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D E C I S I O N
of 21 April 2005

Case Number: T 0698/02 - 3.2.7

Application Number: 95304012.8

Publication Number: 0747313

IPC: B65H 45/24

Language of the proceedings: EN

Title of invention:

Multiple folded paper for continuous disposal

Patentee:

Yoneyama, Katsu

Opponents:

Nice-Pak International Ltd.
Paper Converting Machine Company

Headword:

-

Relevant legal provisions:

EPC Art. 56, 84, 100(b), 111(1), 114(2), 123(2)
EPC R. 57a

Keyword:

"Amendment of granted claims for lack of clarity (not allowed)"
"Added subject-matter (no)"
"Late filed documents (one admitted)"
"Remittal to first instance to consider insufficiency and alleged prior use"
"Insufficiency (not admitted into appeal procedure)"

Decisions cited:

T 0301/87

Catchword:-



Case Number: T 0698/02 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 21 April 2005

Appellant: Yoneyama, Katsu
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 29 April 2002
revoking European patent No. 0747313 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: H. E. Felgenhauer
Members: P. A. O'Reilly
C. Holtz

Summary of Facts and Submissions

I. Opposition was filed against European Patent No. 0 747 313 as a whole and based on Article 100(a) EPC (lack of novelty and lack of inventive step), Article 100(b) EPC (insufficiency) and Article 100(c) EPC (added subject-matter).

The Opposition Division decided to revoke the patent. The Opposition Division held that the subject-matter of claim 1 of the main request was not clear (Article 84 EPC) and that the subject-matter of claim 1 of the auxiliary request did not involve an inventive step (Article 56 EPC).

II. The appellant (proprietor) filed an appeal against the decision of the Opposition Division.

III. The appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of either the main request filed as annex C with letter of 27 August 2002, or the auxiliary request filed as annex D with letter of 21 March 2005, alternatively that case be remitted to the first instance for further prosecution.

Respondents I and II (opponents I and II respectively) each requested that the appeal be dismissed. The respondents alternatively each requested that the decision under appeal be set aside and the case be remitted to the first instance for further prosecution.

IV. The independent claim of the main request reads as follows (with amendments compared to the claim as granted indicated in bold):

"1. A **container and** multiple folded paper for continuous disposal of wet paper sheets comprising:

a container having an outer slit;

a first group of sheets of **wet** paper folded rightwardly;

a second group of sheets of **wet** paper folded leftwardly;

a lower folded-section of each of said first group sheets of paper being interdigitated with an upper folded-section of each of said second group sheets of paper thereunder, thereby forming a multiple folded paper;

said multiple folded paper being received in said container such that a leading end of the upper folded-section **of the uppermost but one sheet of paper**, which is in a frictional engagement at the interdigitated area with the uppermost folded sheet of paper, is exposed out of said outlet slit by drawing out the upper folded-section of the uppermost folded sheet of paper through the outlet slit formed in said container, thereby facilitating a continuous disposal of said multiple folded paper;

wherein a tail end of the lower folded-section of each of said first group sheets of paper folded rightwardly and a tail end of the lower folded-section of each of said second group sheets of paper **is** folded back in an

opposite direction with respect to the folding direction of each sheet of paper, thereby forming superimposing ends of a reduced width respectively, the reduced width superimposing end of each of said rightwardly folded sheets of paper being interdigitated with the leading end of said upper folded-section of each of said leftwardly folded sheets of paper and the reduced width superimposing end of each of said leftwardly folded sheets of paper being interdigitated with the leading end of said upper folded-section of each of said rightwardly folded sheets of paper, so that the reduced width superimposing ends of said rightwardly folded sheets of paper and the reduced width superimposing ends of said leftwardly folded sheets of paper will be proportionally distributed to the right side and the left side of said multiple folded paper."

The independent claim of the auxiliary request reads as follows (with amendments compared to the claim as granted indicated in bold):

"1. A multiple folded paper for continuous disposal of wet paper sheets comprising:

a container having an outer slit;
a first group of sheets of **wet** paper folded rightwardly;
a second group of sheets of **wet** paper folded leftwardly;

a lower folded-section of each of said first group sheets of paper being interdigitated with an upper folded-section of each of said second group sheets of

paper thereunder, thereby forming a multiple folded paper;

said multiple folded paper being received in said container such that a leading end of the upper folded-section, which is in a frictional engagement at the interdigitated area with the uppermost folded sheet of paper, is exposed out of said outlet slit by drawing out the upper folded-section of the uppermost folded sheet of paper through the outlet slit formed in said container, thereby facilitating a continuous disposal of said multiple folded paper;

wherein a tail end of the lower folded-section of each of said first group sheets of paper folded rightwardly and a tail end of the lower folded-section of each of said second group sheets of paper are folded back in an opposite direction with respect to the folding direction of each sheet of paper, thereby forming superimposing ends of a reduced width respectively, the reduced width superimposing end of each of said rightwardly folded sheets of paper being interdigitated with the leading end of said upper folded-section of each of said leftwardly folded sheets of paper and the reduced width superimposing end of each of said leftwardly folded sheets of paper being interdigitated with the leading end of said upper folded-section of each of said rightwardly folded sheets of paper, so that the reduced width superimposing ends of said rightwardly folded sheets of paper and the reduced width superimposing ends of said leftwardly folded sheets of paper will be proportionally distributed to the right side and the left side of said multiple folded paper."

V. The documents cited in the present decision are the following:

D2a: US-A-3 462 043

D5: US-A-3 207 360

D7: JP-A-58 3897 (with translation)

D12: US-A-3 119 516

D29: US-A-4 848 575

D30: JP-A-63 186 689

VI. The appellant argued in written and oral submissions essentially as follows:

(i) The main request should be refused under Rule 57a EPC. The appellant was forced by the Opposition Division to make the amendments to claim 1 because of an alleged lack of clarity. The amendments were thus not made to meet a ground of opposition.

(ii) The ground under Article 100(b) EPC should not be admitted into the appeal proceedings since no decision was taken on this ground by the Opposition Division. If the ground is admitted then the case should be remitted to the first instance to allow the appellant to argue his case before two instances.

- (iii) The amendment to claim 1 of the auxiliary request complies with Article 123(2) EPC. It is clearly stated in the description of the patent in column 3, lines 10 to 12 that the paper being wet paper sheets is a preferred feature of the invention so that it is allowable to limit claim 1 to this preferred feature.
- (iv) With the exception of the translation of D7 the documents filed late by respondent II should not be admitted into the proceedings as they are not relevant.
- (v) The subject-matter of claim 1 of the auxiliary request involves an inventive step.

The skilled person would not arrive at the subject-matter of claim 1 based on general considerations as there is no reason for the skilled person to fold the lower folded section. D5 and D7 do not show folds for reducing the width of the superimposing ends.

D2a discloses a stack of dry sheets and only discloses a container with an opening which, relative to the stack of folded paper, is at the opposite end to that specified in claim 1. The skilled person would therefore have to recognise that the stack known from D2a when inverted would be suitable for wet sheets. There is no indication that the skilled person would invert the stack known from D2a. D5 and D12 show the removal of tissues from both ends of a stack but have special folding arrangements to achieve this result. There

is no general teaching in these documents of removal from both ends always being possible. D7 does not disclose folds for reducing the width of superimposed ends. Also D29 does not reduce the width of the superimposed ends.

- (vi) If the decision under appeal is set aside then the case should be remitted to the first instance to consider the alleged prior use.

VII. Respondent I argued in written and oral submissions essentially as follows:

- (i) Respondent I has no comment on the allowability under Rule 57a EPC of the amendments to claim 1 of the main request.
- (ii) Claim 1 of the auxiliary request does not comply with Article 100(b) EPC. Article 100(b) EPC was a ground of opposition. Also, the Opposition Division considered the clarity of the claim and Article 100(b) EPC and Article 84 EPC are two aspects of the same problem as indicated by the case law.
- (iii) Claim 1 of the auxiliary request offends Article 123(2) EPC. The term wet is mentioned in the patent only as a preferred feature (see column 3, line 12 and the word "particularly") and not as an essential feature. The specification as a whole does disclose the feature as being an essential feature of the invention.

- (iv) Respondent I has no comment on the admissibility of the documents late filed by respondent II.
- (v) The subject-matter of claim 1 of the auxiliary request lacks an inventive step.

It is generally known that wet paper sheets have a greater adherence to each other so that they do not need to overlap so much with each other when it is desired that removal of one sheet from a container pulls out a leading end of the next sheet. It is also known that not too much of the wet sheet should be exposed outside the container whereby the patent itself suggests about a quarter of the sheet as ideal. There are also known desires to provide symmetry in the stack of sheets and to reduce the width of the container. Furthermore the skilled person would routinely try all dry sheet designs for use with wet sheets.

Taking into account these general considerations the skilled person would start from the well known V fold. He would then seek to reduce the overlap between the sheets as he knows that this can be less for wet sheets. He can reduce the overlap by folding either the top section or the bottom section as is known from D5 or D7. Folding the top section has the disadvantage that too much is pulled out of the container and the heavier weight of wetted sheets makes a folded part harder to pull out by adherence. Therefore the skilled person would fold the bottom part. Hence the skilled person would arrive at the subject-matter of claim 1.

The subject-matter of claim 1 also lacks an inventive step starting from D2a. The folding of the stack of sheets disclosed in D2a is the same as specified in claim 1 except that the stack is inverted and the document does not mention wet sheets. As already indicated it is routine for the skilled person to consider for wet sheets the folding arrangements already known for dry sheets. The skilled person knows however that it is possible to take sheets from the bottom of a stack as well as from the top of a stack. This is shown in D12 wherein there are two access openings at respective ends of the stack to allow access thereto in order to remove the sheets either as single ply or as double ply. It is also indicated that the whole container may be inverted. Also D5 discloses that the container may have two openings, respectively at the top and bottom, and that the sheets may be taken out via either opening. When taking out sheets through the bottom opening it is disclosed that these may either be removed as a group of several sheets or be removed singly. Claim 1 does not exclude an opening at the bottom.

Starting from D5 the skilled person knows from column 6, lines 35 to 38 and lines 50 to 51 that both openings of the disclosed container may be used. The folding illustrated in figure 3 of the document is within the definition given in claim 1 so that the skilled person would arrive at the container and stack specified in claim 1.

(vi) If the decision under appeal is set aside then the case should be remitted to the first instance to consider the prior use.

VIII. Respondent II argued in written and oral submissions essentially as follows:

(i) Respondent II has no comment on the allowability under Rule 57a EPC of the amendments to claim 1 of the main request.

(ii) Respondent II has no comment on the admissibility of the ground under Article 100(b) EPC into the appeal proceedings.

(iii) Respondent II has no comment on the allowability under Article 123(2) EPC of the amendment to claim 1 of the auxiliary request.

(iv) The translation of D7 should be admitted into the proceedings since it is the translation of a document already in the proceedings. The other documents, with the exception of Soap & Daily Necessities News, relate to the prior use. Soap & Daily Necessities News is relevant and hence should be admitted into the proceedings. It has a printed publication date before the filing date of the patent in suit although the respondent has no further evidence in this respect. Its content is relevant because it shows that the skilled person would consider dry paper sheets when deciding how to fold a wet paper sheet.

- (v) The subject-matter of claim 1 of the auxiliary request lacks an inventive step.

Respondent II agrees with the arguments of respondent I in this respect. With respect to the arguments starting from D2a reference should also be made to D30 which dispenses paper sheets from both ends of a stack.

Furthermore, D7 also discloses a stack of sheets having the same folding arrangement as set out in claim 1. The only difference between the subject-matter of claim 1 and the disclosure of D7 is that the sheets are wet paper and there is an outer slit. D29 shows that dry paper arrangements may be applied to wet paper arrangements. Also D29 shows that for wet paper sheets a slit would be provided at the top of the container. Therefore also in view of the combination of D7 and D29 the subject-matter of claim 1 is obvious.

The subject-matter of claim 1 is moreover obvious starting from D30. In D30 the container has two compartments, an upper one for dry sheets and a lower one for wet sheets. The folding arrangement is the same in each compartment but in the compartment for dry sheets the opening is at the top whereas in the compartment for wet sheets the opening is at the bottom. There is a pad at the bottom of the lower compartment to wet the sheets as they are withdrawn in practice this pad would wet all the sheets while they are still in the compartment. If the skilled person wished to improve the arrangement of D30 they would go to

D2a and use the folding of D2a in both of the compartments of D30. The bottom compartment would then correspond to claim 1 if the container was just turned upside down. Claim 1 does not exclude that the slit may be in the side of the container.

(vi) If the decision under appeal is set aside then the case should be remitted to the first instance to consider the prior use.

Reasons for the Decision

1. *Late filed documents*

1.1 Respondent II filed a number of documents with its response to the appeal. One of these documents is a translation from Japanese into English of D7 which is a document already in the opposition proceedings. The filing of its translation into an official language can therefore only help the proceedings, so the Board has admitted the document.

1.2 Respondent II wished during the appeal proceedings to rely on a further Japanese document (as well as its translation into English) which is entitled "Soap & Daily Necessaries News" and has a date printed on it of 7 June 1995. This date is just two days before the filing date (9 June 1995) of the patent in suit so that the document would need to have been available to the public by the next day (8 June 1995) at the latest. Respondent II has no evidence regarding availability to the public of the document. The nature of the document, i.e. daily newspaper, weekly or monthly magazine, and

normal means of distribution of the document are not known. With for instance magazines it is the general experience in life that dates printed on them cannot be relied upon as exact publication dates. They commonly are available to the public on quite different dates to those printed on them. It has not therefore been proven that the document was available to the public before the filing date of the patent in suit so that already for this reason the document is not *prima facie* relevant.

- 1.3 However, the Board further considers that, irrespective of its date of availability to the public, the document is not relevant as a piece of prior art on the basis of its content. Respondent II argued its relevance with regard to the Z-folding of wet paper sheets and in that it links wet and dry paper sheet forms. However D29, which is an earlier patent document already in the proceedings, relates to wet paper sheets and shows Z-folding (figure 20). Moreover D29 discusses the relationship of wet and dry paper sheets (cf. column 15, lines 25 to 44). D29 thus has already covered the matters for which respondent II claims the document is relevant. The Board therefore exercises its authority under Article 114(2) EPC to disregard the document for the purpose of the present appeal proceedings. This non admittance of the document into the present appeal proceedings does not mean that the relevance of the document as a piece of evidence for the alleged prior use cannot be examined together with the alleged prior use.

- 1.4 The remaining documents which were late filed by respondent II relate, according to respondent II,

solely to the alleged prior use so that the Board does not take a decision on their admittance into the proceedings.

Main request

2. *Admissibility of the amendments*

2.1 The main request differs from the patent as granted in that in claim 1 the term "wet" has been introduced in the definition of the first and second group of papers. This amendment was made to further distinguish the claim from the prior art since some of the relevant cited prior art documents relate to sheets of dry paper. The claim further contains amendments which were effected in order to overcome a finding of lack of clarity made by the Opposition Division. This finding is set out in section 2 of the decision of the Opposition Division. Article 84 EPC is not a ground of opposition. The Opposition Division was not therefore entitled to examine the claim for compliance with Article 84 EPC other than to examine whether the amendments made to the claim complied with Article 84 EPC. The Opposition Division did not however reject the claim because the amendments did not comply with Article 84 EPC, but because parts of the claim in their form as granted did comply with Article 84 EPC. In the view of the Board the fact that a claim is amended does not open the whole claim to examination under Article 84 EPC. Such examination is limited to effects of the amendments (cf. T 301/87, point 3 of the reasons).

2.2 Since the Opposition Division was not entitled to examine the whole claim under Article 84 EPC it was also not entitled to allow amendments to the claim to overcome an objection under this article. Such amendments do not comply with Rule 57a EPC as they are not occasioned by a ground of opposition.

2.3 The main request cannot therefore be allowed as it is not in accordance with Rule 57a EPC.

Auxiliary request

3. *Rule 57a EPC*

3.1 Claim 1 of the auxiliary request differs from claim 1 as granted in that the term "wet" has been introduced into the definition of the first and second group of papers. As already indicated above with respect to the main request the amendment was made to further distinguish the claim from the prior art. The amendment has therefore been occasioned by a ground of opposition and does not therefore contravene Rule 57a EPC.

4. *Article 123(2) EPC*

4.1 Respondent I acknowledged that there was a specific disclosure of the amendment in the description but argued that the specific disclosure could not be incorporated in the claims. The Board cannot agree with the respondent. In column 3, lines 10 to 12 of the patent description it is indicated that it is "an object of the invention to provide a multiple folded paper for continuous disposal particularly of wet sheets". This is a clear disclosure that the invention

may be limited to wet sheets as set out in the claim as amended. This disclosure is not a disclosure of a feature in combination with other features such that the disclosure could require that the other features also be included in the claim, as apparently implied by respondent I. The fact that the feature was not disclosed as an essential feature to the invention is not a bar to it later being incorporated into an independent claim.

4.2 The Board is therefore satisfied that the amendment complies with Article 123(2) EPC.

5. *Insufficiency*

5.1 Respondent I wished to argue against claim 1 of the auxiliary request on the basis of Article 100(b) EPC. This was a ground of opposition during the opposition proceedings but the ground was not discussed in the oral proceedings before the Opposition Division and the Opposition Division did not take a decision on the ground. Respondent I argued that Article 100(b) EPC and Article 84 EPC were interlinked. The Board cannot agree with this argument as a general statement. Article 100(b) EPC is a ground of opposition, whereas Article 84 EPC is not a ground of opposition. Article 100(b) EPC is directed to the description of the patent, whereas Article 84 EPC is directed to the claims of the patent. There is thus no general linking of these grounds (cf. T 301/87). Also, in the particular circumstances of the present case the discussion of the Opposition Division concerned the wording of the claims as such and not whether the

description sufficiently disclosed the invention as claimed.

5.2 The Opposition Division did not take a decision on this ground and the appellant has requested remittal to the first instance before the ground is discussed. The Board has therefore decided not to consider the ground in the present appeal proceedings.

6. *Inventive step*

6.1 The respondents have used a number of lines of argumentation against the presence of inventive step in claim 1 and it is appropriate to take these lines one by one.

6.2 The first line of argument is based on the general knowledge of the art of the person skilled in the art. The argument is that the skilled person would be aware that wet paper sheets have greater adherence between each other than dry sheets and that not too much of the wet paper sheet should be exposed outside of the container, i.e. exterior to the slot. The skilled person is also assumed to desire symmetry of the stack and to wish to minimise the width of the container. The skilled person is assumed to start from the well known C-folded form of stacking illustrated in figure 1 of the patent in suit. The skilled person would then wish to reduce the amount of overlap between the tail of one sheet and the leading end of the next sheet so that the stack would be suitable for wet paper sheets. To achieve this reduction in overlap respondent I considered that the skilled person would immediately think of folding the lower part of the sheet back on

itself and thus would arrive at the stack of sheets specified in claim 1.

The Board cannot agree with this argumentation. First of all the requirement that the width should be minimised speaks against starting from a C-fold. As discussed in the patent in suit in column 1, lines 38 to 56 and illustrated in figures 1 and 2 a C-fold produces a wider stack than, for instance, a Z-fold. Even if the skilled person were to consider starting from the C-fold the argument that it was obvious to reduce the overlap by folding the lower sheet cannot be followed by the Board. Normally if an overlap is to be reduced this is reduced directly, i.e. by arranging that the length of either the lower section of the upper sheet or the upper section of the lower sheet is reduced. Carrying out such a modification would reduce the overlap in the simplest possible manner without however falling within the scope of claim 1.

Respondent I has given no convincing argument as to why the skilled person would choose another form of folding. Although respondent I has mentioned D5 and D7 these documents do not disclose folding the lower folded section to provide superimposed ends of reduced width. This is explained in more detail in section 6.4 below.

Respondent I has essentially argued in this respect that starting from general considerations there is a one-way street leading the skilled person to the features of claim 1. The Board cannot agree with this view. D29 shows an attempt to provide a stack of folded wet tissues wherein the removal of one sheet through an opening pulls a leading end of the next sheet through

the opening. The inventor of that stack however chose a different manner of folding the sheets to that claimed in claim 1 and moreover D29 only uses one group of sheets to solve the problem. The folding is illustrated in figure 20 of the document. The overlap between successive sheets in this case is reduced by shortening the leading and trailing sections of each sheet and forming a Z-fold. This arrangement has the drawback that there is a bulge in the centre. Nevertheless it shows that the skilled person faced with the problem and having knowledge of several undesirable properties would not automatically assume that a solution existed, but could conclude that at least one drawback may have to be accepted. The Board thus concludes that there is no one-way street leading to the features of claim 1 and furthermore that the most obvious actions of the skilled person would not lead in the direction of claim 1.

- 6.3 A second line of argument was based on D2a. It is agreed by the parties that the stack disclosed in figure 9 of this document is folded in the same manner as the stack defined in claim 1. The Board is also of this opinion. It is also agreed that the difference between the subject-matter of claim 1 and the disclosure of the document lies in claim 1 specifying wet sheets and in the slit in claim 1 being provided at the opposite end of the stack to that disclosed in D2a. This essentially means that the stack disclosed in D2a must be inverted within the container in order to arrive at the definition of the stack specified by the claim.

6.3.1 Reference was made in this respect by respondent I to D5. In this document there is disclosed a container with an opening in the top. The sheets in the stack are interdigitated. It is also indicated in the document that there may be an opening in the bottom of the container (cf. figure 9). The purpose of this opening is stated to be to permit the user to reach through the opening and withdraw a group of interfolded sheets (cf. column 6, lines 39 to 41). There is also a statement that because of the S-form of the sheets "the end-most sheet at each end of the stack of sheets is readily accessible through its dispensing opening" (cf. column 6, lines 52 to 58). Regarding the general purpose of the teaching of D5 there is a statement in column 1, lines 9 to 14 that the invention is directed to permitting the user to dispense sheets one at a time or in groups of two or more. There is also a statement in column 6, lines 46 to 51 that if serial, i.e. single, dispensing is required the upper opening is opened, or if multiple dispensing is required the lower opening is opened, or if both possibilities are required both openings are opened. The Board therefore understands this teaching to mean that the primary purpose of the bottom opening is to provide for multiple dispensing, though a single dispensing is not excluded. The Board also notes that it is essential to the teaching of the document that the openings are large enough for the insertion of fingers, cf. claim 1 of the document. This means that the package would be unsuitable for use with wet sheets since these would quickly dry out. Although respondent I essentially relied on this document as evidence that the skilled person would consider removing from the other end of the stack it must be taken into account that this lower opening is disclosed

in the document primarily in the context of removing multiple sheets in a manner which is unsuitable for use with wet sheets. Moreover, the folding of the sheets is a particular type of S-shape which is relatively symmetric when viewed from either end which is why dispensing from either end is envisaged. Hence the Board does not find a clear indication from the document to the skilled person that he should in general consider inverting a stack of folded papers. The teaching of the document is rather to provide a stack with a form of folding that allows a differing result when sheets are removed from the opposing ends.

6.3.2 With regard to the question of whether the skilled person would consider inverting the stack reference was also made to D12. D12 discloses a container with openings at the top and bottom. The sheets in the stack are so folded that the edge which is presented to the user at the top opening is a folded edge, i.e. a double ply, whereas the edge presented to the user at the bottom opening is a single edge, i.e. a single ply. The sheets are not folded in a way whereby the removal of one sheet should partly expose the next sheet outside the opening. Because of this a relatively wide opening is required at each end. A wide opening however would make the teaching unsuitable for use with wet paper sheets as these would dry out before use.

6.3.3 Reference was further made in this context by respondent II to D30 (which was filed with the opposition grounds by respondent II and originally numbered D5 in those grounds). D30 shows a container with two compartments, each containing a stack of sheets. The sheets are folded in a way which requires

only a single group of sheets. For the stack in the upper compartment of the container a central opening is provided and the stack is composed of dry sheets. For the stack in the lower compartment of the container a source of moisture is provided at the bottom of the container and there is an opening at the side. Despite the differing positioning of the openings the stacks in the two compartments are folded and orientated identically. Respondent II argued that this showed that the skilled person considering D2a would copy the teaching of D30 and thus arrive at the upside down orientation of the stack with respect to the slit, i.e. the orientation specified in claim 1. The Board cannot agree with this analysis. D30 teaches that if it is desired to remove sheets from the bottom of the stack then this may require positioning the slit in a different position to that which would be used when removing sheets from the top of the stack. D30 thus places a prejudice against simply moving the opening from the top to the bottom since it implies that it may not be possible to place the opening in the desired position.

6.3.4 The Board thus finds no indication to the skilled person from D5, D12 or D30 to move the opening from the top to the bottom of a stack of sheets, or invert the stack of sheets within the container, without further consideration of the technical implications. The documents thus do not incite the skilled person to invert the stack within the container of D2a.

6.3.5 Considering the argument that the skilled person would, based on general considerations, invert the stack disclosed in D2a it is, *inter alia*, necessary to

consider the effects of such an inversion. In the orientation disclosed in figure 9, the top of the stack provides two folded edges at the centre of stack which are directly accessible to the user upon opening the container. This makes it easy for the user to pick out the first sheet before the automatic presentation of the subsequent sheets commences. This advantage is expressly stated in the document in column 7, lines 25 to 33. If the stack is inverted then the top of the stack will present to the user a flat sheet of paper. There will be no end available at the opening which the user may grasp. The user will thus have to pinch the middle of the first sheet in order to remove it and thereby possibly pinch more than one sheet which would not be considered satisfactory. There is thus a restraint on the skilled person against inverting the particular stack disclosed in figure 9 of D2a.

6.3.6 Starting from D2a the skilled person would therefore need to recognise that this stack should be considered for use with wet paper, that when considering the stack for use with wet paper the stack should be inverted, and that the restraint against inverting should be ignored. The Board cannot however see any convincing arguments as to why the person skilled in the art should do this.

6.4 Respondent I also argued starting from D5. The argument of the respondent requires that the folding of sheets in the stack disclosed in the document corresponds to the stack defined in claim 1 when inverted. The Board however does not agree with this assertion. Claim 1 requires that the lower folded section of the sheets of each group of sheets are folded back to form

superimposing ends of reduced width. This is not the case for the stack known from D5. When inverted the folding back of the lower folding section of the sheets does not form superimposing ends of reduced width since the amount of superposition remains the same since the whole of the folded back section remains in contact with the upper folded section of the next sheet of the other group of sheets. Since the folding is different to that of claim 1 the skilled person would not arrive at the container and stack of claim 1 starting from D5.

- 6.5 Starting from D7 respondent II argued that the only difference between the subject-matter of claim 1 and the disclosure of D7 was the presence of wet paper sheets and the position and type of opening. The Board does not agree that the folded section of D7 produces superimposing ends of reduced width as required by claim 1. In D7 the folding of the lower section of a sheet from the first group has no effect on the amount of overlap, i.e. superimposition, with the upper folded section of the sheet from the second group since the fold merely means that the overall width of the stack is reduced. The amount of the lower folding section of the sheet of the first group that is in direct contact with the upper folding section of the sheet of the second group is not altered, i.e. reduced, by the folding. According to claim 1, however, this amount of overlap or superimposition cannot be reduced as a result of the folding of the lower sections of sheets. Moreover, there does not appear to be a reason why the skilled person would consider D7 when wishing to provide a stack of folded wet sheets. In D7 the sheets are folded such as to fit into a cylindrical container with a large access opening arranged axially at one end.

There is no reason for the skilled person to consider that the folding of the stack of sheets known from D7 would be suitable for use in a container which is to contain wet sheets and has an opening in the form of a slit below which the sheets are arranged. Respondent II has referred to D29 in this respect. This document however merely indicates that the amount of overlap for wet sheets may be less than for dry sheets. The Board therefore considers that also starting from D7 the subject-matter of claim 1 is not obvious for the skilled person.

- 6.6 Respondent II further argued starting from D30 and in particular that the skilled person starting from D30 and wishing to improve the folding arrangement to occupy less space would consider the arrangement of figure 9 of D2a and thus arrive at the subject-matter of claim 1. In D2a in column 8, lines 23 to 26 it is stated that the folding arrangement takes less space. If the skilled person simply took the stacks disclosed in D2a and placed one in the upper compartment of the container known from D30 and one in the lower compartment then there would be a problem. Because D30 has a slit only at one side of the lower compartment and the folding of the stack of D2a produces free ends at both sides when sheets are removed from the bottom of the stack it would be necessary to provide slits on both sides of the bottom of the pack. Such an arrangement would not fall within the scope of claim 1 of the request under discussion. The skilled person does not in this manner arrive at the container and stack of claim 1.

6.7 Therefore, the subject-matter of claim 1 of the auxiliary request involves an inventive step in the sense of Article 56 EPC with respect to the prior art documents admitted into the proceedings which are not part of the evidence concerning the alleged prior use or prior publication of the Nepia Wet sales guide.

7. *Remittal to the First Instance*

7.1 The Opposition Division in their decision indicated that the alleged prior use, if proven, could affect the novelty of claim 1. Moreover, the Opposition Division has not yet taken a decision on the ground under Article 100(b) EPC. The Board has not considered the prior use either alone or in combination with the other documents in the proceedings. The Board has also not considered the ground under Article 100(b) EPC. All the parties have requested remittal of the case to the first instance if the patent is not revoked on the basis of the documents which do not relate to the prior use. In accordance with Article 111(1) EPC, the Board therefore considers it appropriate to remit the case to the first instance so as to give the parties the possibility to argue their case before two instances.

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.

The Registrar:

The Chairman:

G. Nachtigall

H. Felgenhauer