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**Datasheet for the decision  
of 12 August 2016**

**Case Number:** T 0078/16 - 3.2.07

**Application Number:** 08700234.1

**Publication Number:** 2104573

**IPC:** B05D1/28

**Language of the proceedings:** EN

**Title of invention:**

METHOD AND SYSTEM FOR CONTACTING OF A FLEXIBLE SHEET AND A  
SUBSTRATE

**Applicant:**

Koninklijke Philips N.V.

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2)  
EPC R. 139

**Keyword:**

Amendments - extension beyond the content of the application  
as filed (no)

**Decisions cited:**

G 0003/89, G 0011/91

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
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Case Number: T 0078/16 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 12 August 2016**

**Appellant:**  
(Applicant)

Koninklijke Philips N.V.  
High Tech Campus 5  
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**Representative:**

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**Decision under appeal:**

**Decision of the Examining Division of the  
European Patent Office posted on 19 October 2015  
refusing European patent application No.  
08700234.1 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** H. Meinders  
**Members:** G. Patton  
I. Beckedorf

## Summary of Facts and Submissions

- I. The applicant (appellant) lodged an appeal against the decision to refuse the European patent application No. 08 700 234.1.
- II. The Examining Division held that the subject-matter of claim 1 of the main request extended beyond the content of the application as originally filed pursuant to Article 123(2) EPC and did not admit the then auxiliary request pursuant to Rule 137(3) EPC.
- III. With the statement setting out the grounds of appeal the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request as underlying the impugned decision or, in the alternative, on the basis of a first, second or third auxiliary request, the last corresponding to the auxiliary request underlying the impugned decision.
- IV. Claim 1 of the main request reads as follows (amendments as compared to claim 1 of the application as originally filed are in bold with deletions in strikethrough; emphasis added by the Board; see also impugned decision, point II.2.1):

"Method for contacting of a **stampingsheet** surface **(416)** of a **template stamp (404)**~~flexible sheet~~ and an **exposedfirst contact** surface **(424)** of a **substrate (420)**~~first element~~, comprising the steps of:

a. providing an anchor **(430)** having an anchor surface **(432) for contacting the stamping surface (416)**, the anchor surface **(432)** and the **exposed first contact** surface **(424) of the substrate (420)** having an

adjustable first relative lateral position to each other;

b. using a first contacting process to establish a first **contacting** stage **of the method** wherein at least a first part of the **stampingsheet** surface **(416)** is in contact with at least one of the anchor surface **(432)** and the ~~**exposedfirst contact**~~ surface **(424)** **of the substrate (420)**;

c. while residing in the first stage, determining a first lateral misalignment of the ~~**stampingfirst element**~~ surface **(416)** with respect to ~~**anyat least**~~ one of the surfaces with which the ~~**stampingfirst contact**~~ surface **(416)** is in contact;

d. if the first lateral misalignment exceeds a threshold, establishing a second **contacting** stage **of the method** wherein a part of the **stampingsheet** surface **(416)** is in contact with the anchor surface **(432)**, while no part of the **stampingsheet** surface **(416)** is in contact with the ~~**exposedfirst contact**~~ surface **(424)** **of the substrate**, the second stage being established in such a manner that **at all times between the first and second stages** at least a part of the **stampingsheet** surface is kept in contact with at least one of the anchor surface and the ~~**exposedfirst contact**~~ surface **of the substrate at all times**;

e. while residing in the second stage, adjusting the first relative lateral position to correct for the first lateral misalignment; **and**

f. using a second contacting process to establish a third **contacting** stage **of the method** wherein the **stampingsheet** surface **(416)** is in contact with the

~~exposed first contact~~ surface (424) of the substrate (420), the second contacting process being more accurate than the first contacting process."

In view of the present decision, the wording of the claims 1 of the auxiliary requests is of no importance.

V. The submissions of the appellant with respect to the main request are essentially as follows:

The expression "at all times" of original claim 1 is clarified by the introduction of "between the first and second stages". This amendment is based on the disclosure of the application as originally filed that a contact with the stamping surface starts from the first stage of the first contacting process and lasts till at least the end of the second stage of the first contacting process.

The skilled person will realise that step c. of original claim 1 is erroneous and will directly and unambiguously derive its correction as that the "first element surface" and "first contact surface" should read the "sheet surface".

There is an explicit support in the application as originally filed for the determination of the misalignment of the sheet surface in step c. of claim 1 of the main request with respect to "any one" of the surfaces with which it is in contact.

Claim 1 of the main request does not constitute a novel selection over the original disclosure. The amendments have been made in response to objections, in accordance with the usual practice in the examination proceedings. All essential steps were already present in original

claim 1 so that the objection of "smoke screen" does not hold.

Claim 1 of the main request should then be considered as fulfilling the requirements of Article 123(2) EPC.

## **Reasons for the Decision**

### 1. *Main request*

- 1.1 A basis for amending "sheet surface" and "flexible sheet" into "stamping surface" and "template stamp", respectively, and at the same time, "first contact surface" and "first element" into "exposed surface of the substrate" and "substrate", respectively, is given for instance on page 2, lines 16-18, page 7, lines 18-33 and page 25, line 10.

The embodiments of the application as originally filed also refer to template stamp and substrate, see page 15, lines 12-14 (figures 4A to 4E), page 18, lines 7-11 (figures 5A and 5B), page 19, lines 24-27 (figures 6A and 6B), page 21, lines 1-3 (figure 7) and page 22, lines 15-17 and page 23, line 32 to page 24, line 13 (figures 8 and 9).

A basis for the amendment introduced in step a. of claim 1 that the anchor has an anchor surface "for contacting the stamping surface" is given for instance on page 2, lines 25-27.

The other substantial amendments to claim 1 form the ground for the refusal of the application by the Examining Division and are discussed below.

- 1.2 Feature "between the first and second stage" in step d. of claim 1 (impugned decision, point II.2.1.1)
- 1.2.1 As noted by the Examining Division, step d. of original claim 1 induces a lack of clarity since it is stated that during the second stage no part of the sheet surface is in contact with the first contact surface, while, concurrently, the opposite might also be true due to the expression "at all times" (see communication dated 28 September 2010, point 3, example 1).
- 1.2.2 As explicitly disclosed in the application as originally filed, page 2, lines 25-27, "**in** the second stage" **no** contact between the sheet surface (stamping surface) and the first contact surface (exposed surface of the substrate) is provided. Hence, the expression "at all times" of original claim 1 needs to be clarified to take into account this essential feature of the claimed method (see also page 28, lines 28-33 and figure 4D corresponding to the second stage).
- 1.2.3 The Board concurs with the appellant that the skilled person, based on the disclosure of the application as originally filed, will realise that a contact with the sheet surface (stamp surface) starts from the first stage of the first contacting process and lasts till at least the end of the second stage of the first contacting process.

This is illustrated for instance in figures 4B and 4C, corresponding to the first stage and figure 4D, corresponding to the second stage (page 15, line 5 to page 17, line 25). In fact, the situation at the end of the first stage unambiguously remains unchanged for establishing the second stage, i.e. including between



first and second stages (cf. step b. of original claim 1).

- 1.2.4 As appearing from step d. of original claim 1 there is indeed a distinction between the second stage itself ("wherein...[a second stage]") and the fact of "establishing" said second stage ("the second stage being established"). Hence, "at all times" of original claim 1 covers the first stage, the establishment of the second stage, i.e. to what happens between the first and second stages, and the second stage. The amendment "at all times between the first and second stages" makes then clear that the situation at the end of the first stage is that for establishing the second stage in accordance with the original disclosure (see point 1.2.3 above). It is further in line with point 1.2.2 above and enables to clarify claim 1 (see point 1.1.1 above).

Consequently, even though not literally disclosed, this amendment introduced in step d. of claim 1 of the main request does not contravene Article 123(2) EPC.

- 1.3 Feature "stamping surface" in step c. of claim 1 (impugned decision, point II.2.1.2)
- 1.3.1 According to the impugned decision (see also point 1.1 above), the "first element" of original claim 1 is the "substrate". Hence, there would be no basis in the application as originally filed, in particular not on page 2, lines 23-25, for amending in step c. of original claim 1 the "first element surface" and the "first contact surface" into the "stamping surface", since it should be the "exposed surface of the substrate".

1.3.2 As correctly argued by the appellant, the skilled reader of original claim 1 will understand, in particular in view of the original application taken as a whole, that the first element surface (exposed surface of the substrate) is never in contact with the anchor surface. He will then realize that step c. of original claim 1 is erroneous since it encompasses such an undisclosed and technically meaningless possibility.

In view of the application as originally filed (see page 2, lines 22-25; page 3, lines 15-19; page 5, line 8 to page 6, line 16 and also page 16, lines 3-32 in combination with figures 4B and 4C representing the first stage), the skilled person will directly and immediately derive that the only possible correction is that the "first element surface" and "first contact surface" in step c. of original claim 1 are meant to be the "sheet surface", i.e. the stamping surface.

Consequently, this amendment introduced in step c. of claim 1 of the main request is allowable under Rule 139 EPC. Since the correction is based on the original application, it neither contravenes Article 123(2) EPC (see G 3/89, OJ EPO 1993, 117, and G 11/91, OJ EPO 1993, 125).

1.4 Feature "any one" in step c. of claim 1 (point II.2.1.2)

As correctly put forward by the appellant there is an explicit basis in the application as originally filed, page 5, lines 26-27, for determining the misalignment of the sheet surface, i.e. the stamping surface, with respect to **any one** of the surfaces with which it is in contact (see also page 2, lines 23-25; page 28, lines 26-28).

Consequently, this amendment introduced in step c. of claim 1 of the main request does not contravene Article 123(2) EPC.

1.5 Novel selection (*Obiter Dictum*)

1.5.1 The Board cannot follow the finding of the Examining Division that claim 1 of the main request would constitute a novel selection with respect to the disclosure of the application as originally filed since it amounts to a mere allegation, i.e. not supported by any concrete arguments.

Further, as pointed out by the appellant, the substantial amendments made to claim 1 concern the replacement of generic terms by specific terms and the correction of error(s) and/or clarifications, corresponding to normal practice in examination proceedings. As already discussed under points 1.1 to 1.4 above, these amendments made to claim 1 do not contravene Article 123(2) EPC.

1.5.2 Regarding the "obiter" finding of the Examining Division that original claim 1 would constitute an attempt of erecting a "smoke screen", the Board notes that it concerns a claim which no longer forms the basis for examination. Further, the Examining Division does not provide any legal basis in this respect, nor is there any established "smoke screen" case law, let alone in connection with an objection pursuant to Article 123(2) EPC, which is the legal basis of the impugned decision for refusing the main request. If the Examining Division wishes to make an objection pursuant to Article 84 EPC, it should do so observing the right

to be heard (Article 113(1) EPC), Article 84 EPC itself and the case law dealing with it.

1.5.3 In view of the above, the Board cannot find any help in the *Obiter Dictum*, which would allow it to bring the matter to a decision on the grant of a patent or a dismissal of the appeal.

2. *Auxiliary requests*

As a consequence of the above, a discussion about the auxiliary requests is not necessary.

3. Since the decision under appeal, in as far as it is reasoned, only deals with the amendments under Article 123(2) EPC, the Board sees no reason to exercise the power of the Examining Division any further.

**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:



B. Atienza Vivancos

H. Meinders

Decision electronically authenticated