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**Datasheet for the decision
of 27 May 2024**

Case Number: T 0205/22 - 3.3.06

Application Number: 16397503.0

Publication Number: 3059344

IPC: D21H27/00, D21H19/82

Language of the proceedings: EN

Title of invention:

A METHOD FOR MANUFACTURING PAPER COMPRISING BLEACHED
CHEMITHERMO-MECHANICAL PULP SUITABLE FOR A RELEASE LINER AND
PRODUCTS AND USES THEREOF

Patent Proprietor:

UPM Specialty Papers Oy

Opponent:

Ahlstrom Italia S.p.A.

Headword:

Paper comprising BCTM PULP/UPM

Relevant legal provisions:

RPBA 2020 Art. 12(2), 12(4), 12(6)
EPC Art. 56

Keyword:

primary object of appeal proceedings to review decision -
appeal case directed to evidence on which decision was based
Late-filed evidence - admitted in first-instance proceedings
(yes) - admitted (yes)
Inventive step - obvious alternative - main request (no) -
auxiliary request (yes)

Decisions cited:

G 0007/93, T 1652/08, T 2197/11, T 0572/14, T 1621/16,
T 2049/16, T 0141/20, T 1758/21, T 2202/21

Catchword:



Beschwerdekammern

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Case Number: T 0205/22 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 27 May 2024

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 16 November
2021 rejecting the opposition filed against
European patent No. 3059344 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman J.-M. Schwaller
Members: S. Arrojo
R. Cramer

Summary of Facts and Submissions

I. The appeal from the opponent is directed against the decision of the opposition division to reject the opposition against European patent No. 3 059 344, with claim 1 as granted reading:

"1. A paper (PAP1) suitable for use as a layer of a release liner, the paper having density equal to or less than 1200 kg/m³, the paper having a ratio of grammage to thickness of the paper in micrometres equal to or higher than 1.0, wherein the grammage refers to the weight of the paper (PAP1) in grams per square meter, the paper (PAP1) comprising cellulose fibres from
- bleached chemical pulp and
- bleached chemithermomechanical pulp (BCTMP),
wherein the bleached chemithermomechanical pulp comprises cellulose fibres from hardwood (HW1) and softwood (SW1)."

II. In its grounds of appeal, the appellant argued that the granted claims were insufficiently disclosed, not novel over D6 and not inventive over D32 or the prior use P4 combined with any one of D7, D8 or D9, or over D1 combined with any one of D7, D8, D9 or D10. Further, it contested the admittance and allowability of auxiliary requests 1 to 26 filed in the first instance and submitted D59 to D63, but requested that D34, D47, D48, D50, D51, D52, D53 and D54 be excluded from the appeal proceedings.

III. With its reply, the patent proprietor and respondent contested the above objections and filed several sets of amended claims as auxiliary requests 1 to 26 as well

as the further document D64. Further, it requested that documents P4, D32, D57, D59, D62 and D63 and the new objections regarding improved runnability not be admitted into the appeal proceedings.

IV. Claim 1 of **auxiliary request 1** corresponds to claim 1 as granted with the additional features: "*... wherein the amount of softwood (SW1) in the bleached chemithermomechanical pulp (BCTMP) is equal to or higher than 1 wt.-% of the weight of the bleached chemithermomechanical pulp.*"

In claim 1 of **auxiliary request 2**, the amount of softwood has been amended to "*is in the range of 1-50 wt.-%*"

Claim 1 of **auxiliary request 3** the amount of softwood has been amended to "*is in the range of 5-45 wt.-%*"

Claim 1 of **auxiliary request 4** corresponds to claim 1 of auxiliary request 1 with the additional features: "*... wherein the amount of cellulose fibers from bleached chemithermomechanical pulp in the paper is less than 50 wt.-% of the weight of the paper,*"

Claim 1 of **auxiliary request 5** corresponds to claim 1 as granted with the additional features: "*... wherein the amount of cellulose fibers from bleached chemithermomechanical pulp in the paper is in the range of 1-50 wt.-% of the weight of the paper, and the amount of softwood (SW) in the bleached chemithermomechanical pulp (BCTMP) is in the range of 5-45 wt.-% of the weight of the bleached chemithermomechanical pulp.*"

Claim 1 of **auxiliary request 6** corresponds to claim 1 as granted with the additional features: "*... wherein the amount of cellulose fibers from bleached chemithermomechanical pulp in the paper is in the range of 5-45 wt.-% of the weight of the paper, and the amount of softwood (SW) in the bleached chemithermomechanical pulp (BCTMP) is in the range of 1-50 wt.-% of the weight of the bleached chemithermomechanical pulp.*"

Claim 1 of **auxiliary request 7** corresponds to claim 1 as granted with the additional features: "*... wherein the amount of cellulose fibers from bleached chemithermomechanical pulp in the paper is in the range of 10-35 wt.-% of the weight of the paper, and the amount of softwood (SW) in the bleached chemithermomechanical pulp (BCTMP) is in the range of 5-45 wt.-% of the weight of the bleached chemithermomechanical pulp.*"

- V. In a letter dated 12 October 2022, the appellant requested that D64 and auxiliary requests 1, 2, 6, 7, 11 to 14, 18, 21 and 24 to 26 not be admitted into the appeal proceedings.
- VI. In its preliminary opinion, the Board concluded that claim 1 as granted appeared to be not novel in view of D6, that the auxiliary requests should be admitted, and that document D32 and the prior use P4 were part of the proceedings, as there was no legal basis to disregard these documents. The Board also provided some preliminary thoughts to streamline the discussion on inventive step of the auxiliary requests, but left the conclusions open in this respect.

VII. In a letter dated 10 May 2024, the respondent presented additional requests, namely that i) the case be remitted to the opposition division in view of an alleged infringement of the right to be heard, ii) the decision to admit D30, D30a and D32 be overruled, iii) a question be referred to the EBA to decide whether a board has the discretion to overrule the incorrect admission of documents by the first instance, iv) the case be remitted to the opposition division to discuss the admittance of other late-filed documents and of the auxiliary requests.

VIII. At the oral proceedings, which took place on 27 May 2024, both parties maintained their original requests, namely:

The appellant requested that the decision of the opposition division be set aside and the patent be revoked in its entirety.

The respondent requested that the appeal be dismissed or, as an auxiliary measure, that the case be remitted to the first instance, or that the patent be maintained on the basis of the claims of one of auxiliary requests 1 to 26 filed with the reply to the statement of grounds of appeal.

Reasons for the Decision

1. Alleged violation of the right to be heard

1.1 Documents D30 and D30a (including exhibits 2a-2j concerning the public prior use P4) and D32 were filed after expiry of the opposition period, but were admitted into the proceedings on the argument that

their content was *prima facie* relevant for the discussion on patentability.

1.2 The respondent argued that in admitting the documents, the opposition division disregarded and did not appropriately respond to the proprietor's arguments, which infringed his right to be heard under Article 113(1) EPC. In particular, the division only discussed the matter superficially and did not indicate why the documents were considered to be *prima facie* relevant and why their late filing was not regarded as an abuse of the proceedings. The appellant had also not substantiated the prior use up-to-the-hilt, as it had not clarified what were the features of the release liner in question. In this respect, most of the exhibits in D30a were blacked out, so many of the features of the release liner remained unknown, leaving the respondent in the unfair position of having to defend its patent against a product which was only partially described. The case should therefore be remitted to the first instance.

1.3 The Board disagrees with the above argumentation, because it is clear from the minutes (pages 2 to 5) and the contested decision (points 4.3.1, 5.1.1 and 5.2.1) that the opposition division addressed in detail the question of admittance of the late-filed documents. Moreover, it applied the correct criteria for the exercise of its discretion in assessing whether the various alleged public prior uses were sufficiently substantiated and whether these and other late filed documents were *prima facie* relevant. The fact that some of the public prior uses, namely P1-P3, were not admitted provides further evidence that the opposition division duly considered the issue of admittance and took into account the arguments of the proprietor. The

Board thus concludes that the respondent's right to be heard was respected when documents D30, D30a and D32 were admitted into the proceedings. There is therefore no reason to remit the case to the first instance on this ground.

2. Overruling of the admittance of evidence by the first instance

2.1 The respondent requested that the division's decision to admit D30, D30a and D32 be overruled. While some Boards had concluded that there was no legal basis for overruling the admittance of late filed documents by the first instance and the general rule was that a correctly exercised discretion should not be reviewed, decision G 7/93 indicated that an incorrect exercise of discretion could be overruled. This was confirmed in decision T 2049/16, which argued (Reasons 3.2) that the decision to admit late filed documents could be considered as part of the contested decision and was thus subject to review. The possibility of overruling the admittance of late filed documents was also implicitly acknowledged in T 1652/08, T 572/14 and T 2197/11. While in these decisions it was concluded that the admittance of late filed evidence had been correct, the fact that the issue was discussed implied that there was a discretion in this respect. If the Board disagreed with this argument, a question should be referred to the Enlarged Board of Appeal, as it was clear that this was a fundamental point of law.

2.2 The Board maintains its position expressed in the preliminary opinion that there is no legal basis for disregarding the evidence on which the contested decision was based (Article 12(2) RPBA). In particular, Article 12(4) RPBA is not applicable, as this provision

is limited to amendments to the case, i.e. to documents which were not part of the contested decision. The provisions of Article 12(6) RPBA are also not applicable, because they relate to the Board's discretion to admit evidence not admitted at first instance if the decision to disregard the evidence was erroneous. The Board is not aware of other legal provisions that would justify disregarding evidence that was admitted and is part of the contested decision.

2.3 While decision T 2049/16 formulates the question of whether there is a discretion to overrule a decision to admit late filed evidence (Reasons 3.2), it then points out that G 7/93 concerns the overruling of a decision not to admit documents, and that the EBA did not intend to make a general statement to be applied to other situations. Indeed, this decision also contradicts the respondent's position when it concludes that overruling the admission of documents would be inconsistent with the principle of examination by the EPO of its own motion under Article 114(1) EPC. Moreover, as also pointed out in Reasons 3.2 of T 2049/16, if a document is admitted on the basis that it is considered to be *prima facie* relevant but it turns out that it is in fact not relevant, admitting the document would be unlikely to negatively affect proprietor's position.

2.4 The Board also notes that the fact that some decisions discussed the admittance of evidence that had already been admitted in first instance proceedings does not *per se* imply that there is a legal basis for overruling the admittance of late filed evidence. The argument made in these decisions is that "*even if there was a discretion ... the Board would still not overturn the decision to admit the evidence*", which simply implies

that said boards found it easier and/or more appropriate to confirm that the first instance had exercised its discretion correctly, than to address the question of whether the Board has a legal basis for overturning the exercise of discretion.

2.5 In view of the above considerations, the present board concludes that there is no basis for overruling a decision to admit late filed evidence by the first instance (cf. Case Law of the Boards of Appeal, 10th edition 2022, V.A.3.4.4).

2.6 Moreover, since there seems to be no divergence in the position of the different boards in this respect, the present board does not see any reason to refer a question to the Enlarged Board.

2.7 It follows that documents D30, D30a (i.e. the public prior use P4) and D32 are part of these proceedings.

3. Admittance of other late filed facts and evidence

3.1 The appellant submitted new documents D59 to D63 with the grounds of appeal and requested that D34, D47, D48, D50, D51, D52, D53 and D54 be excluded from the appeal proceedings.

3.2 The respondent submitted new document D64 with the reply to the appeal and requested that, on top of D30, D30a and D32 (see discussion above), D57, D59, D62 and D63, as well as the new objections regarding other causes for improved runnability, not be admitted into these proceedings.

3.3 The Board first notes that none of documents D59 to D64 filed at the appeal stage were decisive for the outcome

of the proceedings, so there is no need to decide on their admittance.

3.4 Documents D47, D48, D50, D51, D52, D53 and D54 were also not relevant for the underlying decision, so there is no need to decide on their admittance.

3.5 Documents D34 and D57 are cited in the present decision but only to indicate that the results in these reports are coherent with the information in the patent. They were thus not decisive for the outcome of the proceedings, so there is also no need to decide on their admittance.

3.6 The allegedly new objections concerning an improved runnability did also not affect the outcome of the proceedings so there is no need to decide on their admittance.

3.7 The respondent requested that the case be remitted to the first instance to discuss the admittance of some of these late filed facts and evidence, but as indicated at the oral proceedings, the Board does not consider that the admittance of late filed evidence or facts represents a special reason which would justify the remittal of the case under Article 11 RPBA. Moreover, as indicated above, none of these facts and evidence was decisive for the outcome of the proceedings, so there is no reason to remit the case on this ground.

4. Admittance of auxiliary requests

4.1 The appellant requested that a number of auxiliary requests not be admitted into the proceedings. As only auxiliary request 7 is relevant for the outcome of

these proceedings, the Board will restrict the discussion to the admittance of this request.

- 4.2 The appellant argued that auxiliary request 7 should have been filed during the opposition proceedings, and furthermore lacked a proper reasoning within the meaning of Article 12(4), second paragraph, RPBA.
- 4.3 As to the first argument, the Board would like to stress that since the opposition was rejected, there was no need for the patentee to file auxiliary requests before the opposition division, and a request filed at the beginning of the appeal proceedings cannot be rejected solely on the ground that it should have been submitted earlier (cf. T 141/20, headnote; T 1758/21, Reasons 7.4 and T 2202/21, Reasons 2.2.6). As regards the lack of reasoning, the contested wording is a simple clarification and does not change the subject matter under discussion. The Board therefore considers that the reasoning given in the respondent's reply is sufficient, and sees no reason not to admit auxiliary request 7 into the proceedings.
5. Content of prior use P4
 - 5.1 P4 consists of a declaration (D30) by an employee of "Ahlstrom-Munksjö La Gère" accompanied by exhibits 2a to 2j (D30a) including data sheets, invoices and internal documents. The prior use concerns a release liner known as "Silca Classic Blue 59g" which was (allegedly) manufactured and sold by the above cited company since 2012 without any restriction or obligation of confidentiality.
 - 5.2 The opposition division considered it established that a release liner containing hardwood Bleached

Chemithermomechanical Pulp (hereinafter "BCTMP") and chemical pulp, and having a density (and therefore a grammage to thickness ratio) within the claimed range, had been made available to the public before the priority date of the patent.

- 5.3 At the appeal stage, the appellant filed two further documents relating to the prior use, namely D62: an unredacted version of exhibit 2f purporting to show the number of bales of each of the pulps used in the production of the release liner, and D63: a new declaration by the same employee who drafted D30, interpreting the meaning of the numbers shown in D62 and indicating the implied concentrations of the different types of pulp used to make the release liner.
- 5.4 The respondent argued that there was not sufficient evidence on the pulp composition of the release liner of the public prior use P4, as the references to "MILLAR WEST" and "ST GAUDENS" in exhibit 2f could potentially refer to any of the many types of pulps offered by these companies. The additional information in D62 and D63 was late filed and should not be admitted. In any case, these documents did not establish beyond reasonable doubt the pulp content of the release liner.
- 5.5 The Board notes that exhibit 2f appears to be only part of the overall body of evidence provided by the appellant, and is mainly intended to establish a link between the invoices, the release liner and the lot production n° 606016. In the Board's view, this exhibit should be read in combination with the statements in the affidavit D30 and with the invoices 2c and 2d.

5.6 While neither D30 nor the exhibits in D30a disclose the exact content of the pulp used to obtain the release liner "Silca Classic Blue 59g", points 2 to 4 of D30 directly indicate that said release liner includes Aspen (i.e. hardwood), BCTMP ("Millar West") and bleached chemical pulp ("St. Gaudens"). In addition, given the grammage (i.e. "Basic weight") and caliper of the release liner disclosed in exhibit 2j, P4 also anticipates a density equal to or less than 1200 kg/m^3 and a grammage to thickness ratio equal to or higher than 1.0 as defined in claim 1 at issue. The Board thus concludes that D30 and D30a (i.e. P4) provide evidence that a release liner including hardwood BCTMP and bleached chemical pulp, and having a density and a grammage to thickness ratio falling within the scope of the invention, was made available to the public before the priority date.

6. At the oral proceedings, the Board concluded that claim 1 of the main request was not novel and that auxiliary request 1 infringed Article 123(2) EPC. The discussion then focused on inventive step of auxiliary requests 2 to 6, but the Board concluded that the finding that these requests were obvious starting from the public prior use P4 also applied to the higher ranking requests. For the sake of simplicity, the present decision will therefore focus on inventive step only.

7. Auxiliary request 2 - Inventive Step

In the board's view, the requirements of Article 56 EPC are not met for the following reasons:

7.1 Claim 1 relates to a low weight paper suitable for use as a release liner. According to the patent (par. [0007]), the addition of BCTMP to a bleached chemical

pulp provides an increased bulk while maintaining a desired ratio between grammage and thickness in order to prevent the problems associated with excessively low grammage.

7.2 Closest prior art

For the board, any one of D1, D32 or the public prior use P4 (i.e. D30 and D30a) represents a valid starting point for the assessment of inventive step, but as indicated at the oral proceedings, the public prior use P4 is regarded as the most promising springboard, as the subject-matter of claim 1 at issue differs from the release liner in P4 only in that the BCTMP includes 1-50 wt.% of softwood.

7.3 Problem solved by the invention

7.3.1 According to the patent (pars. [0009] and [0011]), the use of BCTMP containing hardwood and softwood provides a number of technical effects, such as improving the manufacturing process, reducing brittleness and increasing the internal bond strength of the paper. Examples 1 and 2 of the patent compare processes using BCTMP made of hardwood and BCTMP including both hardwood and softwood, and conclude that the addition of softwood BCTMP contributes to maintaining the paper properties after several hours of a paper manufacturing process (see figures 3a-3c and 4a-4c). The subsequently filed test report D34 indicates that the incorporation of softwood BCTMP also increases the tensile stiffness of the paper.

7.3.2 According to the respondent, the patent demonstrated that the addition of softwood BCTMP provided certain technical effects regardless of the respective amounts

of BCTMP in the pulp or softwood in the BCTMP. In particular pars. [0009] and [0011] of the patent indicated that BCTMP including both hardwood and softwood improved the manufacturing process, the internal bond strength and reduced the brittleness, and that amounts as low as 1 wt.% had been observed to improve the paper manufacturing process. Pars. [0098] and [0099] of the patent referred to the drawbacks observed in the manufacturing process of paper with BCTMP containing only hardwood, in particular during the refining process. These problems were solved, as indicated in par. [0103], by using a BCTMP including both hardwood and softwood. No reference was made in these passages to the amounts of hardwood and softwood, so it was apparent that the effects were achieved with the incorporation of softwood BCTMP in any amount.

- 7.3.3 The Board is not convinced that the information in the patent or in the subsequently filed test reports demonstrates that the addition of any amount of softwood would achieve a specific technical effect over the entire claimed range for the following reasons:

The problems in the manufacturing process resulting from the use of BCTMP hardwood are illustrated by comparing the results in examples 1 and 2 of the patent (see also figures 3a-c and 4a-c), further explained in par. [0074]. As the appellant noted, this passage specifies that these problems occur when the BCTMP concentration in the pulp mixture is 10 wt.% or higher.

The passages in pars. [0009] and [0011] of the patent indicate that the use of the BCTMP with hardwood and softwood would give rise to multiple beneficial effects, but the actual evidence for such effects is first provided in examples 1 and 2 cited above. The

discussion of the disadvantages of using hardwood BCTMP in pars. [0098] and [0099] refers back to the experimental results in figures 3a-3c and 4a-4c (i.e. examples 1 and 2) which, as clarified in par. [0074], relate to the problems of the manufacturing process when the BCTMP content is equal to or higher than 10 wt.%. Moreover, the discussion in par. [0099] concerns specific types of pulps (aspen, birch, etc), indicating in particular that while aspen pulps are quick to refine and form a dense and smooth paper, longer fibres such as birch (which is actually also a hardwood) can increase the paper strength. Otherwise, this passage simply stresses that using only aspen fibres can lead to problems in the retention capability of fine particles, which again seems to be a reference to the observations made in the comparison between examples 1 and 2 and the explanations in par. [0074].

Furthermore, as argued by the respondent himself, the alleged improvements in terms of some physical properties of the paper resulted from the improvements in the manufacturing process. It follows that the multiple alleged technical effects of adding softwood to the BCTMP ultimately relate to a single technical effect, namely the improvement of the manufacturing process.

Even if, for the sake of argument, it was accepted that some effects could be achieved with BCTMP concentrations as low as 1 wt.%, as described in par. [0011] of the patent the question would still remain as to whether such an effect would be observed for any concentration of softwood in the BCTMP. Report D34 submitted by the appellant only examines two alternatives: i) either low BCTMP concentrations in the pulp (3 wt.%) combined with high softwood concentration

in the BCTMP (25 wt.%) or ii) high BCTMP concentration in the pulp (30 wt.%) combined with multiple softwood concentrations in the BCTMP (5 to 25 wt.%). There is thus no test carried out with both low BCTMP concentrations in the pulp and low softwood concentration in the BCTMP, and the only experiment with low BCTMP concentration uses a softwood concentration which is significantly higher than the bottom end value of 1 wt.% defined in claim 1 at issue. Even with such a high concentration of softwood, the difference in stiffness compared to the use of BCTMP including only hardwood is less than 3%, which cannot, as noted by the appellant, be considered a statistically significant improvement.

The Board therefore concludes that there is no basis in the patent or the subsequently filed test reports to conclude that an effect would be achieved with both low concentrations of BCTMP in the pulp/paper and low concentrations of softwood in the BCTMP. This conclusion is coherent with the results in D57 (from the appellant), according to which no worsening of the paper properties was observed after several hours with a pulp containing a concentration of BCTMP of 7 wt.% including only hardwood.

As no specific technical effect has been demonstrated for the combination of low BCTMP concentrations in the pulp/paper and low softwood concentrations in the BCTMP, the problems proposed in the patent are not considered to have been successfully solved and need to be reformulated in a less ambitious way, namely to provide an alternative paper suitable for use as a layer of a release liner.

7.4 Obviousness

7.4.1 Documents D7, D8 and D9 (see par. [0028]) propose using BCTMP including both hardwood and softwood as part of the pulp mixture to promote certain properties of the paper.

7.4.2 The respondent argued that there was no incentive to add the BCTMP mixture according to any one of D7, D8 or D9 to the pulp mixture of P4, because none of these prior art documents related to release liners. In fact, some of the properties allegedly achieved with the BCTMP in those documents would be detrimental for release liners, such as the increased opacity in D8. Moreover, the degree of refining in the BCTMP pulps of D8 and D9 was much higher and thus incompatible with that in P4, so a skilled person would not consider incorporating these BCTMP mixtures into the pulp mix of the prior use. D7 concerned a BCTMP with a low degree of refining, but the proposed concentration of softwood in this document was either outside the scope of the claim (75 wt.%) or at the very edge of the claimed range (50 wt.%). The subject-matter of claim 1 was thus not rendered obvious by P4 alone or in combination with any one of D7, D8 or D9.

7.4.3 The Board first notes that since the only problem solved by the invention is that of proposing an alternative paper, there is no need to demonstrate that the pulps in D7, D8 or D9 would be particularly advantageous for the paper in P4. Instead, it suffices to show that the solution proposed in claim 1, which involves the incorporation of BCTMP including softwood in an amount of 1-50 wt.%, would represent a known alternative to the fibres proposed in P4.

Even if, for the sake of the argument, it was accepted that the pulps in D8 and D9 would not be suitable for the paper in P4, there would be no reason to disregard the use of BCTMP including softwood and hardwood according to D7, as at least one of the alternatives in this document, namely the 425/83/50 grade BCTMP containing 50 wt.% softwood, falls within the scope of the BCTMP mix proposed in claim 1 at issue. This alternative is not only of a similar grade to the BCTMP in P4, but also offers comparable or even improved properties (see for example higher bulk and tensile strength values). The fact that this BCTMP mix is presented as suitable for printing papers is irrelevant for several reasons: first, claim 1 at issue defines a "paper suitable for use as a layer of a release liner", a formulation which is only restricted in terms of suitability and which only concerns a layer of the release liner. Second, the fact that the pulp in D7 leads to properties similar to those obtained with the BCTMP in P4 (see exhibit 2a) suggests to the skilled person to substitute the one with the other. Furthermore the BCTMP used in P4 is also presented as suitable for printing and writing paper (see exhibit 2a in D30a), which further reinforces the argument that a skilled person would consider the BCTMP mixture in D7 as an obvious alternative to the one used in P4.

- 7.4.4 In view of the above considerations, the Board concludes that a person skilled in the art starting from the release liner in P4 and looking for alternative papers would consider the teachings in D7, and in doing so would arrive at the claimed subject-matter without exercising any inventive skill.
- 7.5 The subject-matter of claim 1 at issue is thus obvious, and so not inventive in view of P4 combined with D7.

8. Main and first auxiliary requests - Inventive step

Since the subject-matter of claim 1 as granted (main request) and that of auxiliary request 1 is broader than that of claim 1 of auxiliary request 2, the arguments and conclusions set out above also apply to these requests, which are therefore also not inventive in view of P4 in combination with D7.

9. Auxiliary request 3 - Inventive step

9.1 Claim 1 at issue further restricts the amount of softwood in the BCTMP to the range 5-45 wt.% (vs. 1-50 wt.% in auxiliary request 2).

9.2 Since the thus claimed subject-matter still encompasses embodiments with low amounts of BCTMP in the pulp and of low amounts of softwood in the BCTMP, the alleged invention still covers embodiments which would not provide any specific technical effect with respect to the paper in P4 (see discussion above). In particular, claim 1 at issue encompasses embodiments with any concentration of BCTMP in the pulp and with 5 wt.% softwood in the BCTMP, i.e. a value 5 times lower than the amount of 25 wt.% shown to have an almost insignificant effect in D34. The invention according to this request is therefore considered not to provide any special technical effect and, as was the case in auxiliary request 2, to solve the problem of proposing an alternative paper.

9.3 Since in the present case the amount of softwood in the BCTMP is 5-45 wt.%, this is not anticipated by the BCTMP containing 50 wt.% softwood according to D7. The Board however considers that the skilled person would arrive without exercising inventive skills at the

claimed subject-matter in view of the respective amounts of 25 wt.% softwood in the BCTMP proposed in D8, or of 0-30 wt.% disclosed in D9 (par. [0027]). Even though, as argued by the respondent, the grade of the BCTMP in D8 and D9 is different from that in P4 and (in the case of D8) is said to increase the opacity, as indicated in above, the skilled person would contemplate any known alternative as long as it provides the desired function, irrespective of whether it is more or less advantageous. The Board therefore considers that the BCTMP amounts in D8 and D9 are known and appropriate alternatives to that known from P4, so that the skilled person would consider them individually as an obvious option when exploring alternative papers. Concerning the further features in claim 1 at issue, the same arguments and conclusions as those presented for auxiliary request 2 apply to this request. It follows that the subject-matter of claim 1 at issue is obvious in view of P4 in combination with D8 or D9 and thus does not involve an inventive step within the meaning of Article 56 EPC.

10. Auxiliary requests 4-6 - Inventive step

10.1 In claim 1 of these requests the amounts of BCTMP in the pulp/paper and softwood in the BCTMP are more or less restricted. In auxiliary request 4, the amount of BCTMP in the pulp/paper is less than 50 wt.% and the amount of softwood in the BCTMP is equal to or higher than 1 wt.%. In auxiliary request 5, these ranges are restricted respectively to 1-50 wt.% and 5-45 wt.%, and in auxiliary request 6 to 5-45 wt.% and 1-50 wt.%, so that the subject-matter of claim 1 in all these requests encompasses embodiments with low concentrations of BCTMP in the pulp (namely higher than 0 wt.% in auxiliary request 4, 1 wt.% BCTMP in

auxiliary request 5 and 5 wt.% BCTMP in auxiliary request 6).

10.2 As concluded in the discussion in point 7.3.3 above, the only effect associated with the addition of softwood to the BCTMP mixture is to overcome the problems observed when the BCTMP amount in the pulp is 10 wt.% or higher. Since claim 1 at issue still encompasses pulps with BCTMP concentrations lower than 10 wt.%, the same argumentation and conclusions presented for auxiliary requests 2 and 3 apply to these requests, so that auxiliary requests 4 and 6 are thus not considered to involve an inventive step in view of P4 combined with D7, and auxiliary request 5 is not considered to be inventive over P4 combined with D8 or D9.

11. Auxiliary request 7 - Article 123(2) EPC

11.1 Claim 1 of this request corresponds to claim 1 as filed, with the additional features that: "*... the amount of cellulose fibers from bleached chemithermomechanical pulp in the paper is in the range of 10-35 wt.-% of the weight of the paper, and the amount of softwood (SW) in the bleached chemithermomechanical pulp (BCTMP) is in the range of 5-45 wt.-% of the weight of the bleached chemithermomechanical pulp.*"

11.2 The appellant argued that there was no basis in the application as filed for said amendment, for which multiple selections from different lists were necessary.

11.3 The Board notes that the ranges of 10-35 wt.-% of BCTMP in the paper and 5-45 wt.% of softwood in the BCTMP are

respectively defined in claims 9 and 14 as filed. In particular, the range of 10-35 wt.% being the most preferred alternative in claim 9 as filed, it is not considered to be a selection from a list. The amendments in claim 1 at issue therefore merely require a single selection from the list of alternatives in claim 14 as filed, so that the subject-matter of claim 1 derives directly and unambiguously from the content of the application as filed.

11.4 Even if, as argued by the respondent, the amendments in claim 1 at issue were considered to be based on two selections from lists, these would amount to selections from lists of converging alternatives in the sense of T 1621/16. According to this decision, amendments based on multiple selections from lists of converging alternatives do not necessarily lead to the singling out of an undisclosed combination of elements, as they generally involve selecting more or less preferred forms of certain features, namely the ranges for the amounts of BCTMP in the paper and of softwood in the BCTMP).

11.5 In the case at issue, the criteria to assess compliance with Article 123(2) EPC proposed in T 1621/16 (see Headnote) are clearly fulfilled, because:

- i) there is no undisclosed association of the combination of ranges with a specific technical contribution, as the claim does not define a technical effect, and
- ii) example 2 provides a pointer to the combination of features, because it falls within the scope of claim 1.

11.6 The Board thus concludes that the subject-matter of claim 1 at issue finds support in the combined subject-

matter of claims 1, 9 and 14 as filed, and therefore meets the requirements of Article 123(2) EPC.

12. Auxiliary request 7 - Inventive step

12.1 Claim 1 at issue differs from that of auxiliary request 2 in that the amount of BCTMP in the paper is 10-35 wt.% and the amount of softwood in the BCTMP is 5-45 wt.% (instead of 1-50 wt.%).

12.2 Problem solved by the invention

Since the amount of BCTMP in the paper is now at least 10 wt.%, the arguments brought forward in point 7.3.3 above do no longer apply. In particular, examples 1 and 2 of the patent now provide evidence that a paper according to the claimed invention would have the effect of improving the manufacturing process. This is not contradicted by the test report D57 because, as also explained in the discussion of the problem solved for claim 1 of auxiliary request 2, the experiments were carried out at a BCTMP concentration of 7 wt.%, i.e. below the minimum of 10 wt.% defined in claim 1 at issue and presented in the patent (par. [0074]) as the key value for the worsening of the paper properties during the manufacturing process. The invention is thus considered to successfully achieve the technical effect of improving the manufacturing process, so the problem solved is to provide a paper with an improved manufacturing process.

12.3 Non-obviousness of the solution

12.3.1 The Board notes that there is no indication in either D7, D8 or D9 that the use of BCTMP including softwood and hardwood would improve the paper manufacturing

process, so a skilled person would have no incentive to contemplate the teachings in these documents for solving the underlying technical problem. Even though D7, D8 and D9 refer to certain advantageous effects of using a BCTMP including softwood and hardwood (e.g. higher paper strength or bulk), such effects are said to be the result of replacing kraft pulps, and there is no indication that they would still be achieved when the BCTMP including softwood and hardwood is incorporated into a paper which already includes hardwood BCTMP, or when it is used to replace said hardwood BCTMP.

- 12.3.2 Even if the skilled person considered combining P4 with the pulps of one of the cited prior art to solve the underlying technical problem, it would select the BCTMP blends in D7 as they are the most compatible with the BCTMP fibres in P4 in terms of refining grade. However, this combination would not lead to the claimed invention because the BCTMP in D7 does not fall within the scope of claim 1 at issue, which now requires a maximum softwood concentration in the BCTMP of 45 wt% (versus 75 wt% and 50 wt% for the BCTMP in D7).
- 12.3.3 The subject-matter of claim 1 is thus not rendered obvious by P4 alone or in combination with the cited prior art documents D7, D8 or D9.
- 12.3.4 The same conclusions would be reached starting from D32 or D1, because these documents also do not anticipate the use of BCTMP including softwood and hardwood and there is no teaching in the rest of the prior art that adding softwood to BCTMP would solve the problem of improving the papermaking process.

12.4 The subject-matter of claim 1 therefore involves an inventive step and so meets the requirements of Article 56 EPC.

13. It follows that none of the objections raised by the opponent prejudices the maintenance of the patent on the basis of the claims according to auxiliary request 7.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in amended form on the basis of the claims of auxiliary request 7 filed with the reply of 9 August 2022 to the statement of grounds of appeal, and a description to be adapted where appropriate.

The Registrar:

The Chairman:



A. Pinna

J.-M. Schwaller

Decision electronically authenticated