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**Datasheet for the decision
of 2 May 2014**

Case Number: T 1594/12 - 3.2.05
Application Number: 05741319.7
Publication Number: 1749130
IPC: D21F11/02
Language of the proceedings: EN

Title of invention:

Method for producing extensible paper, plant for implementing the method, product obtained by the method, and paper material obtained from the product

Applicant:

Trani, Giorgio
Cartiere Cariolaro S.p.A.

Headword:

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Amendments - added subject-matter (no)
Remittal to the department of first instance

Decisions cited:

Catchword:

-



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1594/12 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 2 May 2014

Appellant: Giorgio Trani
(Applicant 1) Giudecca 671
30100 Venezia (IT)

Appellant: Cartiere Cariolaro S.p.A.
(Applicant 2) Via Provinciale, 45
35010 Carmignano di Brenta (IT)

Representative: Paolo Piovesana
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Decision under appeal: **Decision of the examining division of the
European Patent Office posted on 3 February 2012
refusing European patent application No.
05741319.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: M. Poock
Members: H. Schram
G. Weiss

Summary of Facts and Submissions

I. The appellants (applicants) filed a notice of appeal on 23 March 2012 against the decision of the examining division, posted on 3 February 2012, by which European patent application No. 05 741 319.7 was refused on the grounds that the amendments to claim 1 of its sole request filed on 27 March 2008 introduced subject-matter extending beyond the contents of the application as filed, Article 123(2) EPC. The appeal fee was paid on 26 March 2012. The statement of grounds was filed in Italian on 8 June 2012, a translation in English was filed on 25 June 2012.

II. The appellants requested that the decision under appeal be set aside and that the case be remitted to the examining division on the basis of the set of claims filed on 24 April 2014 in response to the communication of the board dated 17 April 2014.

III. Claims 1 and 4 of the sole request of the appellant read as follows:

"1. A method for producing substantially smooth extensible paper having a degree of smoothness less than 3000 ml/min according to the Bendtsen scale comprising the step of passing the paper web on the production line between at least one pair of rollers, of which one is of soft material driven at lesser speed and one is of hard material driven at greater speed, characterized in that the hard material roller presents a base roughness R_a of less than 5 μm and comprises, in its entire lateral surface, incisions having the following parameters:
distance A between adjacent incisions: 0.10 – 40 mm
width B of each incision: 0.02 – 2 mm

depth C of each incision: < 0.1 mm
ratio A/B between distance and width 0.12 – 800
ratio B/C between width and depth 1 – 8."

"4. A plant for implementing the method claimed in claims from 1 to 3, comprising:

- a kneader for the fibre-based mix,
- a refining unit,
- a flow chest,
- a paper web forming station,
- a pressing station,
- a first drying station,
- a compacting station,
- a second drying station,
- a glazing station,

characterised in that the compacting station comprises at least one pair of rollers, one of which is of soft material and is driven at a lower speed than the other roller which is of hard material, this latter presenting a base roughness R_a of less than 5 μm and comprising incisions in its entire lateral surface."

IV. The appellant submitted that the refusal was solely based on the view of the examining division that both the range for the distance A between adjacent incisions, viz 0.24 – 16 mm, and the upper limit for the width B of each incision, viz 0.8 mm, present in claim 1 filed on 27 March 2008 contravened the requirements of Article 123(2) EPC. Since in the new version of claim 1 the parameter ranges were the same as those originally filed, the case should be remitted to the examining division for further prosecution.

Reasons for the Decision

1. The appeal is admissible.
2. *Allowability of the amendments, Article 123(2) EPC*
 - 2.1 Claim 1 of the sole request differs from claim 1 as originally filed substantially in that the expression "having a degree of smoothness less than 3000 ml/min according to the Bendsten scale comprising the step of" has been added after the words "extensible paper" and in that the expression "a base roughness RA of less than 5" has been replaced by the expression "a base roughness R_a of less than 5 μm ".

The additional feature is, apart from the unit ml/min, disclosed on page 9, line 5 and 6 of the application as filed (published version). The person skilled in the art knows that the unit for the Bendtsen smoothness is [ml/min].

The person skilled in the art also knows that the unit for the base roughness of a hard roller is [μm].

It follows that claim 1 meets the requirements of Article 123(2) EPC.

- 2.2 Claim 4 of the sole request differs from claim 6 as originally filed substantially in that the expression "a base roughness RA of less than 5" has been replaced by the expression "a base roughness R_a of less than 5 μm ".

It follows that claim 4 also meets the requirements of Article 123(2) EPC.

- 2.3 Dependent claims 2, 3, and 5 to 9 correspond to claims 2, 5 and 7 to 11, as originally filed and therefore meet the requirements of Article 123(2) EPC.
3. The examining division has not yet decided whether the application meets all the requirements of the EPC, including the question of inventive step, Article 56 EPC 1973. It is thus considered appropriate to remit the case to the department of first instance for further prosecution, Article 111(1) EPC 1973.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated