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**D E C I S I O N**  
**of 11 October 2001**

**Case Number:** T 0099/97 - 3.2.5

**Application Number:** 92310679.3

**Publication Number:** 0547785

**IPC:** B42D 5/02

**Language of the proceedings:** EN

**Title of invention:**

Return envelopes and mailers containing such envelopes

**Applicant:**

MOORE BUSINESS FORMS, INC.

**Opponent:**

-

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 123(2)

**Keyword:**

"Added subject-matter (yes)"

**Decisions cited:**

-

**Catchword:**

-



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Boards of Appeal

Chambres de recours

**Case Number:** T 0099/97 - 3.2.5

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.5**  
**of 11 October 2001**

**Appellant:** MOORE BUSINESS FORMS, INC.  
300 Lang Boulevard  
Grand Island  
New York 14072-1697 (US)

**Representative:** Fry, Heath & Spence  
The Old College  
53 High Street  
Horley  
Surrey RH6 7BN (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 3 September 1996  
refusing European patent application  
No. 92 310 679.3 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** W. Moser  
**Members:** A. Burkhart  
P. E. Michel

## Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the Examining Division refusing the application No. 92 310 679.3.

The Examining Division held that the application did not meet the requirements of Article 56 EPC (inventive step) having regard to the prior art documents

D1: FR-A-2 354 937 and

D2: EP-A-0 302 796.

- II. The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the following documents:

(i) Main request:

Claims 1 to 10, description and drawings underlying the decision under appeal; or

(ii) Auxiliary request:

Claims 1 to 10, filed on 31 December 1996.

- III. Claim 1 according to the main request reads as follows:

"1. A business form comprising an outer mailer for first mailing, the mailer having a completed exterior construction of a rectangular sheet having four borders and being arranged to be sealed round those borders, lines of weakness (42,43,44) to define in the mailer around at least three of the borders marginal areas (45,46,47) that are detachable from main panels

(48,49,50) of the mailer, said main panels being within said lines of weakness and being rectangular in configuration, the outer mailer containing within it a reply envelope (11), the reply envelope comprising adjacent panels (14,15) having respective inner surfaces in face to face contact to define an envelope pocket with an opening (17) across its width and having respective outer surfaces, one (14) of the panels being extended to form a flap portion having a free edge (22) and connected to said one panel along a first fold line (18), the flap portion having a depth greater than one half, and preferably substantially equal to, the depth of the envelope pocket, the flap portion including a second fold line (23) between the first fold line and the free edge, the reply envelope having the flap portion folded about the first line, and the second fold line being spaced from the first fold line a distance sufficient to provide final dimensions of the return envelope, when the flap is folded about the second fold line, which meet or exceed minimum size requirements for a mailable document, characterised in that the outer mailer has been formed from a single sheet which has been C-folded or Z-folded, that single sheet being of an original size that the main panels of the outgoing mailer and the return envelope when folded about the first fold line have a depth less than the minimum size requirements for a mailable document, that is 88.9mm (3½")."

Claim 1 according to the auxiliary request differs from claim 1 according to the main request in that the feature "that the outer mailer has been formed from a single sheet which has been C-folded or Z-folded" has been replaced by the feature "the outer mailer being formed from a single sheet which has been C-folded or

Z-folded about two lines dividing the sheets into three substantially equal parts",

and in that the preamble of this claim is based on a prior art different from that underlying the preamble of claim 1 of the main request.

IV. On 4 July 2001 the appellant was duly summoned by the Board to oral proceedings scheduled for 11 October 2001.

In an annex to the summons to attend oral proceedings, the Board, *inter alia*, expressed its view that the main and auxiliary requests were not allowable with respect to Article 123(2) EPC, since the feature contained in claim 1 of each request "that the main panels of the outgoing mailer have a depth less than the minimum size requirement for a mailable document, that is 88.9mm (3½)" was not disclosed in the application as filed.

V. The appellant did not file any reply to this annex. Moreover, at the oral proceedings of 11 October 2001, no one was present on behalf of the appellant, and the representative of the appellant informed the Board by facsimile, received on 11 October 2001 at 10.28 hrs, that the appellant did not wish her to attend oral proceedings. Based on Rule 71(2) EPC, the oral proceedings were continued without the appellant, and the final decision was given orally (Rule 68(1) EPC).

### **Reasons for the Decision**

*Extension beyond the content of the application as filed -  
Article 123(2) EPC*

The feature of claim 1 both according to the main and the auxiliary requests

"that the main panels of the outgoing mailer have a depth less than the minimum size requirement for a mailable document, that is 88.9mm (3½)"

is not disclosed in the application as filed.

It is true that claim 11 of the application as filed describes an embodiment of the invention, wherein the panels of the outgoing mailer have a depth of about 8.6cm. However, nowhere in the application as filed can there be found an indication that the depth of the panels of the outgoing mailer should fall short of a critical value of 88.9mm (3½").

It is only with respect to the return envelope that a depth limitation is mentioned, see description, page 2, second paragraph, and page 8, lines 10 to 21, of the application as filed, from which indications it can be learnt that the **return envelope**, when folded about the first fold line, should have a depth less than the minimum size requirement for a mailable document under the "U.S.P.S. standards for first class mail".

Therefore, both claim 1 according to the main request and claim 1 according to the auxiliary request do not comply with the requirement of Article 123(2) EPC, and therefore neither of the requests of the appellant is allowable.

## **Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

M. Dainese

W. Moser