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File Number: T 563/89 - 3.2.1

Application No.: 80 107 516.9

Publication No.: 0 030 348

Title of invention: A method for producing a re-sealable dispenser-container
as well as dispenser-container produced according to this
method

Classification: B56D 83/08, B65D 75/58

DECISION
of 3 September 1991

Proprietor of the patent: Nakamura, Kenji

Opponent (02) Medusa Eurosponges

Opponent (03) Klöckner Pentapack GmbH

Headword:

EPC Article 56, Rule 67

Keyword: "Transfer of rights from an opponent to a third party acting as an
appellant"
"Novelty (yes)"
"Inventive step (no)"
"Procedural violation (no)"

Headnote



Case Number : T 563/89 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 3 September 1991

Appellant :
(Opponent 03)

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Decision under appeal :

Interlocutory decision of Opposition Division of
the European Patent Office dated 23 June 1989
concerning maintenance of European patent
No. 0 030 348 in amended form.

Composition of the Board :

Chairman : F. Gumbel
Members : P. Alting van Geusau
J.-C. Saisset

Summary of Facts and Submissions

- I. The mention of grant of European patent No. 0 030 348, in respect of European patent application No. 80 107 516.9 filed on 2 December 1980, was published on 19 September 1984.

- II. In notices of opposition filed respectively on 18 June 1985 and 19 June 1985 the Opponents requested revocation of the patent on the ground that its subject-matter lacked novelty and further did not involve an inventive step (Article 100 EPC).

The oppositions were supported, *inter alia* by the following documents:

- (1) Publication "Packaging Machines" (1971), P. Keppler Verlag KG, pages 8, 49, 51, 54, 59, 65, 75 and 76;

- (2) Text book "Verpacken mit Kunststoffen" (1974) Carl Hanser Verlag, pages 240-241;

- (3) US-A-4 156 493;

- (6) US-A-4 185 754 (document not prepublished);

- (9) Pamphlet of the Italian firm Hayssen
Via Torino 14
I-24040 Zingonia (Bergamo) - Italy;

- (10) Pamphlet of the Italian firm Cavanna SpA
Via Matteotti 104
I-28077 Prato Sesia (Novara) - Italy;

- (11) Pamphlet of the Italian firm OMAS
Corous Piemonte 62
I-10078 Venaria Reale (Torino) - Italy;

- (12) DE-A-28 00 165;
- (13) DE-A-28 47 560;
- (14) A sample of KLEENEX pocket pack, sold prior to 1979.

III. By an interlocutory decision of 23 June 1989 the Opposition Division maintained the patent in amended form on the basis of a set of 6 claims having two independent Claims 1 and 4 which read as follows:

1. A method for producing a re-sealable dispenser-container for containing sheet-like materials for cosmetic or toilet use comprising a main container body (1) made of an impervious sheet-like material (21) which wraps around said sheet-like materials (29) for cosmetic or toilet use;

said main container body being formed in a rectangular shape and having at least one opening (2);

a flap (3) one end of which is attached to said main body (1) at a position apart from an end of said opening and which has a pressure-sensitive adhesive surface and

a non-adhesive member (5) made of an impervious sheet-like material in a size at least the same as that of said opening formed on said container body (1) and being adhered to said flap (3) at a position corresponding to said opening, said method is characterized by:

- (a) feeding a continuous sheet of impervious material;

- (b) periodically punching a line drawn in a closed elongated shape at a central portion in said continuous sheet (Figs. 6-7:21);
- (c) periodically disposing a flap (Figs. 1-7:3) with an adhesive surface (Figs. 1-5:4) on one side of said continuous sheet (Figs. 6-7:21) in such a manner that the flap (Figs. 1-7:3) covers said punched line and that said adhesive surface (Figs. 1-5:4) of the flap (Figs. 1-7:3) contacts said side of said continuous sheet (Figs. 6-7:21);
- (d) periodically fixing one end portion of said flap (Figs. 1-7:3) to said continuous sheet (Figs. 6-7:21);
- (e) periodically disposing said sheet-like materials (Figs. 6-7:29) for cosmetic or toilet use on the opposite side of said continuous sheet (Figs. 6-7:21) at a position corresponding to said flap (Figs. 1-5:3);
- (f) continuously wrapping said sheet-like materials (Figs. 6-7:29) for cosmetic or toilet use with the continuous sheet (Figs. 6-7:21) with said flap so folded that longitudinal edges (Figs. 6-7:17) of the continuous sheet (Figs. 6-7:21) are put upon each other at the central portion of the continuous sheet (Figs. 6-7:21);
- (g) continuously sealing the longitudinal edges (Figs. 6-7:17) of the continuous sheet (Figs. 6-7:21) with said flap and sealing said sheet (Figs. 6-7:21) with said flap transversely; and periodically cutting said sheet (Figs. 6-7:21) at a transversely sealed portion (Figs. 6-7:6).

((a) to (g) have been added for purpose of reference in the present decision.)

4. A re-sealable dispenser-container for containing sheet-like materials for cosmetic or toilet use obtained by the method according to Claims 1 to 3, comprising:

a main container body (Figs. 1-5:1) made of an impervious sheet-like material (Figs. 6-7:21) which wraps around said sheet-like materials (Figs. 6-7:29) for cosmetic or toilet use;

said main container body (Figs. 1-5:1) being formed in a rectangular shape and having at least one opening (Figs. 1-5:2);

a flap (Figs. 1-5:3) one end of which is attached to said main body (Figs. 1-5:1) at a position apart from an end of said opening (Figs. 1-5:2) and which has a pressure-sensitive adhesive surface (Figs. 1-5:4); and a non-adhesive member (Figs. 1, 3-5:5) made of an impervious sheet-like material in a size at least the same as that of said opening (Figs. 1-5:2) formed on said main container body (Figs. 1-5:1) and being adhered to said flap (Figs. 1-5:3) at a position corresponding to said opening (Figs. 1-5:2) characterized in that:

said main container body (Figs. 1-5:1) has:

a first seal line (Figs. 6-7:16) extending in a longitudinal direction of said main container body (Figs. 1-5:1) at the central portion of said rectangular shape and connecting the edges (Figs. 6-7:17) of said impervious sheet-like material (Figs. 6-7:21) of said main container body (Figs. 1-5:1) to each other; and

two second seal lines (Figs. 6-7:6) transversing to said first seal line (Figs. 6-7:16) at both short ends of said rectangular shape;

said opening (Figs. 1-5:2) as formed on a surface of said main container body (Figs. 1-5:1) opposite to said first seal line (Figs. 6-7:16) is located at the central portion of said rectangular shape and extends in a longitudinal direction of said rectangular shape.

The Opposition Division held that in the light of the problem to be solved, i.e. to avoid the drawbacks of the nearest prior art disclosed in D3 and concerning the continuous manufacture of dispenser-containers a person skilled in the art could not find in the cited prior art any hint to help him conceive a solution such as defined in the independent method Claim 1. The Opposition Division was further of the opinion that since the subject-matter of Claim 1 is founded on an inventive step, the re-sealable dispenser-container according to Claim 4 obtained by the inventive method is also founded on an inventive step.

IV. An appeal was filed against this decision by Opponent 03 and Opponent 01 on 21 and 28 August 1989 respectively with payment of the prescribed appeal fee being made on the same days. The Statements of Grounds of Appeal were filed on 27 September 1989 (Opponent 03) and 28 August 1989 (Opponent 01).

It was stated in the appeal filed on 21 August 1989 that the Company Virgunia Verpackung (Opponent 03) had been sold to Klöckner Pentapack GmbH and that the latter company should be considered as the legal successor of

Opponent (03). Evidence of the transfer of rights was filed with letters of 23 May 1990 and 14 August 1990.

- V. On 1 February 1991 the Board issued a communication, together with a summons for oral proceedings, auxiliarily requested by Opponent 01 and the Respondent.

The Board observed that many new prior art documents had been filed after the 9 month period set out in Article 99(1) EPC but, since none of these documents appeared to be more relevant than the documents already in the proceedings, it was announced that these further documents might well be disregarded in accordance with Article 114(2) EPC.

The Board further expressed their doubts as to whether the subject-matter of the independent claims involved an inventive step, when taking into account the teachings of D3 and D12 together with the knowledge of the skilled packaging engineer, as reflected for example in documents D9 to D11.

- VI. By telecopy of 21 August 1991 Opponent 01 withdrew both his opposition and the associated appeal.

- VII. Oral proceedings took place on 3 September 1991.

At the beginning of the oral proceedings the Respondent asked whether the only remaining Appellant was entitled to appeal because the Respondent had not been informed of the formal examination and result concerning the transfer of rights.

The Chairman announced that the transfer of rights had been established and documentated in the file in particular through filing a contract of sale of the

Company Virgunia Verpackung (Opponent 03) to Klöckner Pentapack GmbH (Appellant). No further questions were raised in respect of this issue.

VIII. In his written submissions and during the oral proceedings, the Appellant substantially argued as follows:

The product as claimed in Claim 4 lacks novelty in view of the disclosures of D12. Although no reference is made to a re-sealable package, it is self-evident to the skilled person that, when an adhesive is used for attaching the flap 63 to the container, re-sealing by means of re-application of the flap using the adhesive is certainly possible, since the adhesives normally used also keep their adhesive properties even after the flap has been torn from the package for the first time.

Considering the embodiment disclosed in Figure 4A of D3, the container according to current Claim 4 differs therefrom effectively only in respect of different positions of the seals which form a pillow pack, a pillow pack being in itself referred to in Figure 5A of D3. Therefore D3 already comprises all the information necessary to arrive in an obvious way at the container of Claim 4 of the amended patent.

Further, when wishing to produce a pillow pack with the re-sealable opening disclosed in Figure 4A or 4B of D3, the skilled person would immediately arrive at the method of Claim 1, since this defines the only sensible way of making this sort of container. The manufacturing of pillow packs is well known from D2 and from D9-D11, and does not differ from what is defined in Claim 1. It follows from normal manufacture of a re-sealable opening of the sort disclosed in D3 that the provision of the opening and re-

sealable flap should be in advance of the step at which the wet tissues are inserted. Therefore the method of Claim 1 can also not be considered to contain inventive subject-matter.

Moreover, in the Appellant's opinion the subject-matter of Claim 4 has not been examined independently of Claim 1 in the opposition procedure, which should therefore be considered to constitute a substantial procedural violation, requiring reimbursement of the appeal fee.

IX. The Respondent contested the Appellant's comments and essentially submitted the following:

The embodiments of Figures 4A and 4B as disclosed in D3, are just two possibilities out of a great number of other embodiments disclosed in that document. Most of the embodiments comprise re-sealable caps. In the case of US patents an inventor has to disclose the best possible embodiment of the invention, but obviously the inventor of D3 did not think of producing a re-sealable container according to the currently claimed manufacturing process, in respect of the specific succession of steps thereof, and of the fact that a pillow pack method is now used for manufacturing the container. In particular, D3 does not teach that the flap should be attached prior to disposing the sheet-like materials on the continuous sheet; this feature, seen in conjunction with the idea of producing such a re-sealable dispenser-container according to the pillow pack method, forms the gist of the invention.

D12 does not relate to a re-sealable dispenser-container but to a refill package in a re-closable rigid box. Further, the different heights of the two sides of the package shown in Figures 3 to 5 of D12 exclude continuous manufacture. In the pillow pack packaging machines

according to D9-D11, no opening is formed which is used to dispense the contained material therethrough and which can be re-sealed, nor is there any suggestion of such re-sealable openings in any of these documents.

The advantages of a pillow pack over a pouch pack are that the pillow pack can be made more simply and speedily and so as to conform to the dimensions of the contents; thus less material is required, and the pack is aesthetically more pleasant.

The patent proprietor has satisfied a long-existing demand for a cheap and re-sealable dispenser-container for wet tissues. This position is supported by:

- (a) a great commercial success,
- (b) license requests from well-known competitors such as the former Opponent 01 (Nice-Pak) and
- (c) freely negotiated license agreements in various countries.

The inventors of D3 and of D12 tried to solve the existing problem in quite different ways. The many different earlier approaches indicate that the method as described in the patent under dispute cannot be considered as obvious.

The re-sealable dispenser-container, which is manufactured according to the claimed method, is a so-called "wholesale article" or "mass produced article". In the case of such articles there is a universal need with manufacturers to continually and progressively improve their production methods. In so doing even relatively small improvements

may lead to achieving considerable commercial success and may also constitute an invention.

Reference was also made in this respect to the decision T 9/86 of Technical Board of Appeal 3.3.1 dated 6 November 1986 (OJ 1988,12).

The patent proprietor also filed an affidavit by Mr Anthony Spinozzi, which underlined the patent proprietor's position that the claimed method was not obvious in particular as regards the provision of a resealable opening in a "pillow-pack" container.

- X. The Appellant requested that the impugned decision be set aside and that the patent be revoked in its entirety.

He further requested reimbursement of the appeal fee for the reason that the Opposition Division had not dealt with Claim 4 as an independent claim in their decision, which, according to the Appellant, constitutes a substantial procedural violation.

The Respondent requested that the appeal be dismissed and that the patent be maintained in the form as amended in the Opposition procedure. He auxiliarily requested maintenance of the patent exclusively on the basis of the method Claims 1 to 3.

Reasons for the Decision

1. Admissibility of the appeal

- 1.1 In the course of the present case but before the appeal proceedings the company Virgunia Verpackung, which filed an opposition on 19 June 1985 (Opponent 03), was sold in

its entirety, as can be seen from the contract of sale, a copy of which was filed at the EPO on 16 August 1990, to the company Klöckner Pentapack GmbH with effect from at least 4 May 1987 (see paragraph 2 of the contract of sale).

The notice of appeal filed by Klöckner Pentapack GmbH explained clearly that this company was acting as successor in title of Virgunia Verpackung. Thus from the beginning of the appeal procedure the parties have been aware of the transfer of rights and this transfer has not been contested in the appeal procedure.

In accordance with the decision of the Enlarged Board of Appeal G 4/88 (OJ, 1989, 480), an opposition pending before the European Patent Office may be transferred or assigned to a third party as part of the Opponent's business assets, together with the assets in the interests of which the opposition was filed.

The present Board of Appeal considers that the right to lodge an appeal may also be transferred to a third party, based on the same reasons as developed in the above decision of the Enlarged Board of Appeal (cf. point 6 thereof).

The company Klöckner Pentapack must therefore be seen as the legal successor of Opponent 03 and as such is entitled to appeal in accordance with Article 107 EPC.

1.2 The appeal further complies with Articles 106 and 108 as well as Rule 64, and is admissible.

2. Formal acceptability of the claims

2.1 The independent Claims 1 and 4 are based on features finding their counterpart in original Claims 1, 2, 3, 5, 6

and 20 to 24 and features relating to the manufacturing process disclosed with respect to original Figure 15 and described on page 11, line 6 to page 12, line 2 of the application as filed. Dependent claims 3 and 6 contain features disclosed with respect to a further embodiment of the manufacturing process with respect to Figure 16 and page 12, lines 3 to 18 of the application as filed.

Claim 2 is based on the features disclosed on original page 11, lines 11 to 13 and Claim 5 has its basis in the originally filed description, page 6, lines 10 to 16.

All claims thus meet the requirement of Article 123(2) EPC.

- 2.2 Since the current Claims 2 to 6 are repetitions of the granted Claims 2 to 6 and current Claim 1 is further restricted by features relating to the continuous character of the disclosed manufacturing process, the current claims do not contravene Article 123(3) EPC.

3. Prior art

- 3.1 In addition to the documents introduced within the 9-month period stipulated in Article 99(1) EPC, a great number of further prior art documents were cited after this period. The Board has considered these additional documents but has come to the conclusion that, as well as being late-filed, they are no more relevant than the documents already in the proceedings. The Board therefore makes use of its discretion in accordance with Article 114(2) EPC to disregard this evidence.

4. Novelty

4.1 For the question as to whether the subject-matter of Claims 1 and 4 is novel the documents D3 and D12 respectively are considered to represent the most relevant prior art.

4.2 Comparing the disclosure of D3 with the manufacturing method of Claim 1 under consideration, it is apparent that in the embodiments of Figures 4A and 4B, which come closest to the claimed subject-matter, these containers have a 3/4 surrounding seal, rather than a longitudinal seal at the central portion and two end seals at the small ends of the container, as defined in Claim 1 under consideration.

This difference also applies when comparing the disclosure of D3 with the re-sealable dispenser-container defined in Claim 4 under consideration.

4.3 The document D12 relates to a dispenser-container which is a refill-pack for a re-sealable rigid box. A sealing flap is fastened, to one side of the dispenser by, for example, an adhesive for complete removal of it together with an underlying portion of the container sheet material forming the dispensing opening.

The Appellant expressed the opinion that the sealing flap in D12 could also be considered to represent a re-sealable flap since usually the applied adhesives keep their adhesive properties after tearing the flap off the container, and thus may be re-applied to the package. Therefore, in his opinion, the subject-matter of Claim 4 lacked novelty relative to the disclosure of D12.

In this respect the Board notes that D12 is solely related to complete removal of the flap covering the dispenser

opening, because the re-sealable box provides the re-sealable function of the container. Although D12 refers to a number of possibilities for removable fastening of the flaps to the container (see page 15, last paragraph), no disclosure or implication can be derived from this document to the combination of a pressure sensitive adhesive surface and a fixed end portion of the flap, in order to arrive at a re-sealable and opening-closure registering function of the flap portion such as achieved by the flaps of the independent Claims 1 and 4.

4.4 The subject-matter of Claims 1 and 4 is therefore deemed to be novel over the prior art (Article 54 EPC).

5. Inventive step

5.1 As regards the method defined in Claim 1 under consideration, D3 is considered to represent the closest prior art, since this document also concerns the manufacture of a re-sealable dispenser-container for wet sheet-like materials, whereas D12 concerns a refill package not having such a re-sealable function of the dispensing opening closure flap.

Considering D3 more in detail, a number of embodiments of re-sealable dispenser-containers are disclosed, of which the embodiments of Figures 4A and 4B show hermetically sealed flexible containers employing an adhesive type re-sealable closure of the type such as defined in Claim 1 under consideration, in accordance with the pre-characterising portion of Claim 1.

5.2 The characterising features of Claim 1 provide for continuous manufacturing of the re-sealable dispenser-container in the form of a so-called "pillow pack" - in contrast to the "pouch pack" shown in the embodiment of Figures 4A and 4B in D3. Pouch type packs lead to some

drawbacks as to manufacture, material consumption and aesthetic appearance.

The objective problem underlying the patent in suit can therefore be seen in the provision of a continuous process for manufacturing in an easy manner at low cost a dispenser-container having a re-sealable opening, and which is of pleasant appearance and specially adapted for pocket use.

No inventive activity can be attributed to the recognition of the problem, the disadvantages of pouch type packs concerning manufacture, appearance and pocket use being evident.

5.3 Considering now whether the skilled person would draw any further information leading to the claimed manufacturing process from the disclosure of D3, the Board is of the opinion that, in view of the "pouch" type containers shown in Figures 4A and 4B, the skilled person would immediately realise that these containers would have been produced by the well-known "Bartelt" pouch making machine referred to in the Reply Affidavit of 8 October 1986 of Mr Julius (see also page 13 of the Respondent's letter of 19 April 1990), which is a continuous process by which pouches are formed from a continuous sheet of impervious material (feature (a) in Claim 1 under consideration).

It is noted that the Respondent submitted in writing that the dispenser-containers according to Figures 4A and 4B of D3 must have been formed from discontinuous and separate sheet-like material by folding the sheet-like material into two and sealing the three peripheral edges of the separate sheet-like material (see also column 2, lines 11 to 16 of the amended patent). However, with his response of 1 August 1991, a Proof of Evidence was filed according

to which the container of the embodiments, as shown in Figures 2 and 3, have actually been produced on a modified Bartelt IM packing machine. Since the container of this embodiment is also of the "pouch" type, the allegation that the dispenser-container of the embodiment of Figures 4A and 4B must have been produced in a different, discontinuous manner cannot be accepted.

5.4 It was further admitted by the Respondent in the oral proceedings that, had a continuous process, such as that determined by the Bartelt machine, been used, the opening 35' in the container would most probably have been formed by periodically punching a line drawn in a closed shape on a portion of the continuous sheet before the pouch forming step (feature (b) in Claim 1).

In the Board's opinion, there is no conceivable manner by which the opening 35' could otherwise have been formed, and it is therefore considered to be self-evident that the discontinuous area defining the opening 35' would have been formed by a perforation cut into the material forming the packet 25' before the package forming manufacturing step.

5.5 A discussion developed in the oral proceedings as to whether the flap 42 would have been applied before the package forming manufacturing steps or after the package had been filled with the tissues.

Although D3 is silent regarding at what stage of the manufacturing process the flap 42 in the embodiment of Figures 4A or 4B is attached to the container, the Board considers it to be clear for a practitioner that the flap is supposed to be attached to the sheet before the pouch is formed; this is mainly because of the fact that the perforations provide leakage paths for the liquid of the

wet tissues, and that in practice any such leakage would hinder adhesive fastening as soon as pressure is exerted on the filled package when applying the flap. A further reason is that the flap is permanently attached at one end 41 thereof to the packet 25', thereby defining a flexible hinge 43. In order to fasten this part, e.g. by means of the normally used methods of heat sealing or ultrasonic sealing referred to in D3, direct access of the sealing equipment on both sides of the sheet is necessary and this fastening step will therefore normally be carried out before the folding and pouch making step, as has been submitted by the Appellant (features (c) and (d) in Claim 1).

Of course, it is not excluded that the flap may be attached after forming and filling of the container. In this respect the Respondent referred to US-A-4 723 301 published on 2 February 1988, in which a re-sealable flap is attached after the container has been formed. However, this document is silent as to the manner in which the hinge side portion is permanently attached. For this reason this cannot, in the Board's opinion, be considered to represent the most evident manner of attaching a flap to the container shown in Figures 4A and 4B of D3.

- 5.6 Although Claim 1 under discussion defines the opening to be of "a closed elongated shape", according to the description of the amended patent the shape of the opening 2 can be a circle, rectangle, diamond shape, ellipse and the like.

In this respect, the possible forms of the opening disclosed in D3 are not essentially different, since in column 3, lines 43 to 46 there is stated that the opening may take the form of a circle, an oval, a slit or any other desired shape.

5.7 Summarising the conclusions of the preceding points 5.3 to 5.6 the Board is of the view that D3 provides sufficient information for the skilled person, so that he would arrive in an obvious manner at the features (a) to (d) of the characterising portion of Claim 1 under discussion; this results solely from normal considerations as to how the container shown in Figures 4A and 4B would be manufactured by standard production methods.

Whether the container according to these embodiments has really ever been produced or not is considered irrelevant since the only important question to be answered in respect of D3 is how the skilled person would have produced these embodiments with the means readily available to him at the date of publication of D3.

5.8 Tissues for pocket use were sold before the priority date of the patent in suit in so-called "pillow packs" which are a well-known alternative to "pouch packs" (see also Figure 5A in D3). An example of such a "pillow pack" for dry tissues was presented during opposition proceedings as a sample of a Kleenex pocket pack sold prior to 1979 (evidence No. 14).)

In view of the drawbacks inherent to pouch packs (see point 5.2 above) and considering the fact that packaging machines for manufacturing pillow pack containers were readily available to the skilled person (see D9-D11), no inventive contribution was necessary in order to conceive the idea of producing instead of the pouch pack disclosed with respect to the embodiments of Figures 4A and 4B in D3 a pillow pack container.

5.9 The Board notes that the Respondent particularly considered this change of manufacturing process - from the

pouch pack type to the pillow pack type - as not being obvious to the skilled person, and in this respect he submitted that the known pillow packs of D9-D11 are not re-sealable, but are broken when it is required to take out the contents. Also, in the Proof of Evidence provided by Mr Spinozzi, it was stated that the practicability of combining the label, as shown in Figure 4A of D3 with the simple pillow pack type wrapper could only be realised after having had knowledge of the application documents of the present patent.

However, a pillow pack type of dispenser for wet tissues, having an opening closed by a removable flap, was already known from D12. It is true that this flap is not intended to be re-sealable, but its construction is nevertheless very similar to the flap disclosed in D3 and in the Board's opinion, such containers obviously have been produced on a suitably adapted pillow pack making machine.

There was therefore also no reason why the skilled person would have been discouraged, when adapting the manufacturing process from pouch type packs to pillow type packs for wet tissues, having once realised that the known pouch pack shown in D3 was disadvantageous in certain respects and not really suitable for pocket use, because of its exposed longitudinal edges.

- 5.10 No proof has been presented showing difficulty when adapting the manufacturing process of the pouch pack container according to the embodiments of Figures 4A or 4B to pillow pack production nor is there any evidence of a combinatory effect between choosing to manufacture the pillow pack and selecting the stage at which the flap is to be applied according to the claimed method. Hence, no such combinatory effect can be taken into account.

As regards the disclosure of D12 the Respondent argued that the different heights on the two sides of the package shown in Figures 3 to 5 exclude the likelihood of continuous manufacture because this could not be carried out on a flat conveyor.

It was submitted during the oral proceedings by the Appellant that different heights on the sides of a pillow type package did not cause any problems in the known pillow pack manufacturing process. Samples of re-sealable containers with such different heights were shown, which had been manufactured on the Appellant's pillow type packaging machines.

Since it is obvious, for the skilled person, also in the embodiments of Figures 4A or 4B, to provide the opening and flap before insertion of the tissues (see points 5.4 and 5.5 hereinabove), only the container forming steps would have needed adaptation to conform to the standard pillow pack manufacture technique.

- 5.11 The Board can thus neither see a prejudice nor technical difficulties that would prevent a skilled person from applying the pillow pack manufacturing technique for manufacturing a re-sealable dispenser container disclosed with respect to Figures 4A and 4B of D3.

These standard pillow pack manufacturing steps correspond to the features (e) to (g) of the characterising portion of Claim 1 under consideration.

- 5.12 The Respondent also submitted that a long existing demand for a cheap and re-sealable dispenser-container for wet tissues had been satisfied, which should be regarded as an indication of inventive activity.

However, it is noted that the most relevant prior art disclosed in D3 and D12 refer to priority dates of 19 March 1976 and 10 January 1977, respectively. The present patent's earliest priorities date from 3 December 1979. These close respective dates cannot be considered to corroborate a long existing demand but, in the Board's opinion, merely indicate that at that time a normal development of this relatively new product took place.

In this respect, the further alleged indications, such as a great commercial success, license requests from competitors and freely negotiated license agreements in various countries cannot be considered in themselves as being suited to substantiating inventive step. No proof was given that these aspects are predominantly linked to the manufacturing process or product as claimed rather than to selling techniques, advertising and marketing strategies on the one hand and the execution of the privileges given by the impugned patent on the other hand.

- 5.13 Another point stressed by the Respondent was that the inventor of the containers disclosed in D3, who must be regarded as a real expert in the field, did not think of the possibility of producing a dispenser container having a re-sealable flap as shown in Figures 4A or 4B in D3 according to the pillow pack process; he would otherwise have referred to this in the specification of D3 because, in accordance with American patent law, the "best" solution must be disclosed (see page 9 of the Respondent's letter of 1 August 1991). Leaving out of consideration whether such an argument is suitable for substantiating an inventive activity, in the Board's view what is to be considered as representing the "best" solution depends to

a great extent on subjective considerations. The pouch pack type of container shown in D3 gives, for example, the possibility of adding extra fluid to the tissues before closing the package, which under certain circumstances may be regarded as a "better" solution than the pillow pack, which does not provide this possibility.

- 5.14 The Respondent also drew attention to the Decision T 9/86 of the technical Board of Appeal 3.3.1 (OJ 1988, 12) in order to underline his opinion that, for a mass produced article, even relatively small improvements may indicate inventive step, and that such conditions apply in the present case.

However, as can also be derived from the cited Decision (see in particular points 5 and 6 thereof) further circumstances must also be taken into account, such as different development in the relevant field or a technical prejudice of some sort. As will be clear from the above considerations with regard to inventive step of the method of Claim 1, there is no indication of any such counteracting circumstances and therefore the Respondent's arguments cannot be considered convincing in this respect.

- 5.15 In view of the preceding, no inventive step can be perceived in the subject-matter of Claim 1 according to the Respondent's main request. The patent cannot therefore be maintained on the basis of the set of claims according to the main request.
- 5.16 As regards the independent product Claim 4, the conclusions with respect to lack of inventive step put forward against Claim 1 apply *mutatis mutandis*.

It is noted that although Claim 4 refers to the method of Claim 1, it must be considered as an independent product claim in accordance with established jurisprudence by the Boards of Appeal, based on the conclusions in the decision T 150/82 (OJ 1984, 309). Considering Claim 4 in more detail, it will be clear that the sequence of steps of the manufacturing process do not imply any recognisable technical feature of the product. A comparison of the claimed product with the disclosure of D3 in Figures 4A and 4B thus lead to the conclusion that there is a difference only with respect to the position of two seals of the containers. The underlying problem to be solved by the product of Claim 4 is therefore solely related to the provision of a more handy package for pocket use, the solution thereof, in choosing the "pillow pack" type of container, being well-known to the skilled person.

5.17 According to the Respondent's auxiliary request the patent shall be maintained in amended form on the basis of Claims 1 to 3 of the main request only. However, since the method Claim 1 according to the main request is not patentable for lack of inventive step of its subject-matter, the auxiliary request must also be rejected.

6. Request for reimbursement of the appeal fee

6.1 In the decision under appeal the Opposition Division established that since the subject-matter of Claim 1 was founded on an inventive step, the re-sealable dispenser-container obtained by the inventive method was also founded as an inventive step.

The Appellant submitted that the subject-matter of the independent Claim 4 had not been considered in itself, as to whether it complies with the requirements of the EPC, particularly novelty and inventive step; this, in his

opinion, constitutes a procedural violation requiring reimbursement of the appeal fee.

6.2 The Board agrees with the Appellant that the patentability of a method claim does not necessarily imply patentability of the independent product claim containing a reference to that method claim (see also point 5.16 hereinabove). However, the incorrect conclusion drawn by the Opposition Division cannot be regarded as a violation of EPC procedure but merely represents an error of judgment. Thus, there is no ground for reimbursement of the appeal fee under Rule 67 EPC and the request must therefore be rejected, as was announced by the Chairman at the end of the oral proceedings, but not reported in the minutes of those proceedings.

Order

For these reasons, it is decided that:

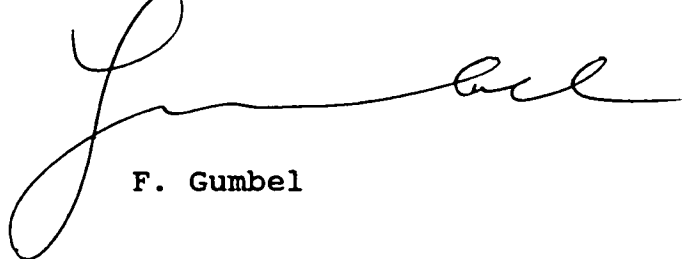
- the decision under appeal is set aside.
- the patent is revoked.
- the request for reimbursement of the appeal fee is rejected.

The Registrar:



S. Fabiani

The Chairman:



F. Gumbel