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**Datasheet for the decision
of 18 June 2020**

Case Number: T 0770/15 - 3.4.01

Application Number: 04077912.6

Publication Number: 1650697

IPC: G06K7/14

Language of the proceedings: EN

Title of invention:

A method for applying a RFID tag carrying label on an object

Patent Proprietor:

Sato Holdings Kabushiki Kaisha

Opponent:

S+P Samson GmbH

Headword:

RFID Tag / Sato Holdings

Relevant legal provisions:

EPC Art. 54(3), 123(2)

Keyword:

Novelty - (no)

Amendments - allowable (no)



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0770/15 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 18 June 2020

Appellant: Sato Holdings Kabushiki Kaisha
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
3 February 2015 concerning maintenance of the
European Patent No. 1650697 in amended form.**

Composition of the Board:

Chairman P. Scriven
Members: T. Alecu
R. Winkelhofer

Summary of Facts and Submissions

- I. The proprietor appealed the Opposition Division's decision to maintain European patent EP B 1650697 in amended form.
- II. The opponent had requested revocation of the patent on the grounds of Articles 100(a), 100(b) and 100(c) EPC, but did not appeal the decision.
- III. The opponent cited the following documents in the opposition proceedings:
 - E1: EP A 1632926
 - E2: DE 1007142
 - E3: US A 5838253
 - E4: WO 00/54216
- IV. Document E1 is prior art according to Article 54(3) EPC. The other documents are prior art according to Article 54(2) EPC.
- V. The Opposition Division maintained the patent in the form according to the third auxiliary request. The main request and the first auxiliary request were rejected for lack of novelty of claim 1 in comparison with E1. The second auxiliary request was rejected for lack of compliance of claim 1 with the provisions of Article 123(2) EPC.
- VI. The appellant requested that the decision be set aside, and (main request) that the opposition be rejected, or that the patent be maintained on the basis of one of

auxiliary requests 1 or 2 as submitted during the opposition proceedings.

- VII. The opponent requested that the appeal be dismissed. They supported the grounds of the impugned decision, added that E3 took away novelty of at least claims 5 and 6 of the main and first auxiliary requests, and also maintained objections regarding inventive step starting from E2 for both the main and the first auxiliary request.
- VIII. In a communication under Article 15(1) RPBA, the Board indicated its provisional opinion that the decision of the Opposition Division was correct, and concurred with the respondent's objection based on E3.
- IX. Oral proceedings before the Board took place on 18 June 2020.
- X. The parties' submissions, in so far as relevant to the Board's decision, are given in detail in the Reasons, below.
- XI. Claim 1 of the main request reads:

A method for applying a RFID (Radio Frequency Identification) tag (7) carrying label (2) on an object (1), said tag (7) comprising an antenna connected to an integrated circuit including a receiver and a transmitter, said label (2) being provided with a self-adhesive layer (6), said tag (7) being applied on said label (2), which label (2) is adhered to said object (1), in such a manner that the tag (7) is offset from a volume enclosed by said object (1) and forms

a freely extending protrusion with respect to said volume, whereby said protrusion may extend in whatever direction with respect to said object (1) and said tag (7) is applied on a side of said label (2) on which said self-adhesive layer (6) is applied, characterised in that said protrusion is formed by a flap obtained by :

- determining on said label (2) a stroke (4) having a surface which is at least equal to the tag surface;*
- applying said tag (7) along and offset from said stroke (4);*
- folding said stroke (4) towards said tag (7); and*
- applying said stroke (4) over said tag (7) in order to cover the latter.*

XII. Claim 1 of auxiliary request 1 is identical to that of the main request except that the formulation *in whatever direction with respect to said object (1)* is replaced by

... parallel to the side of the face of the object (1) on which it is applied or perpendicular thereto or make any other angle between 0° and 180° with this side ...

XIII. Claim 1 of auxiliary request 2 modifies claim 1 of auxiliary request 1 by adding the following text at the end:

... wherein the label (2) is moved over a plate (10), the plate (10) being provided with perforations beyond which a vacuum is

applied and the plate (10) being divided in a plurality of parts (10-1, 10-2, 10-3, 10-4), which are mounted together with hinges (11) in order to pivot among each other.

Reasons for the Decision

Main Request - novelty - introduction

1. The Opposition Division rejected claim 1 as lacking novelty over the embodiment of Figure 1 of E1, described in paragraphs 17 and 18, read together with the teachings of paragraph 13.
2. Document E1 teaches a method of creating a label with a transponder attached to a non-adherent flap, creating a configuration in which the transponder is spaced from the labeled item. This is the same as in the claimed invention, as can be seen from a comparison of Figure 1 of the opposed patent with Figure 1 of E1.
3. As agreed by both parties, novelty hinges on the question of whether E1 teaches the attachment of the transponder on the reverse side of the label of that embodiment. If this was not the case, then the last feature of the claim would not be disclosed, because the tag would not be covered by the stroke.
4. E1 teaches, in paragraph 13, that the transponder is attached on the reverse side, but also states, in paragraph 14, that it is possible to place it on the front side. Paragraphs 17 and 18, describing Figure 1, do not specify where the transponder is placed.

5. The Opposition Division considered, in essence, that paragraphs 17 and 18 should be read as a logical extension of paragraph 13 and concluded that the transponder was placed on the reverse side.

Main request - the appellant's submissions

6. The appellant (proprietor) submitted that it was not possible to combine the teachings of paragraph 13 with those of paragraphs 17 and 18 without hindsight of the invention. They were separate teachings and did not reference one another.
7. Taking the embodiment of Figure 1 by itself, it was never specified that the transponder was on the reverse side. Rather, there were indications that it was on the front side.
8. This was clear in that Figure 1a showed the front side referenced with 2, with the printing areas 8 and 9 shown from the top; the transponder was shown as reference 6. If the transponder were on the reverse side, it would not be visible.
9. Furthermore, the transponder had certain dimensions, which were not negligible. This could be seen in that, for instance, in Figure 2b it was used to create an angle with the package. If it were placed on the reverse side, the flap would not be flat, and the two sides could not adhere to each other, as paragraph 18 required. Also, the skilled person could not place it in close proximity of the line 3, which was what paragraph 18 required. Placing it close to the line had a meaning, which was that the transponder was spaced

from the package, which was an objective of E1.

10. Furthermore, the embodiments of Figure 2 were introduced (paragraph 19) as referring to *other* labels. The difference was precisely that, in these other labels, the transponder was on the reverse side. For Figure 2 this was specified in paragraph 19.
11. Figure 2a showed the reverse face, with the transponder and without the backing sheet. Reference 8 indicated the reverse side of the printing area.
12. Referring to paragraph 13, the appellant submitted that, although this paragraph did teach the formation of a ridge, and the position of the transponder on the reverse side, it was not explained *how* the ridge was formed. This paragraph by itself, therefore, could not anticipate the claimed subject matter. The ridge was otherwise something rigid, which did not correspond to the embodiment of Figure 1. There was no correspondence between the embodiments of Figure 13 and those of Figures 1 and 2. They were different embodiments.
13. To establish a lack of novelty one had to show that the disclosure was clearly there. Whether the skilled person would think of using the information in paragraph 13 in combination with the embodiment of Figure 1 was a matter of inventive step, and E1 could not be used for assessing inventive step.

Main request - the respondent's submissions

14. The respondent (opponent) submitted that the Figures 1 and 2 were consistently drawn, and that they showed, in

the perspective view, the same front side.

15. The transponder was shown not because it was visible, but simply to show where it was placed. This was clear in that, in Figure 2, the transponder could not be visible irrespective of the side shown, because it was sandwiched between the paper and the backing sheet.
16. From the way Figure 2a was drawn above Figure 2b, it was clear that it was the face side which was shown, i.e. the top side of 2b.
17. The same reference signs were used in Figure 1 as well, notably the numeral 8 indicating the printing area. The skilled person would not think that the reference in Figure 2 was to the reverse side of the printing area.
18. But figures aside, reading the text alone was sufficient. Paragraph 13 made it clear that the transponder was on the reverse side. This was the default.
19. The two possibilities in paragraph 13 were exemplified in Figures 1 and 2a/2b. They were consistent with a ridge and a loose flap respectively. The possibility, mentioned in paragraph 14, of placing the transponder on the front, was not exemplified.
20. Paragraphs 17 to 19 should be read in the light of the previous information in paragraph 13. There was no reason for the skilled person to think that the transponder should be on the front in Figure 1. This would require another adhesive, on the front side, which was not mentioned. Paragraph 17 mentioned an adhesive on the reverse side, and stated that the transponder was dispensed. It could only be dispensed

on the previously-mentioned adhesive, i.e. on the back.

21. There was also no reason to think that it could not be dispensed in a close proximity to the line 3, while being on the reverse, if one considered the dimensions drawn in Figure 1.
22. Putting it on the line, on the front, would mean it could easily be peeled off accidentally, which the skilled person would avoid.

Main request - the Board's assessment

23. The disclosure of a prior art document extends only as far as the skilled person would clearly and unambiguously derive from it using their common knowledge.
24. However, *clearly derivable* does not imply *effortlessly derivable*. If, while trying to put the disclosure into practice, the skilled person stumbles upon apparent gaps, they will make the effort to derive, from the context of the disclosure, if that gap is to be filled in a particular way, or not.
 - 24.1 They will read the whole disclosure with a mind seeking to understand and extract the technical information needed. They will favor a technically consistent reading over a self-contradictory one. Simply put, they will try to make sense out of the whole disclosure.
25. In the present case, when implementing the embodiment of Figure 1 of E1, the skilled person would need to decide whether E1 taught that the transponder was to be placed on the front side, on the reverse side, or

either of the two. Only in the first case would the claim be new, because in the last case both options are disclosed.

26. In the Board's view, the only consistent reading of document E1 is the one provided by the respondent. It provides for a correspondence, which the skilled person expects, between the general teaching of paragraph 13 and the two embodiments of Figures 1 and 2, i.e. the ridge and the loose flap, with the transponder on the reverse side. It also explains the drawings by making them consistent in their schematics - Figures 1 and 2a showing the front side and the position of the transponder in "transparency".
27. Regarding the dimensions of the transponder, the text makes no reference to them, and does not explain that they would be important. The skilled person has no reason to believe that it impacts the placement of the transponder.
28. This reading results from an understanding of the specific disclosure of Figure 1 in the context of the overall disclosure and is therefore not a matter of inventive activity, as the appellant has submitted (see paragraph 13, above).
29. The reading of the appellant, wherein the transponder is on the front side, is contradictory. It does not explain why the transponder is shown in the same way in Figures 1 and 2a (one being visible and one not). It does not explain why the printing area 8 is referenced on the reverse side. Most importantly, it is not consistent with the text itself.

30. The default position is indeed the reverse side, as explained in paragraph 13, and placing it on the front side requires modifications, as the opponent argued (also cf. paragraph 14), which are not disclosed in the embodiment of Figure 1.
31. At most, the skilled person might understand that the embodiment of Figure 1 could be modified to also allow the transponder to be placed on the front. But even then, this would not negate that the default placement on the reverse is derivable. It would only mean that the skilled person can also derive a second implementation, i.e. both positions would be disclosed.
32. In conclusion, the skilled person would derive an embodiment with the transponder on the reverse side. It follows that claim 1 is not new in comparison with E1.

Auxiliary request 1 - novelty

33. The appellant argued that the amendment was not to be read as only meaning that the protrusion had a certain angle, but rather so that the protrusion can fold between those angles. This was obvious from paragraphs 5 and 16 of the opposed patent, which explained the need for having the protrusion. The ridge flap of E1 was rigid, and it could be seen that the two bottom sides in Figure 1 did not touch one another, which meant that the flap could not be folded.
34. The respondent conceded that the appellant's claim construction could be legitimate, although the claim was not clear in that respect. But the ridge flap of E1 was also foldable, which was obvious from the fact that it was made out of paper, that it could have

perforations to enhance folding (paragraph 13), and that it was even foldable enough to be used in a standard printing process (paragraph 9).

35. The Board is of the opinion that, even when taking the most favourable claim construction for the appellant, i.e. a foldable protrusion, it must be concluded from the characteristics provided for the fold of E1 that it was also foldable between the recited angles.
36. Consequently, claim 1 of this request also lacks novelty with respect to E1.

Auxiliary request 2 - Article 123(2) EPC

37. The Opposition Division and the respondent were of the opinion that this claim defined an unallowable intermediate generalization. It lacked the features of *keeping the label on the plate, of the parts being successive* and of the *driving means to pivot the parts*, which in the application documents as filed were described together with the other features.
38. The appellant disagreed, stating that the first feature was implied by the presence of the vacuum, that the second was just an example, the important part being that the parts were connected so that they could pivot, and the third was not essential, and in that any type of means could be used to impose the pivoting movements.
39. While the - omission of the first two features might be allowable, at least the driving means are necessary to avoid an extension of subject matter. Without specifying any driving means, the possibility of, for

example, manual action on the hinges is also part of the claimed scope. Such matter is not derivable from the application documents as filed.

40. Hence claim 1 of this request contravenes Article 123(2) EPC.

Conclusion

41. The main request and auxiliary request 1 fail for lack of compliance with Article 56 EPC. Auxiliary request 2 fails for lack of compliance with Article 123(2) EPC. Thus none of the appellant's requests can be allowed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Meyfarth

P. Scriven

Decision electronically authenticated