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D E C I S I O N
of 6 April 2006

Case Number: T 1015/04 - 3.3.09

Application Number: 93306611.0

Publication Number: 0585076

IPC: C09J 7/02

Language of the proceedings: EN

Title of invention:

Adhesive tape

Patentee:

P.P. PAYNE LTD

Opponent:

GIESECKE & DEVRIENT GmbH
DE LA RUE INTERNATIONAL LIMITED
Wipak Walsrode GmbH & Co. KG

Headword:

-

Relevant legal provisions:

EPC Art. 56

Keyword:

"Main and first auxiliary requests: inventive step - no"
"Second auxiliary request: not admissible (late filed)"

Decisions cited:

-

Catchword:

-



Case Number: T 1015/04 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 6 April 2006

Appellant:

(Patent Proprietor)

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 July 2004
revoking European patent No. 0585076 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Kitzmantel
Members: A. T. Liu
W. Sekretaruk

Summary of Facts and Submissions

- I. Against European patent No. 585 076, granted with a set of 11 claims, four notices of opposition were filed on the grounds of Articles 100 (a), (b) and (c) EPC.
- II. At the conclusion of the oral proceedings on 18 May 2004, the opposition division held that the subject-matter of Claim 1 as granted (main request), and that of Claim 1 as amended according to the then operative sole auxiliary request, lacked an inventive step, and revoked the patent. The reasons for the revocation were given in the written decision dispatched on 2 July 2004.
- III. A notice of appeal was lodged by the patentee on 11 August 2004. With the Statement of the grounds of appeal dated 11 November 2004, the appellant submitted new claims as bases for its main and first auxiliary requests.
- IV. By letter of 9 March 2006, the respondent 04 (Wipak Walsrode GmbH & Co. KG) filed a statutory declaration ("Eidesstattliche Erklärung") by M. Koppers, dated 8 March 2006.
- V. The opposition by respondent 01 (Leonhard Kurz GmbH & Co. KG) was withdrawn by letter dated 5 April 2006.
- VI. Oral proceedings took place on 6 April 2006 in the absence of the respondent 03 (De La Rue International Limited), who had been duly summoned but indicated by letter dated 19 January 2006 that it would not be represented at these proceedings. At the end of these proceedings, the appellant submitted a further amended

Claim 1 as basis for a second auxiliary request, allegedly prompted by the afore-mentioned declaration of Mr. Koppers.

VII. Claim 1 of the main request reads as follows:

"1. A tape for applying to a substrate to attach a hologram to the substrate, which tape comprises an oriented base film of thermoplastic plastics material, the base film having on one surface a coating of pressure sensitive adhesive composition, and having on another surface a coating of release agent, characterised in that the tape further comprises a hologram between the base film and the pressure sensitive adhesive composition."

VIII. The text of Claim 1 of the first auxiliary request corresponds to that of Claim 1 of the main request, and contains in addition the stipulation:

"... the hologram comprising an embossed coating of embossing lacquer on the base film and a coating of aluminium on the embossing lacquer."

IX. Claim 1 of the second auxiliary request reads as follows:

"A tear tape for applying to a substrate to attach a hologram to the substrate, which tape comprises an oriented base film of thermoplastic plastics material, coated on one surface with transparent pressure sensitive adhesive composition and on another surface with release agent;

characterised in that the tape includes a security device in the form of a hologram, wherein said one surface of the base film has a coat of primer, over which is an embossed coat of embossing lacquer, over which is a coat of aluminium, over which is a coat of primer, over which is the coat of pressure sensitive adhesive."

X. Of the prior art documents cited in the course of the proceedings, reference will be made to the following in the present decision:

D1: GB-A-2 211 760

D2: EP-A-0 121 371

D12: WO-A-91/18377

XI. The appellant's arguments on inventive step can be summarised as follows:

- Document D2, directed to a tape comprising printed matter, represented the closest prior art.
- The technical problem to be solved with respect to D2 was the provision of a tape for applying security devices to goods and like articles.
- The solution proposed, namely the incorporation of a hologram between the base film and the pressure sensitive adhesive, was not derivable from the available prior art.
- There was no mention of a hologram in D2.
- In D2, two options for printing were described as viable, ie printing the image either on the adhesive-side of the tape or on its release-agent side. Thus, the location of the hologram as in Claim 1 additionally represented an inventive selection from

these alternatives. This was especially not obvious in view of the prejudice against the solvent-coating of a hologram with a pressure sensitive adhesive, as could be seen from D12.

- None of the other prior teachings was suitable for being combined with that of D2.

XII. In the discussion of inventive step, the respondents essentially argued as follows:

- The incorporation of a hologram as a security device was common in the art at the filing date of the patent in suit, as stated for example in D1 and D12.
- In view of D2, the positioning of the hologram between the base film and the pressure sensitive adhesive was the result of routine variations and was all the more obvious since it corresponded to the preferred embodiment of this document.
- The structure of the hologram as defined in Claim 1 of the first auxiliary request was trivial.
- D12 could not be construed teaching away from a positioning of the hologram according to Claim 1.
- Claim 1 of the second auxiliary request was not a combination of existing claims but had been amended to include features taken from the description. The examination of this new subject-matter as to its patentability would require an additional search. This request therefore should not be admitted into the proceedings at this late stage.

XIII. The appellant (patentee) requested that the decision under appeal be set aside and the patent be maintained with the claims of the main request or, alternatively,

with the claims of the auxiliary request 1, both filed with the Statement of the grounds of appeal, or alternatively, with the claims of the second auxiliary request filed during the oral proceedings.

The respondents requested that the appeal be dismissed.

Reasons for the Decision

Main request

1. *Inventive step*

1.1 Claim 1 is directed to a tape comprising a base film with a coating of release agent on one surface and a coating of pressure sensitive adhesive composition on the other. Furthermore, the tape comprises a hologram located between the base film and the pressure sensitive adhesive composition (see point VII above).

1.2 Closest prior art

The board accepts the appellant's submission that the subject of the patent in suit is generally the kind of tape that can be produced in the form of traverse wound reels (see patent in suit, column 4, paragraph [0018]). In consequence, the board concurs with the parties that D2, which relates to the same type of tape, should be considered to comprise the closest prior art teaching (see D2, page 4, lines 26 to 29; D2 even being referred to in the patent in suit, paragraph [0016], bridging columns 3 and 4).

D2 discloses tear tapes formed from an oriented thermoplastic base film (page 3, lines 3 to 8). The base film is printed and the printed matter coated with a pressure sensitive adhesive composition; the non-printed surface of the base film is coated with a release agent (page 4, lines 3 to 14 ; Example 1, page 10, lines 28 to 29 and Example 2, page 11, lines 34 to 36). It is self-evident that the purpose of the printed matter is to convey information and this is even emphasised on page 4, lines 22 to 23: "The matter printed can be either decorative or informative".

1.3 Problem / Solution

It is common ground that, with respect to D2, the technical problem to be solved is the provision of an alternative tape for applying specific information to goods and like articles. This technical problem is solved, according to Claim 1, by the provision of a tape which differs from that of D2 only by substituting a hologram, ie a specific tamper-proof information carrier, for the printed matter. The information character of a hologram is emphasized in D1 by the use of the expression "holographic information" (page 1, lines 7 and 17).

It is undisputed that the tape as claimed can be attached onto a substrate and can act as a (tamper-proof) information carrier. In view of this, the present technical problem is effectively solved by the tape according to Claim 1.

1.4 Obviousness

- 1.4.1 As pointed out by the respondents and not refuted by the appellant, the use of holograms for tamper-proof security purposes, eg for cheque guarantee cards and as seals for security pouches for value items, was well known at the priority date of the patent in suit. The related prior art is, for example, referred to in D1, page 1, line 5, to page 2, line 2, and in D12, page 1, line 15, to page 2, line 33. Thus, the use of holograms as tamper-proof information carriers and their use as security devices on substrates to be protected does not need to be derived from a specific document but can be considered as part of general common knowledge of the practitioner skilled in the art of applying information to goods.

In the board's judgment, it thus follows that no inventive skill is required to replace the printed information of D2 with holographic information. By doing so, the skilled person will arrive at the subject-matter of Claim 1 in the most straightforward and obvious manner. The claimed process therefore lacks an inventive step in view of D2 in combination with the general common knowledge, as can be seen from D1 or D12 (Article 56 EPC).

- 1.5 The board does not accept the appellant's argument that the location of the hologram as claimed, namely between the base film and the pressure sensitive adhesive composition, is based on an inventive selection out of the two viable possibilities disclosed in D2. The board can agree with the appellant that D2 also discloses the alternative of coating the printed matter

with release agent and coating the other surface of the base layer with pressure sensitive adhesive. However, this is clearly not the alternative preferred in D2, which states that: "In a particular preferred embodiment, the base film is printed in a manner such that the printed matter is right reading ... For example, the printed matter may be printed normally onto a surface of the base film and overcoated with transparent pressure sensitive adhesive composition ... In this way, the printed matter is protected from abrasion and from possible contact with the contents of the package" (page 4, lines 2 to 18). This teaching is also clearly reflected in both examples which serve to illustrate D2's invention (Examples 1 and 2, in particular page 10, lines 25 to 29, and page 11, lines 34 to 36). The selection of the preferred embodiment over a less preferred one is, in the board's judgment, at best a matter of routine variation and not one requiring inventive effort.

- 1.6 Likewise, the board is unable to concur with the appellant who asserted that D12 would expressly teach away from coating holograms with a pressure sensitive adhesive composition. In the passage quoted by the appellant to this effect, it is observed that "A protective polymeric coating ... may be applied to the metallic film 4 before applying a pressure sensitive transfer adhesive 6. The adhesive is not coated on as its solvent or drying would possibly attack the carrier 2 or embossable lacquer 3. Rather the adhesive is transferred already releasably adhered to a release paper (or film) 7 and the two surfaces are brought together under mild pressure of rollers to bond pressure sensitive adhesive 6 firmly and irreversibly

to the metallic film 4" (see page 14, lines 11 to 20). Thus, the quoted passage relates to a particular method for preparing a tamper resistant security seal in which the hologram, comprising the lacquer layer 3 and the metallic layer 4, is coated with a pressure sensitive adhesive layer 6 by transferring a film of this adhesive onto the metallic film of the hologram. As a result, the laminate of D12 comprises a hologram located between the carrier layer 2 and the pressure sensitive adhesive layer 6 (see Figure 1 and Abstract). The board notes that present Claim 1, which is also directed to a tape comprising a hologram positioned between a base film and a pressure sensitive adhesive composition, is not restricted by any method of applying the pressure sensitive coating including the transfer method of D12. In consequence, the board cannot see how the disclosure of D12 could be construed as a prejudice against the positioning of the hologram according to Claim 1.

The appellant's arguments therefore do not alter the board's above finding of lack of inventive step (see item 1.4 above).

First auxiliary request

2. Claim 1 of the first auxiliary request, compared with Claim 1 of the main request, contains additional features to define the hologram as "comprising an embossed coating of embossing lacquer on the base film and a coating of aluminium on the embossing lacquer". However, as pointed out by the respondents and not refuted by the appellant, this definition corresponds to the structure of state of the art holograms (see for

example D1, page 5, lines 9 to 19). Furthermore, the appellant has not submitted and the board has no reason for assuming that these additional features interact with the remaining technical features of the claim in any particular, unexpected way. In consequence, the finding of lack of inventive step regarding the subject-matter of Claim 1 of the main request applies *mutatis mutandis* to that of Claim 1 of the present request.

Second auxiliary request

3. *Admissibility*

- 3.1 The board notes that the statutory declaration by Mr. Koppers was received 9 March 2006. According to the accompanying submission of respondent 04, this declaration was also transmitted to the appellant by facsimile on the same day. Since there is no observation to the contrary on file, it is legitimate to assume that the declaration was also received by the appellant on 9 March 2006. Thus, if the filing of a new request had been considered necessary in view of the content of this declaration, the appellant still had nearly one month before the date of the oral proceedings to do so. Furthermore, the appellant had been notified of the letter dated 19 January 2006 in which respondent 03 indicated its intention not to attend the oral proceedings (see official communication of 30 January 2006). Submitting new claim requests at the oral proceedings thus deprives this party of the opportunity of comment.

3.2 Further to the timing of the filing, it is undisputed that Claim 1 of the second request is not just a combination of existing claims but contains further features taken from the description, namely that the base film and the coat of aluminium have coats of primer (see item IX above). Since a finding on inventive step would be essentially based on these additional technical features, the case would have to be stayed in order to give the respondents the opportunity to consider this unexpected development, including the possibility of an additional search for documents directed to this particular aspect.

3.3 Considering the right of all parties to a fair procedure and in the interests of procedural economy, the board therefore decides not to admit the second auxiliary request into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

G. Röhn

P. Kitzmantel