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**D E C I S I O N**  
**of 21 June 2005**

**Case Number:** T 0361/03 - 3.4.3

**Application Number:** 95922429.6

**Publication Number:** 0765514

**IPC:** G09F 3/02

**Language of the proceedings:** EN

**Title of invention:**

A label and a lever arch file or ring binder

**Patentee:**

DRY LABEL DENMARK APS

**Opponent:**

Sigel GmbH

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 111, 114, 104, 54, 56

**Keyword:**

"Late filed documents"

"Remittal for further prosecution"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0361/03 - 3.4.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.3  
of 21 June 2005

**Appellant:**  
(Opponent)

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**Representative:**

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**Respondent:**  
(Proprietor of the patent)

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**Representative:**

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**Decision under appeal:**

Decision of the Opposition Division of the  
European Patent Office posted 29 January 2003  
rejecting the opposition filed against European  
patent No. 0765514 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** R. G. O'Connell  
**Members:** V. L. P. Frank  
P. Mühlens

## Summary of Facts and Submissions

- I. This is an appeal against the rejection pursuant to Article 102(2) EPC of the opposition to European patent 765 514.

The opposition was directed against the patent as a whole and was based on the grounds mentioned in Article 100(a), (b) and (c) EPC, although only the grounds of lack of novelty and of inventive step (Article 54 and 56 EPC) were substantiated.

- II. Independent claim 1 of the granted patent forming the basis of the proprietor's main request on appeal reads as follows:

"A label assembly (10; 20; 30; 40; 50; 60) comprising: a support sheet (11, 13; 21a, 21b, 23; 31a, 31b, 31c, 31d, 33; 41a; 51a; 61a) made of paper material, said support sheet defining opposite surfaces, an adhesive coating (12, 14; 22a, 24; 32a, 34) applied to one side of said support sheet, and a printing sheet (16, 17; 26, 27a, 27b, 27c; 37; 47; 57; 67) defining opposite front and rear surfaces, said rear surface of said printing sheet being releasably fixated to said support sheet in facial contact therewith through said adhesive coating, said printing sheet being divided into individual printing labels or printing tags (17; 27a, 27b, 27c; 37; 47; 57; 67) which are individually removable from said support sheet, characterized in that said printing sheet, thus also said individual labels or tags, are made of printing paper material, in that

said individual paper labels or paper tags (17; 27a, 27b, 27c; 37; 47; 57; 67) are adapted to be removably received inside a receiving pocket (72) affixed at the back (76) of a lever arch or ring binder (70) so as to distinguish and identify them or to be formed as individual place cards, visiting cards, gift tokens, taking in to dinner cards, name signs, conference signs, badges, table signs or identity cards, and in that said paper printing sheet (16, 17; 26, 27a, 27b, 27c; 37; 47; 57; 67) is provided with a release coating at said rear surface thereof and said release coating facing and contacting said adhesive coating (12, 14; 22a, 24; 32a, 34) of said support sheet in said facial contact between said support sheet and said paper printing sheet."

Claim 1 according to the auxiliary request submitted during the oral proceedings before the board appends the following features to claim 1 of the main request:

"said adhesive coating (12, 14; 22a, 24; 32a, 34) being a water based, non-heat curable adhesive coating allowing said label assembly (10; 20; 30; 40; 50; 60) to be printed in a printer such as a laser printer or ink jet printer exposing said label system (10; 20; 30; 40; 50; 60) to heat during the printing process."

III. The following prior art documents were cited *inter alia* in the opposition procedure:

D8: EP 0 613 792 A

D9: DE 94 14 959 U

D10: DE 42 40 825 A

One month before the oral proceedings held before the board on 21 June 2005 the appellant opponent filed the following prior art documents:

D15: US 3 420 364 A

D16: US 3 854 229 A

D17: EP 0 034 316 A

D18: US 2 896 351 A

IV. The appellant opponent argued essentially as follows:

- Documents D8 and D9 disclosed all the features of the label assembly according to claim 1 of the main request.
- The opposition division's assessment of document D10 was incorrect, as this document also disclosed all the features of the label assembly of claim 1 of the main request. The presence of a release coating on the rear side of the labels was implicitly disclosed by the requirement that the labels have no traces of adhesive left on them when removed from the support sheet. Moreover, according to document D10, self-adhesive labels were already known in the prior art. A self-adhesive label assembly comprised a release coating on the support sheet and an adhesive coating on the printing sheet so that the adhesive remains on the label when peeled off. The label assembly of the opposed patent was thus nothing more than a

kinematic inversion of this conventional label assembly in which the relative positions of the adhesive and release coatings were exchanged.

- It would moreover have been obvious for a skilled person to use a release coating on the rear side of the labels disclosed in document D10 so that no traces of adhesive were left on them when removed from the support sheet, given that the use of release coatings was well known in the art, as shown eg in document D8.
  
- Documents D15 to D18 were found in an additional search carried out after having received the preliminary opinion of the board and also disclosed all the features of the label assembly according to the main request or at least rendered such an assembly obvious. The use of a release coating in a label assembly was, moreover, clearly disclosed in these documents. Its use in the label assembly of document D10 therefore did not involve an inventive step.
  
- To specify the adhesive used as in claim 1 of the auxiliary request did not involve an inventive step, as nothing inventive could be recognized in using a known agent for its known specific use. Water based adhesives became known shortly before the priority date of the opposed patent and it would have been obvious to a skilled person to use them for the adhesive coating.

V. The respondent proprietor argued essentially as follows:

- Document D8 failed to disclose a release coating applied to the rear side of the printing labels. The material which was removed from the blank for the manufacture of the form and which had a release coating on its rear side was not the printable business card, as the business card was a separate element having slightly smaller dimensions than the die cut-out and which was positioned for the printing step within the cut-out. It was nowhere mentioned in this document that a release coating was applied on the rear side of the business card.
  
- The opposition division considered that document D9 did not belong to the state of the art under Article 54(2) EPC as the claim to priority from its priority date had not been validly proven. No new facts had been adduced by the appellant that would change this assessment.
  
- The argument that the use of a release coating was part of the common general knowledge in the art and therefore implicitly disclosed in document D10 had failed to persuade the opposition division. The reference in this context to document D8 was inadmissible, as document D8 was part of the state of the art under Article 54(3) EPC and was therefore only relevant for assessing novelty, but not inventive step. Document D10 disclosed, moreover, that the labels can be printed on both sides by merely removing them from the support sheet, turning them over and repeating the printing step. This would clearly be impossible if a release coating

were provided on their rear surface, as the presence of a release coating rendered printing on it nearly impossible. Consequently, the method of document D10 would have to be modified in a manner contrary to its specific teaching.

- No reasons whatsoever had been presented by the appellant to justify the very late introduction of documents D15 to D18. In order to have these documents assessed at two levels of jurisdiction, it was requested to remit the case to the department of first instance if these documents were admitted into the proceedings. Moreover, an apportionment of costs was requested, since further costs would arise from the remittal which were directly attributable to the late filing of these documents by the appellant opponent.
  
- Document D15 did not disclose a label assembly as presently claimed. The tags disclosed in documents D15 were not made of paper, since the word *tag* was commonly used to mean a piece of cloth or metal or a plastic sheet. This document also failed to disclose a printing sheet made of paper which was divided into a plurality of individual labels. The endless paper strip used as support in document D15 could moreover not be considered as a support sheet.
  
- The label assembly according to the auxiliary request specified a water soluble adhesive which had to resist the heated environment of a laser printer, since for environmental safety reasons no organic solvent based adhesives could be used. No prior art document disclosed the use of such an adhesive.



- VI. At the oral proceedings before the board the appellant opponent requested that the decision under appeal be set aside and that the patent be revoked.

The respondent proprietor requested as main request that the appeal be dismissed, as first auxiliary request that the patent be maintained in amended form on the basis of the auxiliary request filed in the oral proceedings, as second auxiliary request that the case be remitted to the department of first instance for further prosecution and apportionment of costs.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The opposed patent relates to a label assembly that allows different kinds of identification cards, eg labels for the rear pocket of a ring binder, to be printed with the now commonly employed laser or ink jet printers. To achieve this a structure is disclosed comprising in this sequence a support sheet, an adhesive coating, a release coating and a printing sheet from which the individual labels are formed. In contrast with the well known printable self-adhesive labels in which the adhesive coating remains on the label, no traces of adhesive should be left on the present labels when removed from the support. This is achieved by a release coating which is applied to the rear side of the printing sheet. When the labels are removed from the support sheet two different objects thus remain: the labels with the release coating on

their back and the support sheet with the adhesive coating on its front (cf column 2, lines 36 to 48 and the Figures).

The problems that arise due to the use of a dry adhesive when printing in a laser printer are also addressed in the patent. The heat generated in the laser printer while printing the labels ruins the conventional dry adhesives and the individual labels loosen from the support causing eg misprints. To overcome this problem the patent proposes the use of a water based, non-heat curable adhesive (cf column 1, lines 19 to 39 and column 3, lines 40 to 48).

3. *Main request - Novelty with respect to documents D8 to D10*

3.1 Document D8

3.1.1 Document D8 belongs to the state of the art under Article 54(3) EPC for the Contracting States DE, FR, GB and NL and is, therefore, relevant only for assessing the novelty of the label assembly according to claim 1 of the opposed patent.

3.1.2 The opposition division found in their decision that this document did not disclose (i) that the support sheet was made of paper material, (ii) that the printing sheet was divided into individual labels and (iii) that the paper printing sheet was provided with a release coating.

3.1.3 The appellant opponent argued in the statement of grounds of appeal that document D8 disclosed that the

sheet 27 (ie the support sheet) had substantially the same **configuration** and dimensions as sheet 11 (ie the printing sheet) (cf column 4, lines 12 to 14) and that therefore the same material was used for both sheets. In his view, the term "same configuration" should be interpreted as meaning the same construction and structure.

3.1.4 The board is not persuaded by the appellant's argument and considers that document D8 only discloses that both sheets have substantially the same shape and dimensions and is silent about the composition of the support sheet. The appellant opponent has not adduced any evidence to substantiate his interpretation of the term "same configuration"; nor has the board found any dictionary definition which would lend credence to the view that anything other than external shape, figure or arrangement was meant.

3.1.5 Although the fact that document D8 does not specify the material of the support sheet is in itself sufficient to establish novelty of the label assembly according to claim 1 of the opposed patent, the board is also of the view that the identification card 19 which is printed with the form disclosed in document D8 is not an individual label obtained from dividing the printing sheet, but a different object which is attached to the open area 22, since document D8 discloses that the card 19 may be made of paper, plastic or other synthetic material while the printing sheet is made of paper material (cf column 3, lines 54 to 55).

3.2 Document D9

3.2.1 Document D9 is a German utility model which bases its priority date on a CEBIT trade fair which took place in Hannover (Ausstellungspriorität) before the priority date of the opposed patent.

3.2.2 According to the appellant opponent, the fact that document D9 claimed the priority of the trade fair established that the label assembly described in this document was made available to the public at the date of the trade fair and that it belonged therefore to the state of the art under Article 54(2) EPC.

3.2.3 The board, however, considers that there is no evidence on file proving that the assembly exhibited at the CEBIT trade fair and that described in document D9 were the same, so that a mere statement in D9 claiming priority from the CEBIT exhibition does not establish that the label assembly disclosed in D9 was in fact exhibited at the CEBIT trade fair before the priority date of the opposed patent, since it is not uncommon that subject-matter be added or deleted in a patent or utility model although a priority date has been invoked.

3.2.4 For these reasons, the board confirms the finding of the opposition division that it has not been proven that the label assembly described in document D9 was made available to the public before the priority date of the opposed patent.

3.3 Document D10

3.3.1 Although the opposition division considered that this document disclosed that the support sheet was made of paper material (cf point 4.1 of the contested decision), the board is of the view that the passage referred to, ie column 5, lines 31 to 34, merely discloses that the support sheet is joined to a sheet of paper material by a releasable adhesive, but not that it is made of such material. Document D10 is silent on the composition of the support sheet.

3.3.2 The board is not persuaded by the appellant's argument that a release coating is implicitly disclosed in document D10 by the indication that the labels 3 can be removed from the support sheet 2 without leaving any trace of adhesive on them (cf column 3, lines 14 to 16), as this is achieved by a particular selection of adhesive material (cf column 3, lines 30 to 33).

3.3.3 On the other hand, the self-adhesive label assembly mentioned in document D10 as forming part of the prior art does not comprise a release coating, but consists merely of labels which are joined by an adhesive to a support sheet (cf column 1, lines 38 to 48). A kinematic inversion of this conventional label assembly results therefore in an assembly equivalent to the one disclosed in document D10, but fails to destroy the novelty of the use of a release coating.

3.4 The board, for the reasons set out above, judges that the label assembly according to claim 1 is new having regard to the disclosures of documents D8 to D10.

4. *Main request - Inventive step considering document D10 as closest prior art*

4.1 The appellant has essentially argued that it would be obvious for a skilled person to provide a release coating on the rear side of the label assembly disclosed in document D10, as the use of release coatings was a standard measure used in the prior art.

4.2 The respondent contends that document D10 discloses that in case the labels 3 were to be printed on both sides they should either be printed on the rear side prior to attaching them to the support sheet or that they could be printed on the rear side by simply flipping them over, attaching them again to the support sheet and repeating the printing process (cf column 7, lines 25 to 40). This would, however, not be possible if a release coating, usually a silicon based material, was applied on the card's rear surface as this makes printing on it nearly impossible. For this reason, he contends that document D10 leads away from using a release coating on the rear side of the labels.

4.3 The board agrees with the respondent that the label assembly disclosed in document D10 is not intended for use with a release coating. In particular, great attention is paid in this document to the proper selection of the adhesive so that the labels can be removed without leaving traces of adhesive on them. In consequence, the use of a release coating in the label assembly of document D10 would contradict the teaching of this document.

4.4 In the judgement of the board the label assembly according to claim 1 involves an inventive step in the sense of Article 56 EPC when starting from document D10 as closest prior art.

5. *Documents D15 to D18*

5.1 Documents D15 to D18 were submitted by the appellant opponent one month before the date of oral proceedings before the board, ie at a very late stage of the procedure.

5.2 This appeal was filed on 19 March 2003, viz before the amended Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2003, 89) came into force on 1 May 2003. According to Article 2 of the decision of the Presidium of 28 October 2002 (OJ EPO 2003, 67) Articles 10a, 10b, 10c and 11a(1)(a) RPBA apply only to proceedings in which the notice of appeal was received by the EPO after 1 May 2003. The established jurisprudence at the filing date of this appeal was that a new document filed at such a late stage in the procedure could be admitted if it manifestly jeopardized the maintenance of the patent (cf Case law of the Boards of Appeal, 4th edition 2001, VI.F).

5.3 The board considers that in the present case at least document D15 meets this high hurdle and should therefore be admitted into the procedure. This has, however, the concomitant effect of altering in a fundamental manner the factual framework of the case under appeal compared with that upon which the decision of the opposition division had been based and which the respondent proprietor had been prepared to deal with.

The board therefore judges that a remittal to the department of first instance for further prosecution as requested by the respondent proprietor and not opposed by the appellant opponent is justified. This has the twofold purpose of allowing this fresh case to be examined at two levels of jurisdiction and of giving the respondent proprietor a reasonable opportunity to consider possible fallback amendments and possible evidence that could be produced in defence of such amended requests.

6. *Apportionment of costs*

- 6.1 The respondent proprietor has requested apportionment of costs under Article 104(1) and Rule 63(1) EPC, as the remittal of the case and its further prosecution will generate costs for which he cannot be held accountable; however no additional costs have been incurred yet by the parties which would justify such an order.



**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

Registrar:

Chair:

P. Cremona

R. G. O'Connell