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**Datasheet for the decision
of 9 May 2017**

Case Number: T 1229/12 - 3.2.05

Application Number: 98932589.9

Publication Number: 0933183

IPC: B29C45/14

Language of the proceedings: EN

Title of invention:

Sheet for molded-in foil decoration and method of producing
molded resin having molded-in foil decoration by using the
sheet

Patent Proprietor:

Nissha Printing Co., Ltd.

Opponent:

Leonhard Kurz Stiftung & Co. KG

Relevant legal provisions:

EPC 1973 Art. 56, 116(1)

Keyword:

No longer a need for holding oral proceedings
Inventive step - no



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Case Number: T 1229/12 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 9 May 2017

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Decision under appeal: **Interlocutory decision of the opposition division of the European Patent Office posted on 27 March 2012 concerning maintenance of the European Patent No. 0933183 in amended form.**

Composition of the Board:

Chairman M. Poock
Members: H. Schram
 D. Rogers

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the interlocutory decision of the opposition division posted on 27 March 2012 concerning the maintenance of European patent Nr. 0 933 183 in amended form.

The opposition division held that the grounds of opposition under Article 100(a) EPC (lack of novelty, Article 54 EPC, and lack of inventive step, Article 56 EPC) did not prejudice the maintenance of the patent on the basis of claims 1 to 9 filed on the basis of the sole request filed by the respondent (patent proprietor) during the oral proceedings before the opposition division held on 1 February 2012.

- II. In a communication dated 27 February 2017 pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal issued in preparation for the oral proceedings scheduled for 19 May 2017, the board stated its preliminary view that the the subject-matter of claim 1 of the respondent's main request did not seem to involve an inventive step and that it was unlikely that the respondent's auxiliary requests 1 and 2 would be admitted into the proceedings.

- III. Neither party filed any substantive response to the board's communication. The respondent informed the board on 27 March 2017 that it would not attend the oral proceedings. Subsequently, the scheduled oral proceedings were cancelled by the board.

- IV. The documents referred to in this decision include the following:

D3 JP 09300397 A (Patent Abstracts of Japan, computer translation in English);

D3Ü Full translation of document D3 in English.

- V. The appellant requested that the decision under appeal be set aside and that the patent in suit be revoked.

The respondent requested that the appeal be dismissed (main request), or alternatively that the decision under appeal be set aside and that the patent be maintained upon the basis of auxiliary requests 1 or 2, filed under cover of a letter dated 18 September 2012.

Both parties requested as an auxiliary measure that oral proceedings be appointed.

- VI. Claim 1 of the main request reads as follows:

"A foil-decorated resin molded article comprising a foil-decorating sheet (4) integrally bonded to a surface of a molding resin (10), the sheet being in the form of a laminate comprising a transparent acrylic film (1), a bonding surface-side film (3), and a decorative layer (2) formed between the acrylic film (1) and the bonding surface-side film (3), which is on a side of a surface to be bonded to the molding resin, at least a part of the decorative layer being formed from a base layer (15), the bonding surface side film (3) and the molding resin comprising component resins which are identical or similar, wherein the bonding surface-side film (3) is a polypropylene film or an acrylonitrile butadienestyrene film and the bonding surface-side film (3) has a peel strength of not less than 1 kgf/inch (1kgf/2.54 cm) width at an interface with the molding resin,

characterised in that either:

- (i) the laminate further comprises a coloured layer (16) between the decorative layer (2) and the bonding surface-side film (3), or
- (ii) the bonding surface-side film (3) is a coloured film (17), the base layer (15) being substantially isochromatic with the coloured layer (16) or the coloured film (17)."

Reasons for the Decision

1. The appeal is admissible.

PROCEDURAL ISSUES

2. *Need for appointing oral proceedings - no*

Article 116(1) EPC 1973 stipulates that oral proceedings shall take place either at the instance of the European Patent Office if it considers this to be expedient or at the request of any party to the proceedings.

According to jurisprudence of the boards, the statement of the respondent (see point III) that it will not attend the oral proceedings is tantamount to a withdrawal of its auxiliary request for oral proceedings, see Case Law of the Boards of Appeal of the EPO, 8th edition 2016, III.C.2.3.1, page 562ff.

The appellant also requested that oral proceedings be appointed, should the board intend not to decide in favour of its main request, viz to revoke the patent.

Since the auxiliary request for oral proceedings of the respondent is considered to be withdrawn and the main request of the appellant is granted (see point 6 below), this case can be decided without appointing oral proceedings.

3. *Admittance of auxiliary request 1 and 2*

3.1 With its reply to the appeal the respondent filed auxiliary request 1 and 2.

In principle the reply to the appeal shall contain the respondent's complete case which has to be taken into consideration by the board pursuant to Article 12(2) RPBA. However, it lies in the discretion of the board to refuse requests which are presented for the first time in appeal or were not admitted in the first instance proceedings and which would therefore constitute a fresh case, cf Article 12(4) RPBA.

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the expression "wherein the butadiene content in the acrylonitrile butadienestyrene film is 20 to 50% by weight" has been added at the end of the claim.

Claim 1 of auxiliary request 2 differs from claim 1 of auxiliary request 1 in that the expression "and the thickness of acrylic film (1) is 30 - 700 μm " has been added at the end of the claim.

Auxiliary requests 1 and 2 share the feature "wherein the butadiene content in the acrylonitrile butadienestyrene film is 20 to 50% by weight".

A request containing said feature has not been presented in the first-instance proceedings by the appellant (cf Article 12(4) RPBA), thereby compelling the board either to give a first ruling on this issue or to remit the case to the opposition division, cf Case Law of the Boards of Appeal of the EPO, 8th edition 2016, IV.E.4.3, page 1139ff.). These requests thus represent a fresh case.

In addition the board is of the opinion that varying the butadiene content of the bonding surface-side film in such a way that its elongation behavior matches that of the adjacent acrylic film seems to be obvious to the person in the art, especially since the claimed range of 20 to 50% by weight seems to be known per se in the art.

It may be noticed that a thickness within the range from 30 to 700 μm for acrylic film also seems to be known per se in the art, see for example document D1, page 7, lines 51 to 52, wherein the thickness of the clear coat (see page 9, lines 14 to 40) has a preferred thickness of about 12,7 μm to about 38,1 μm .

- 3.2 The board therefore exercises its power under Article 12(4) RPBA and does not admit auxiliary requests 1 and 2 into the appeal proceedings.

4. *Right of priority*

The patent claims the priority of JP21259897 (22 July 1997) and JP8273998 (13 March 1998).

In the decision under appeal the opposition division held that the patent was not entitled to a priority date earlier than the filing date of the international

application and that document D3 (translated as D3Ü) was comprised in the state of the art according to Article 54(2) EPC, see point 2.3 of the reasons.

Since the respondent (then applicant) already acknowledged during the oral proceedings held before the examining division on 11 October 2007 that the priority was invalid, see point 2.1 of the minutes, there is no need for further substantiation of this matter.

Document D3 therefore forms part of the state of the art according to Article 54(2) EPC 1973.

MAIN REQUEST

5. *Ground for opposition under Article 100(a) EPC 1973 in combination with Articles 54 and 56 EPC 1973*

5.1 In the following table, the enumeration of the features of claim 1 of the set of claims on the basis of which the opposition division intended to maintain the patent (main request), which is identical to claim 1 as granted, corresponds to the feature analysis presented by the appellant in point 1 of the statement of grounds, with the exception that feature f) has been split into features f-i) and f-ii) and in that features h) and i) have been renamed h-i) and h-ii).

Document D3, which is cited in paragraph [0002] of the patent in suit, discloses (see Example 3) a woodgrain pattern molded article with features a) to c), c1) to c4), d), alternative f-ii), alternative h-ii) and j), as follows:

	Claim 1 as maintained	D3Ü; Figures: see D3
a)	A foil-decorated resin molded article	Woodgrain pattern molded article 9, see claim 4 and Figure 4
b)	comprising a foil-decorating sheet (4) integrally bonded to a surface of a molding resin (10),	Acrylic insert film 1 (see Figure 3) integrally bonded to a surface molding material 7, see Figure 4
c)	the sheet being in the form of a laminate comprising	See Figure 3
c1)	a transparent acrylic film (1),	Transparent acryl film 2, see Example 3, paragraph [0060], which refers to Example 1, paragraph [0044]
c2)	a bonding surface-side film (3), and	See Example 3, paragraph [0062]. The pigmented sheet 5, or pigmented layer 6, having the function of an adhesive film, see paragraph [0066], last sentence. In this case the bonding layer 8 may be omitted, see paragraph [0034].
c3)	a decorative layer (2) formed between the acrylic film (1) and the bonding surface-side film (3),	Woodgrain vessel pattern layer 3 with underlayer 4 formed between layers 2 and 6 in Figure 3
c4)	which is on a side of a surface to be bonded to the molding resin,	See Figure 3.
d)	at least a part of the decorative layer being formed from a base layer (15),	See underlayer 4
e)	the bonding surface side film (3) and the molding resin comprising component resins which are identical or similar,	Material of pigmented sheet 5 in Example 3 is (see paragraph [0062]) acrylonitrile butadiene polystyrene, which is identical or similar to the molding resin material 7 of Example 1.
f-i)	wherein the bonding surface-side film (3) is a polypropylene film or	See comment directly below (alternative f-ii)
f-ii)	an acrylonitrile butadienestyrene film and	See paragraph [0062]
g)	the bonding surface-side film (3) has a peel strength of not less than 1 kgf/inch (1kgf/2.54 cm) width at an interface with the molding resin,	Not disclosed
	characterised in that	
h-i)	either: (i) the laminate further comprises a coloured layer (16) between the decorative layer (2) and the bonding surface-side film (3),	See comment directly below (alternative h-ii)
h-ii)	or (ii) the bonding surface-side film (3) is a coloured film (17),	Pigmented layer 5 is a "coloured film"
j)	the base layer (15) being substantially isochromatic with the coloured layer (16) or the coloured film (17).	See page 8, lines 1 and 2

Document D3 does not disclose feature e) or g).

The material of pigmented sheet 5 in Example 3 is acrylonitrile butadiene polystyrene, see paragraph

[0062]. Whilst document D3 does not mention *expressis verbis* the kind of molding resins in Example 2 (cf paragraphs [0051] to [0059]) or Example 3 (cf paragraphs [0060] to [0068]), paragraphs [0058] and [0067] suggest that in Examples 2 and 3 the same molding resin is being used as the one in Example 1, namely an acrylonitrile butadiene polystyrene copolymer resin, cf Example 1, paragraph [0049].

The board therefore considers it to be obvious to the person skilled in the art, starting from Example 3 of document D3, to use said molding resin.

Claim 1 of the main request requires that "the bonding surface-side film (3) has a peel strength of not less than 1 kgf/inch (1kgf/2.54 cm) width at an interface with the molding resin", see feature g).

On page 4, lines 20 to 23, of the patent in suit, it is stated: "Laminate films which can meet such requirement are such that component resins of such films are identical or similar, for example ... a combination of acrylonitrile butadiene styrene and acrylonitrile styrene, both acrylonitrile copolymers", ie identical or similar to the resin taken for the molding resin, cf feature e).

Since the pigmented sheet 5 of Example 3, namely an acrylonitrile butadiene polystyrene, is identical or similar to said molding resin, feature e) would be met, and in view of the passage cited above, feature g) would also be met. The person skilled in the art would hence arrive at the subject-matter of claim 1 of the main request without the exercise of inventive activity.

- 5.2 Thus the subject-matter of claim 1 of the main request does not involve an inventive step with respect to document D3.

There is hence no need to decide whether an acrylonitrile butadiene polystyrene copolymer resin is clearly and directly derivable from Example 3 of document D3 for the person skilled in the art.

6. It follows that the main request of the respondent is not allowable, as it does not meet the requirements of Article 56 EPC 1973.

Since auxiliary requests 1 and 2 are not admitted into the appeal proceedings, there are no further requests pending.

Order

For these reasons it is decided that:

1. The decision under appeal be set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated