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D E C I S I O N
of 21 April 2006

Case Number: T 0681/05 - 3.2.04

Application Number: 02759163.5

Publication Number: 1424923

IPC: A47G 1/17

Language of the proceedings: EN

Title of invention:

Stretch releasing adhesive tape article with flexible cover

Applicant:

3M Innovative Properties Company

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 54(1), (2), 113(1), 123(2)

EPC R. 68(2)

RPBA Art. 10

Keyword:

"Novelty - yes"

"Remittal for further prosecution"

"Substantial procedural violation - decision not reasoned -
essential reasoning"

"Reimbursement of the appeal fee - yes"

Decisions cited:

G 0010/93, T 0951/92, T 0740/93

Catchword:

-



Case Number: T 0681/05 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 21 April 2006

Appellant: 3M Innovative Properties Company
3M Center
P.O. Box 33427
St. Paul
MN 55133-3427 (US)

Representative: Hilleringmann Jochen, Dipl.-Ing.
Von Kreisler Selting Werner
Bahnhofsvorplatz 1
Deichmannhaus
D-50667 Köln (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 14 December 2004
refusing European application No. 02759163.5
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: M. Poock
C. Heath

Summary of Facts and Submissions

I. This appeal is directed against the decision of the examining division posted 14 December 2004 in which European patent application No. 02 759 163, published under the international publication No. WO 03/022107, was refused.

The appeal was lodged on 17 February 2005 and the prescribed appeal fee was paid simultaneously. The statement of grounds of appeal was received on 14 April 2005.

II. The examining division held that the subject-matter of claim 1 is not new having regard to documents DE-A-19 632 182 (D1) or WO-A-0 134 717 (D2).

III. The relevant first instance file history can be summarized as follows:

(a) In a first communication of the examining division dated 4 June 2004, the subject-matter of claim 1 was found to lack novelty having regard to documents D1 or D2. More particularly, the decision noted that just as the cover portion of claim 1, also D1's "cover portion 12 (*including a film hinge*) is more flexible than the base plate first portion".

(b) On 14 October 2004, the applicant filed an amended set of claims, contested the examiner's view on novelty and argued that "D1 fails to teach that the cover portion 12 is more flexible than the first portion" because the film hinge cannot make

the cover portion more flexible than the first portion.

(c) In the decision under appeal, it is further specified that the cover portion 12 of D1 "is more flexible than said base plate first portion (because the cover portion 12 includes a flexible film hinge, and also because the base plate first portion is stiffened by collar 8, 8A, see Figure 5)".

IV. The appellant (applicant) requested that the decision under appeal be set aside and the case be remitted to the examining division for completing the examining and granting procedure on the basis of the following documents:

Claims: 1 to 9 as filed with letter of
11 October 2005;
Description: pages 1, 1a, 2, 5, 7, 8 as filed with
letter of 14 October 2004,
pages 3, 4, 6, 9 to 11 as published;
Drawings: 1/5 to 5/5 as published.

Moreover, the appellant requested that the appeal fee be reimbursed.

V. The appellant argues that the subject-matter of claim 1 is new and takes the view that in the decision under appeal **"there is absolutely no discussion why the objections and arguments submitted by the Applicants in response to the first Communication are not convincing"**.

VI. Claim 1 as filed with letter of 11 October 2005 reads as follows:

"A stretch releasing adhesive tape article (402,502) to be mounted on a substrate using a stretch releasing adhesive tape strip (404; 504;604) having an adhesive portion (506;606) and a non-adhesive pull tab (212;412;512;612) said article comprising a unitary attachment member (218;518;618) including a base plate portion (220;420;520;620) to overlay said tape strip (404;504;604), said base plate portion (220;420;520;620) including a first portion (224;424;524;624) overlaying said tape strip adhesive portion (506;606) and a flexible cover portion (226;426;526;626) overlaying said tape strip non-adhesive pull tab (212;412;512;612), whereby a user can manually urge said cover portion (226;426;526;626) away from said pull tab (212;412;512;612), thereby allowing the user to stretch remove said tape strip (404;504;604) from said unitary attachment member (218;518;618) and the substrate, and wherein said cover portion (226;426;526;626) is more flexible than said base plate first portion (224;424;524;624), characterized in that said base plate first portion (224;424;524;624) is formed of a first material and said cover portion (226;426;526;626) is formed of a second material, said second material having a flexibility greater than said first material."

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and with Rules 1(1) and 64(b) EPC and is therefore admissible.

2. *Amendments*

The characterising feature of claim 1 was added in the appeal proceedings. Since this amendment is based on claim 7 as originally filed, it does not contravene the requirements of Article 123(2) EPC.

3. *Novelty*

3.1 D1 discloses a stretch releasing adhesive tape article (see for example figures 4 to 6 and 13 to 16) to be mounted on a substrate using a stretch releasing adhesive tape strip having an adhesive portion 1 and a non-adhesive pull tab 2. This article comprises a unitary attachment member 9 including a base plate portion to overlay the tape strip. The base plate portion includes a first portion overlaying the tape strip adhesive portion 1 and a flexible cover portion 12 overlaying said tape strip non-adhesive pull tab, whereby a user can manually urge said cover portion 12 away from said pull tab 2, thereby allowing the user to stretch-remove said tape strip from said unitary attachment member 9 and the substrate.

The attachment member 9 of D1 is injection moulded (see col. 4, lines 33-41) to form a first portion and a collar of the same material so that the flexibility of the first portion is also determined by the collar and

cannot be considered in isolation from the collar. The form of the collar has the effect that the base plate's first portion is stiffer than its cover portion, i.e. in the wording of claim 1, the cover portion is more flexible than the base plate first portion.

3.2 However, neither D1 nor D2 discloses the characterising features of claim 1.

3.3 The subject-matter of claim 1 is, therefore, new over the disclosure of documents D1 and D2 (Article 54(1), (2) EPC).

4. *Remittal to the first instance*

The amended claims clearly meet the objections on which the decision relied.

Under these circumstances, the board considers it appropriate to exercise its discretion under Article 111(1), second sentence, second alternative EPC to remit the case to the examining division for further prosecution, in particular to examine the novelty of the subject-matter of claim 1 with respect to the remaining prior art and its inventive step.

In this respect the board draws the first instance's attention to the fact that in claim 1 a comma is missing after the first mention of "(212;412;512;612)".

5. *Reimbursement of the appeal fee*

5.1 According to Article 113(1) EPC, the decisions of the European Patent Office may only be based on grounds on

which the parties concerned have had an opportunity to present their comments. In this context, the word "grounds" should be interpreted as referring to the essential reasoning, both legal and factual, which leads to the refusal of the application (see T 951/92, point 3, (v), OJ EPO 1996, 53).

- 5.1.1 In the decision under appeal, it is stated that the feature of claim 1 that the cover portion 12 is more flexible than the base plate first portion is known from D1 because "the cover portion 12 includes a flexible film hinge" (reason a), and also because "the base plate first portion is stiffened by collar 8, 8A see Fig. 5" (reason b).

Reason b was communicated to the appellant only with the decision.

- 5.1.2 The board takes the view that the above two reasons are both essential parts of the decision's reasoning because they relate to different parts of D1's attachment member 9. Since reason b was not communicated to the appellant (applicant) before the decision was issued, it was not clearly informed of every ground on which the finding of non-compliance was based (see T 951/92, point 3, (v), supra). Thus, the appellant has not had the opportunity to present its comments.

- 5.1.3 The board therefore concludes that the requirements of Article 113(1) EPC are not met, failure of which amounts to a substantial procedural violation.

5.2 According to the first sentence of Rule 68(2) EPC, the decisions of the European Patent Office which are open to appeal shall be reasoned.

5.2.1 In this respect, the board accepts that "reasoned" does not mean that every argument whatsoever submitted by the applicant should be dealt with in detail, but it is a general principle of good faith and fair proceedings that reasoned decisions contain, in addition to the logical chain of facts and reasons, at least some motivation on crucial points of dispute insofar as this is not already apparent from other reasons given (see for example T 740/93, point 5.4, not published in OJ EPO).

This ensures that the party concerned has a fair idea of why its submissions were not considered convincing so that it can react accordingly. It also ensures that the board can examine the contested decision, as is its primary purpose in appeal proceedings (see G 010/93, point 4, OJ EPO 1995, 172).

5.2.2 In the present case, one of the crucial points in dispute was whether the film hinge of D1 can make the cover portion 12 more flexible than the base plate first portion or not. Nevertheless, the decision merely repeats the examiner's statement in the first communication, i.e. "Said cover 12 is more flexible than the first portion (because the cover portion 12 includes a flexible film hinge ...)" and does not specify at all why the applicant's submissions were not considered convincing. Thus, the decision does not contain any motivation on this crucial point of dispute.

5.2.3 The board therefore concludes that the decision was not sufficiently reasoned contrary to the requirements of Rule 68(2) EPC which amounts to a substantial procedural violation.

5.3 The appeal being allowable, the board considers it to be equitable by reason of the above substantial procedural violations to reimburse the appeal fee according to Rule 67 EPC.

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.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte