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DECISION
of 20 July 2004

Case Number: T 0344/02 - 3.2.5

Application Number: 94305972.5

Publication Number: 0646471

IPC: B41M 1/30

Language of the proceedings: EN

Title of invention:

Method of double-sided printing of a laminate and product
obtained thereby

Patentee:

JOHNSON & JOHNSON VISION PRODUCTS, INC.

Opponent:

NOVARTIS AG

Headword:

-

Relevant legal provisions:

EPC Art. 56
EPC R. 57a, 65(1)

Keyword:

"Appeal of one party inadmissible"
"Implicit abandonment of subject-matter (no)"
"Amendments occasioned by grounds of appeal (main and first to
third auxiliary requests, no; fourth and fifth auxiliary
requests, yes)"
"Prohibition of reformatio in peius extending to individual
arguments (no)"
"Inventive step (fourth and fifth auxiliary requests, no)"

Decisions cited:

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Catchword:

-



Case Number: T 0344/02 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 20 July 2004

Appellant I: Novartis AG, Patent- und Markenabteilung
(Opponent) Lichtstrasse 35
CH-4002 Basel (CH)

Representative: Stellbrink, Axel
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Appellant II: JOHNSON & JOHNSON VISION PRODUCTS, INC.
(Proprietor of the patent) 4500 Salisbury Road
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Florida 32216-0995 (US)

Representative: Mercer, Christopher Paul
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
29 January 2002 concerning maintenance of
European patent No. 0646471 in amended form.

Composition of the Board:

Chairman: W. Moser
Members: P. E. Michel
W. Widmeier

Summary of Facts and Submissions

- I. Appellant I (opponent) and appellant II (patentee) each lodged an appeal against the interlocutory decision of the Opposition Division, posted 29 January 2002, maintaining European patent No. 0 646 471 in amended form. However, only appellant II filed a statement setting out the grounds of appeal within the period specified in Article 108 EPC.

In the decision under appeal, it was held that the grounds of opposition submitted by appellant I did not prejudice the maintenance of the patent as amended according to the auxiliary request of appellant II.

- II. Oral proceedings were held before the Board of Appeal on 20 July 2004.
- III. Appellant I requested that the decision under appeal be set aside and that European patent No. 0 646 471 be revoked.

Appellant II requested that the decision under appeal be set aside and that the patent be maintained on the basis of the following documents:

- (i) claims 1 to 14 filed as new main request on 21 June 2004; or
- (ii) claims 1 to 14 filed as new first auxiliary request on 21 June 2004; or
- (iii) claims 1 to 14 filed as new second auxiliary request on 21 June 2004; or

- (iv) claims 1 to 14 filed as new third auxiliary request on 21 June 2004; or
- (v) claims 1 to 14 presented as new fourth auxiliary request during oral proceedings; or
- (vi) claims 1 to 14 presented as new fifth auxiliary request during oral proceedings.

IV. Claims 1 and 10 of the main request read as follows:

"1. Printed, laminated lidstock for contact lens blister packages, comprising:
 (a) a metallic foil; and
 (b) a first layer constituted of a plastic film material adhesively secured to one surface of said foil, wherein said first layer has:
 indicia imprinted on the surface thereof facing said foil; and
 on the surface thereof remote from said foil, indicia imprinted via thermal transfer printing, whereby said indicia on the two surfaces of said first layer form a printed label."

"10. A method of producing lidstock as defined in any one of claims 1 to 7 that is free from indentations, which may adversely affect its mechanical sealing properties to a surface of a contact lens blister package, comprising:

- (a) imprinting first indicia on a first surface of a first plastic film material;

(b) adhesively securing said imprinted first surface of said first plastic material to a first surface of a metallic foil; and

(c) imprinting second indicia on the surface of said first plastic film material remote from said foil by thermal transfer printing through the intermediary of a ceramic printing head."

Claim 1 of the first auxiliary request is identical to claim 1 of the main request. Claim 10 of the first auxiliary request differs from claim 10 of the main request in that the term "through lithographic printing" is introduced into feature (a).

Claim 1 of the second auxiliary request reads as follows:

"1. Printed, laminated lidstock for contact lens blister packages, comprising:

(a) a metallic foil; and

(b) a first layer constituted of a plastic film material that is adhesively secured to one surface of said foil, said first layer having indicia imprinted on the surface thereof facing said foil and indicia imprinted via thermal transfer printing through the intermediary of a ceramic printing head on the surface thereof remote from said foil, whereby said lidstock is free from indentations, which may adversely affect its mechanical sealing properties to a surface of a contact lens blister package, and said indicia together form a printed label."

Claim 10 of the second auxiliary request corresponds to claim 10 of the main request, but with the omission of

the wording "that is free from indentations, which may adversely affect its mechanical sealing properties to a surface of a contact lens blister package,"

Claim 1 of the third auxiliary request is identical to claim 1 of the second auxiliary request. Claim 10 of the third auxiliary request is identical to claim 10 of the first auxiliary request.

Claim 1 of the fourth auxiliary request is identical to claim 1 of the main request. Claim 10 of the fourth auxiliary request is identical to claim 10 of the patent in suit as maintained by the Opposition Division in the decision under appeal.

Claim 1 of the fifth auxiliary request is identical to claim 1 of the second auxiliary request. Claim 10 of the fifth auxiliary request is identical to claim 10 of the patent in suit as maintained by the Opposition Division in the decision under appeal.

V. The following documents were referred to *inter alia* in the appeal proceedings:

D2: JP-A-62-233241, together with an English translation

D7: DE-A-4 033 512

D8: JP-Y-50-24455, together with an English translation

D14: Gekkan Yakuji (Monthly Pharmaceutical) Vol. 25, No. 7, 1983, pages 1375 to 1379, "Concerning Printing on Immediate Packaging Containers for Pharmaceuticals", together with an English translation.

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

The requests which form the subject of the decision under appeal both specify the method used for printing on the surface of the first layer facing the metallic foil. Having abandoned a claim in which the method used for printing on the surface of the first layer facing the metallic foil was not specified, it was not possible to revert to such a claim.

The amendments to claim 10 of each of the main request and first to third auxiliary requests do not comply with the requirements of Rule 57a EPC. The grounds of opposition specified in Article 100 EPC do not provide a reason to reformulate the claims and make general editorial amendments. It would have been possible for appellant II simply to introduce limitations into claim 1 as granted.

The fourth and fifth auxiliary requests, presented during the oral proceedings, were late filed and should not be admitted into the proceedings.

The preamble of claim 3 as granted specifies a "composite laminated foil covering and printed label structure for a package". Claim 1 of the fourth and fifth auxiliary requests has been reformulated so as to

refer to a "printed, laminated lidstock for contact lens blister packages". Claim 3 as granted is restricted to the combination of a covering and a package. The amendments of the fourth and fifth auxiliary requests must either involve an extension of subject-matter contrary to Article 123(3) EPC, or be unnecessary and hence not allowable in view of Rule 57a EPC.

Claim 1 of the fourth and fifth auxiliary requests is also not allowable in view of Article 123(2) EPC. Three features of claim 1 of the patent in suit as maintained by the Opposition Division are omitted from the claim. These are that the plastic film material is translucent, the use of conventional lithography and, in the case of the fourth auxiliary request, the use of a ceramic printing head. There is no basis in the application as filed for the omission of these features.

The closest prior art is document D2. The subject-matter of claim 1 of the fourth auxiliary request is distinguished over the disclosure of document D2 by the use of thermal transfer printing. The reference to "ink" in this document does not exclude thermal transfer printing.

There is no feature of claim 1 which permits sterilisation of the lidstock without adversely affecting the quality of the printed image. The question of whether or not a lidstock can undergo sterilisation is dependent on the selection of a suitable ink and not on the use of thermal transfer printing. The problem to be solved is accordingly to

provide a lidstock which allows differing information to be printed.

In view of the disclosure of document D7, the use of thermal transfer printing enables this problem to be overcome.

Claim 1 of the fourth auxiliary request thus does not involve an inventive step.

The feature of claim 1 of the fifth auxiliary request according to which the "lidstock is free from indentations, which may adversely affect its mechanical sealing properties to a surface of a contact lens blister package" is merely an obviously desirable feature without specifying the means which enable this feature to be achieved. The use of a ceramic printing head also does not involve an inventive step.

Claim 1 of the fifth auxiliary request thus also does not involve an inventive step.

VII. In written and oral proceedings, appellant II argued essentially as follows:

The withdrawal of a claim in which the method used for printing on the surface of the first layer facing the metallic foil was not specified does not amount to a waiver of subject-matter. In any case, it is not clear what, if any, subject-matter can be regarded as having been waived.

Claim 10 of the main request and first to third auxiliary requests is based on claim 1 as granted and does not involve any extension of the scope of protection.

The fourth and fifth auxiliary requests were filed at the oral proceedings before the Board in response to objections under Rule 57a EPC which were raised for the first time at the oral proceedings. In addition, these requests merely involve combinations of claims which were filed in previous requests with claims as maintained by the Opposition Division. The late filing of these requests thus does not amount to an abuse of the procedure and does not introduce any issues into the proceedings for which appellant I was not prepared.

It is not the correct approach under Article 123(2) EPC to compare claim 1 of the fourth and fifth auxiliary requests with the corresponding claim as maintained by the Opposition Division. The features referred to by appellant I are not presented in the application as filed as being essential. Claim 1 of the fourth and fifth auxiliary requests is based on claim 3 as granted and contains all the features of this claim. The sole differences between claim 1 of the fourth and fifth auxiliary requests and claim 3 as granted relate to a limitation of the scope of protection. Claim 1 of the fourth and fifth auxiliary requests is accordingly allowable in view of Article 123(2) and (3) and Rule 57a EPC.

Appellant I should not be permitted to adduce arguments relating to the issue of inventive step. Since the appeal of appellant I is not admissible, appellant I

cannot challenge the decision of the Opposition Division. If such arguments were to be considered and accepted by the Board, this would result in a worse situation for appellant II which would be at variance with the prohibition of reformatio in peius. Any decision by the Board on the issue of inventive step would imply a decision on the claims of the patent in suit as maintained by the Opposition Division in the decision under appeal.

The closest prior art is document D2. The object of the invention is to provide a lidstock which can withstand sterilisation. Document D7 does not suggest that thermal transfer printing would be suitable for printing on a lidstock which is to undergo sterilisation. There is thus no motivation for the person skilled in the art to combine documents D2 and D7.

The subject-matter of claim 1 of the fourth and fifth auxiliary requests thus involves an inventive step.

Reasons for the Decision

1. Admissibility of the appeal of appellant I

Appellant I filed an appeal on 22 March 2002. However, a written statement setting out the grounds of appeal in accordance with Article 108 EPC was not filed. In accordance with Rule 65(1) EPC, the appeal is therefore rejected as being inadmissible. Appellant I nevertheless remains a party to the proceedings as of

right in accordance with Article 107 EPC, second sentence.

2. *Abandonment of subject-matter*

In the decision under appeal, a main request in which claim 1 specified the feature of printing on the surface of the first layer facing the metallic foil "via a non-thermal printing process" was held not to be allowable in view of the provisions of Article 123(2) EPC. According to the auxiliary request of appellant II, which was upheld by the Opposition Division, this feature was replaced by a reference to "conventional lithography" in order to overcome the objection under Article 123(2) EPC. Thus, both requests considered by the Opposition Division limit in some way the method used for printing on the surface of the first layer facing the metallic foil.

However, claim 3 of the patent in suit as granted did not specify in any way the method used for printing on the surface of the first layer facing the metallic foil. It was argued on behalf of appellant I that, having abandoned a claim in which the method used for printing on the surface of the first layer facing the metallic foil was not specified, it was not possible to revert to such a claim. This objection applies to all the requests of appellant II.

This argument cannot, however, be accepted. The omitted feature of claim 1 of the former main request was held by the Opposition Division in their decision as not being allowable in view of the provisions of Article 123(2) EPC. The omission of this feature is

thus regarded as being appropriate in order to overcome this objection and the Board finds it appropriate to exercise its discretion under Article 114(1) EPC and admit the requests of appellant II.

3. *Main request and first to third auxiliary requests*

3.1 Rule 57a EPC

The claims of the patent in suit as granted included three independent claims: claim 1, directed to a method of printing on opposite surfaces of a layer comprising a plastic film material; claim 3, directed to a composite laminated foil covering and printed label structure for a package; and claim 9, directed to a method of producing multi-layered foil laminate coverings for a packaging.

Claim 10 of each of the main request and first to third auxiliary requests of appellant II is directed to a method of producing lidstock. It was argued on behalf of appellant II that the claim should be allowable under Article 123(3) EPC as being based on claim 3 as granted, but having undergone a change of category.

However, Rule 57a EPC requires that amendments of a European patent must be occasioned by grounds of opposition. This is not the case for claim 10 of the main request and first to third auxiliary requests of appellant II. The amendments which result in claim 10 of these requests involve reformulations and editorial amendments as compared with the independent claims as granted which, whilst they may well be allowable under the provisions of Article 123(2) and (3) EPC, go beyond

what is necessary to overcome a ground of opposition specified in Article 100 EPC.

The main request and first to third auxiliary requests accordingly involve amendments which do not comply with the requirements of Rule 57a EPC and these requests are not allowable.

4. *Admissibility of the fourth and fifth auxiliary requests*

These requests were filed by appellant II at the oral proceedings before the Board in response to objections under Rule 57a EPC which were raised for the first time at the oral proceedings. In addition, these requests merely involve combinations of claims which were filed in previous requests with claims of the patent in suit as maintained by the Opposition Division in the decision under appeal. The late filing of these requests thus does not amount to an abuse of the procedure and does not introduce any issues into the proceedings for which appellant I was not prepared. The Board therefore concludes that it is an appropriate exercise of its discretion to admit the fourth and fifth auxiliary requests into the proceedings.

5. *Admissibility of arguments relating to novelty and inventive step*

The prohibition of *reformatio in peius* cannot be extended so as to apply separately to each point decided by the Opposition Division. It was argued on behalf of appellant II that a finding of the Board that the subject-matter of the claims of the requests was

not novel or did not involve an inventive step would constitute an implicit finding in respect of the claims of the patent in suit as maintained by the Opposition Division in the decision under appeal. The Board is, however, of the opinion that, in the case of a patentee who is the sole appealing party, the prohibition of reformatio in peius applies only to amendments which would have the effect of placing the patentee in a worse situation by virtue of an amendment having a limiting effect on the scope of protection offered by the claims of the patent in suit as maintained by the Opposition Division in the decision under appeal.

The Board is accordingly of the opinion that arguments relating to novelty and inventive step should be admitted.

6. *Fourth auxiliary request*

6.1 Amendments

Claim 3 as granted relates to a "composite laminated foil covering and printed label structure for a package". Claim 1 of the fourth auxiliary request of appellant II relates to "printed, laminated lidstock for contact lens blister packages". The wording of the claim makes it clear that the claim is directed to a composite foil material, and the use of the term "lidstock" indicates that the claimed material is intended for use as a covering for a package. Finally, the amended claim 1 refers to the printed indicia forming "a printed label". Claim 1 as amended is thus restricted as compared with claim 3 as granted, so that

the claim satisfies the requirements of Article 123(3) EPC and Rule 57a EPC.

In addition, the application as filed (referring to the printed version) refers to the foil as being suitable for use as a lidstock for contact lens blister packages at column 1, lines 34 to 55. The approach suggested by appellant I, involving comparing claim 1 of the fourth auxiliary request with claim 1 as maintained by the Opposition Division in the decision under appeal, and then looking for a disclosure in the application as filed to the effect that the omitted features are not essential, cannot be followed. Article 123(2) EPC requires that the subject-matter of a claim does not extend beyond the disclosure of the application as filed. This thus merely requires a comparison of the amended claim with the disclosure of the application as filed. Such a comparison leads to the conclusion that the omitted features referred to by appellant I are not disclosed in the application as filed as being essential.

The amended claim 1 of the fourth auxiliary request thus complies with the requirements of Article 123(2) EPC.

6.2 Novelty of claim 1

None of the prior art documents disclose a lidstock for contact lens blister packages on which indicia are imprinted via thermal transfer printing.

The subject-matter of claim 1 is thus novel and satisfies the requirements of Article 54 EPC.

6.3 Inventive step of claim 1

6.3.1 Closest prior art

Document D2 represents the closest prior art. In particular, it is disclosed at page 7, lines 9 to 11, of this document that "the surface and/or reverse surface of this polyester film can be printed on with ink, as required". This document is thus more relevant than documents D8 and D14, insofar as printing on both sides of the polyester film is suggested. The subject-matter of claim 1 is distinguished over the disclosure of document D2 by the use of thermal transfer printing to print on the surface of the film remote from the foil.

6.3.2 Problem to be solved

In the submissions of appellant II, the problem to be solved is to provide a printed foil laminate for contact lens blister packages in which the quality of the printed image is not adversely affected by sterilisation, and which is suitable for sealing to the blister package. This cannot, however, be accepted, since this problem is not solved by the use of an unspecified method of printing on the surface of the plastic film facing the metallic foil and the use of thermal transfer printing on the surface of the film remote from the foil. In particular, thermal transfer printing involves the use of a fusible ink, so that the use of thermal transfer printing in general is not sufficient to ensure that the printed image is not adversely affected by sterilisation. Indeed, in order

for the printed image not to be adversely affected by sterilisation, it is necessary to use an ink which is not adversely affected by the temperatures encountered during sterilisation on both sides of the plastic film.

The problem to be solved must accordingly be more generally formulated as being to provide an appropriate printing method for printing on the outside surface of the film.

6.3.3 Solution

Document D7 relates to a wrapping foil and notes that thermal transfer printing has advantages when it is desired to print variable indicia (column 1, lines 35 to 39).

As indicated in the patent in suit at column 1, lines 25 to 35, it is often desirable to print variable indicia, such as expiration dates, lot numbers and other data on blister packages. The disclosure in document D7 of the advantages of thermal transfer printing for such a purpose thus makes thermal transfer printing an obvious candidate for printing variable indicia on the outside surface of the lidstock. Whilst document D7 does not suggest that thermal transfer printing can withstand sterilisation, as stated under point 6.3.2 above, the use of thermal transfer printing does not in itself solve this problem, which is only solved by the selection of a suitable ink and not by the use of thermal transfer printing.

The subject-matter of claim 1 according to the fourth auxiliary request thus does not involve an inventive step.

7. *Fifth auxiliary request*

7.1 Amendments

The additional features included in claim 1 of the fifth auxiliary request as compared with claim 1 of the fourth auxiliary request have the effect of further limiting the scope of protection and are disclosed in the application as filed.

Referring to the reasoning as set out under point 6.1 above in respect of the fourth auxiliary request, the amended claim 1 of the fifth auxiliary request also complies with the requirements of Article 123(2) EPC.

7.2 Novelty of claim 1

For the reasons in respect of claim 1 of the fourth auxiliary request under point 6.2 above, the subject-matter of claim 1 is novel and satisfies the requirements of Article 54 EPC.

7.3 Inventive step of claim 1

As compared with claim 1 of the fourth auxiliary request, claim 1 of the fifth auxiliary request includes the additional features that a ceramic printing head is used for the thermal transfer printing and that "said lidstock is free from indentations, which may adversely affect its mechanical sealing

properties to a surface of a contact lens blister package".

The reference to a ceramic printing head being used for the thermal transfer printing does not restrict the scope of the claim, which is drawn to a lidstock per se.

It is obvious to the person skilled in that art that the presence of indentations in the lidstock would adversely affect the ability of a lid formed from the lidstock to seal and adhere to a surface of a blister package, and that the presence of indentations should accordingly be avoided regardless of the printing methods adopted.

The additional features thus do not alter the conclusions drawn in respect of the fourth auxiliary request as set out under point 6.3 above. The subject-matter of claim 1 according to the fifth auxiliary request thus does not involve an inventive step.

Order

For these reasons it is decided that:

1. The appeal of appellant I is rejected as inadmissible.
2. The appeal of appellant II is dismissed.

The Registrar:

The Chairman:

M. Dainese

W. Moser