and reference signs are not to be construed as limiting the claim (Rule 29(7) EPC). Nevertheless, whatever elements may constitute the twisting means, they cannot give rise to an inventive step. It is an inherent feature of all claims (see above point 4) that the tape is twisted by 90° on its way from the supply reel to the transfer head and again by 90° on its way from the transfer head to the take-up reel. Consequently, there must be twisting means for twisting the tape. Nothing more is specified in additional feature (c) of claim 1 of auxiliary request 3.

6. *Auxiliary request 4*

The further additional feature of claim 1 of auxiliary request 4 that the reels are engaged with each other and the winding reel is interlocked with the pay-out reel in automatic winding type (feature (d)) is also comprised in the tool of document E4 (cf. column 13, line 57, to column 14, line 5) so that this feature cannot change the assessment of inventive step. It should be noted that all features of claim 1 except for

feature (iv) are known in combination from document E4 so that a special new combinatory effect as suggested by the respondent cannot be seen.

7. *Auxiliary requests 4a, 4b*

Auxiliary requests 4a and 4b were submitted by the respondent during oral proceedings. It is established case law of the Boards of Appeal that new requests submitted at such a late stage of the proceedings are admissible only if the claims of the new request comprise prima facie allowable subject-matter and if the new claims do not introduce subject-matter which could not be expected by the other parties and which do not require a further search to be performed (cf. T 1105/98, point 3 of the reasons).

Claim 1 of auxiliary request 4a is prima facie not allowable because the use of guide pins for guiding and, in particular, also for twisting a tape is suggested by document E4 (cf. the drawings, in particular Figures 1 to 3) so that it cannot give rise to an inventive step. Moreover, the feature of providing guide pins for twisting the tape between the head and the guide pins by 90° was the subject neither of the claim of the application as filed nor of the claims of the patent as granted.

Similarly, claim 1 of auxiliary request 4b comprises a feature (feature (g)) which was not the subject of the claim of the application as filed or of the claims of the patent as granted. It was only comprised in the description. Accordingly, it was not covered by the

search report. Its introduction could not be expected either by the appellant or by the other party.

In accordance with Rule 71(a) EPC, the Board therefore rejects auxiliary requests 4a and 4b.

8. *Auxiliary requests 5 to 11a*

Claim 1 of each of auxiliary requests 5 to 11a comprises the features of the main request and various combinations of features (a1), (a1'), (a2), (a2'), (b), (c), (d), (e). As regards any contribution to inventive step by features (a1) and (a2), see above points 2.2 and 3. The same applies to features (a1') and (a2') respectively, which are substantially similar to features (a1) and (a2) respectively. Features (b) and (c) are a consequence of the orientation of the outer edge of the transfer head (see above, points 4 and 5). As to feature (d), see above point 6. Feature (e) specifies that the adhesive layer is pressure-sensitive. Also the tape used in the tool of document E4 has a pressure-sensitive adhesive layer (cf. column 15, lines 9 to 18 and 44 to 51).

Consequently, the subject-matter of claim 1 of any of auxiliary requests 5 to 11a also differs from the prior art according to document E4 only by the orientation of the transfer head. No new combinatory effect can be seen therefore, and thus the assessment of inventive step is the same as for the previous requests.

9. *Auxiliary requests 12 to 14*

Claim 1 of auxiliary request 12 differs from claim 1 of the main request and claim 1 of auxiliary requests 13, 13a and 14 differ from claim 1 of auxiliary requests 1, 1a and 8 by a modification of feature (iv).

With this modification, a transfer tool with a coaxial arrangement of the axes of the two reels is explicitly excluded since it is now specified that these two axes define a plane. However, this modification cannot change the assessment of inventive step because document E4 shows various embodiments (Figure 4 onwards) where the axes of the two reels define a plane.

10. Summarizing, the subject-matter of claim 1 of all requests (not considered: rejected auxiliary requests 4a and 4b) has its origin in a feature combination known from document E4 and includes the teaching of document E3 of turning the transfer head by 90° in order to improve the handling of the tool. Owing to the similarity of the tools of documents E3 and E4 and to the simple nature of the modification taught by document E3 it is obvious for a person skilled in the art to apply the solution of document E3 to the tool of document E4.

Consequently, the subject-matter of claim 1 of neither admitted request involves an inventive step.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar:

The Chairman:

M. Dainese

W. R. Zellhuber