

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 1 October 2024**

Case Number: T 0596/22 - 3.3.06

Application Number: 13197516.1

Publication Number: 2884001

IPC: D21H27/00, B31F1/07, D21H27/02

Language of the proceedings: EN

Title of invention:
Improvement in cylinder for tissue paper lamination

Patent Proprietor:
Rolltec Cilindro LTDA

Opponent:
Kimberly-Clark Worldwide, Inc.

Headword:
TISSUE PAPER LAMINATION/ROLLTEC

Relevant legal provisions:
EPC Art. 123(2), 123(3)

Keyword:
Amendments - extension beyond the content of the application
as filed (main request, yes) - extension of the protection
conferred (auxiliary request, yes)

Decisions cited:

G 0001/21, J 0006/22

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0

Case Number: T 0596/22 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 1 October 2024

Appellant:
(Patent Proprietor)

Rolltec Cilindro LTDA
Rua Santa Vitoria, 455
Cumbica
Guarulhos (BR)

Representative:

Manresa Medina, José Manuel
Manresa Industrial Property Netherlands B.V.
Weena 43C
3013 CD Rotterdam (NL)

Respondent:
(Opponent)

Kimberly-Clark Worldwide, Inc.
2300 Winchester Road
Neenah WI 54956 (US)

Representative:

Dehns
10 Old Bailey
London EC4M 7NG (GB)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 3 January 2022
revoking European patent No. 2884001 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman J.-M. Schwaller
Members: R. Elsässer
C. Heath

Summary of Facts and Submissions

I. The appeal of the proprietor lies against the decision of the opposition division to revoke European patent EP 2 884 001, because granted claim 1 was held not to meet the requirements of Article 123(2) EPC. Further, the first and second auxiliary requests were not admitted into the proceedings as not *prima facie* allowable.

II. Granted claim 1 reads as follows:

"1. Method for tissue paper lamination, that combines DESL process (1), and Point to Point process (2), wherein the first paper layer (3) passes through its respective first embossing cylinder (5, 14) comprising elements of cylinders, the second paper layer (4) passes through its respective second embossing cylinder (6, 15, 22), the two paper layers (3, 4) jointly operate with calendering rolls (7, 8, 16, 17) and other sizing rollers (10, 18), wherein after the embossing of the first and second paper layers (3, 4), the said layers (3, 4) overlap, characterized in that the second embossing cylinder (22) comprises combination of higher elements (23) for DESL process and lower elements (24) for Point to Point process, wherein top surfaces of the relief formed by lower elements (24) of second embossing cylinder (22) are glued to the top surfaces of the relief formed by the elements of the first embossing cylinder (5, 14) such that reliefs formed by the elements of the first embossing cylinder are fitted with the reliefs formed by higher elements (23) of the second embossing cylinder (22) forming several reliefs on paper surface composing figures, ribbing and all sorts of drawings."

- III. With its grounds of appeal, the appellant filed a new auxiliary request and argued that granted claim 1 did not extend beyond the original disclosure. It also argued that the first instance proceedings were marred by several substantial procedural violations.
- IV. With its reply, the opponent and respondent argued that the decision of the opposition division concerning the main request was correct and that the auxiliary request was *inter alia* not allowable under Article 123(3) EPC.
- V. At the oral proceedings held on 1 October 2024, the above issues were discussed and the final requests of the parties were established as follows:

The appellant requested to set aside the contested decision and to remit the case to the opposition division for further prosecution, or as an auxiliary measure, to maintain the patent as granted or, alternatively, to maintain the patent in amended form based on the claims according to the auxiliary request filed with the grounds of appeal.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. Main request - Article 123(2) EPC

The board has come to the conclusion that granted claim 1 does not meet the requirements of Article 123(2) EPC.

- 1.1 The claimed subject-matter concerns a method for tissue lamination that combines two known processes, namely the DESL process and the Point to Point process. The claim then recites features of two embossing cylinders

used in the combined process and several of its method steps, *inter alia* the one of glueing two embossed paper layers together.

- 1.2 The board observes that there is no detailed disclosure of the combined process in the application as filed. The method steps recited in claim 1 as filed (lines 5-19) in fact do not relate to a combined process but to the prior art processes, namely the DESL process (lines 5-12), on the one hand, and the Point to Point process (lines 12-19), on the other hand. This is not only evident from the wording of the claim but can also be derived from the description where the DESL process is described on page 3, lines 59-67 and in figures 1A and 1B, while the Point to Point process is described on page 3, line 70-page 4, line 78 and in figures 2A and 2B), in both cases using nearly the identical wording as in claim 1.
- 1.3 With regard to figure 3, which shows an embossing cylinder (22) according to the invention, no paper layers are shown, let alone whether glue is used in their lamination. Furthermore, many of the components mentioned in granted claim 1 are neither shown in said figure nor are they mentioned in the corresponding passages of the description.
- 1.4 It is true, as argued by the appellant, that corresponding steps and/or components are originally disclosed in the context of the individual DESL process and/or of the individual Point to Point process. For instance, claim 1 as filed discloses that in the Point to Point process, two paper layers are first embossed and then their protruding (male) elements are glued together at the top. It is also true that the application as filed discloses that the embossing

cylinder of the invention combines the DESL and the Point to Point processes.

However, this statement is vague and does not directly and unambiguously define or disclose which aspects of the respective processes are present in the combined process of the invention and how they interact.

For example, the fact that a glue lamination step is disclosed for the Point to Point process does not directly and unambiguously disclose that a process that "combines" this process and the DESL process will also comprise this step, in particular in view of the fact that for the DESL process, it is not disclosed that the layers are laminated together, let alone by glueing, so that a combined process might just as well resemble the DESL process in this regard.

- 1.5 The appellant argued that it would be very easy for a skilled person who knows the DESL and the Point to Point methods and who sees figure 3 to know how the cylinders shown in the figure would work. This is not disputed by the board, but this argument basically confirms that the combined method is not as such disclosed in the application as filed but must be devised in the mind of the skilled reader.
- 1.6 The appellant further argued that no subject matter is added by the change of the claim category. This argument is however irrelevant because the issue at stake is not the change of category to a method claim, but the incorporation therein of method steps which are not disclosed as such in the application as filed.
- 1.7 And already for this reason, the subject-matter of claim 1 as granted is not directly and unambiguously

derivable from, and so extends beyond, the original disclosure of the application as filed, and so does not meet the requirements of Article 123(2) EPC.

2. Alleged procedural violations

2.1 The appellant has argued that at the oral proceedings before the opposition division, the opponent presented new arguments, facts and grounds that had not been presented in writing. It stated having requested the division to reject any objections that were not explicitly indicated in the notice of opposition, including those of lack of clarity and of an intermediate generalisation. However, neither did the opposition division allow this request, nor did they give any reason in the decision as to why this request was not allowed. This violated the proprietor's right to be heard and was also in breach of the obligation to provide a reasoned decision.

Moreover, accepting arguments which had been presented only orally was in conflict with the principle laid out in **G 1/21** that proceedings before the EPO were mainly in writing.

The appellant further put forward that it was not given enough time to come up with a suitable defence against the new attacks.

Thus, the division committed several procedural violations, including a violation of the right to be heard, a failure to give a fully reasoned decision and a failure to ensure a fair trial.

2.2 In the board's view, none of these arguments is convincing for the following reasons.

- 2.2.1 According to Article 113(1) EPC, the right to be heard requires that decisions should only be based on grounds or evidence on which the parties had an opportunity to comment.

In the present case, the decision is exclusively based on grounds and facts that had already been raised under points 3 to 6. of the grounds for opposition, where the opponent pointed out that, while the application as filed disclosed details of the processes of the prior art (DESL and Point to Point) and details of the roller of the invention, it however failed to disclose the details of the combined method as claimed.

As the decision (page 3) is in essence based on this objection only, and not on any ground on which the proprietor did not have an opportunity to comment, it is manifest that its right to be heard has not been violated and the decision is thus in conformity with Article 113(1) EPC.

- 2.2.2 The appellant also takes issue with the fact that an objection of lack of clarity was presented for the first time at the oral proceedings and that the opposition division "accepted" this objection against the proprietor's explicit request. The same applies to the objection of an alleged unallowable intermediate generalisation that had also been raised for the first time at the oral proceedings.

The board observes in this respect that even if the division did "accept" these objections in the sense that they were admitted into the proceedings, the decision is not based on them so that their admission cannot be seen as a violation of the right to be heard. Furthermore, is it not manifest that the division's

"acceptance" of the new objections had any bearing on the outcome of the case.

- 2.2.3 The appellant appears also to allege that the decision is nevertheless *indirectly* based on or was *indirectly* influenced by these new objections because they caused the division to reverse its positive preliminary opinion.

In the board's view, this allegation remains in the realm of speculation. As can be seen from the decision, it appears that the division only considered the objections under Article 123(2) EPC set out in the grounds of opposition, and after the hearing they came to a conclusion that differed from the preliminary opinion. But the mere fact that the opposition division changed its mind at the oral proceeding is no proof that it took into account new facts ; it is well possible that, for instance, it had not properly understood the opponent's arguments presented in writing or that its oral presentation was more convincing. In any case, parties cannot base any expectations on a preliminary opinion, be it of an opposition division or of a Board, as such an opinion is only provisional and can be different from the final conclusions in the decision, even if the underlying facts are the same.

While an opposition division in general tends to give reasons as to why it deviates from the preliminary opinion, this is not a requirement for a reasoned decision. Rule 111(2) EPC stipulates that decisions must be reasoned, which in this case means that the division had to indicate the reasons as to why it had come to the conclusion that the requirements of Article 123(2) EPC were not met. This requirement is fulfilled,

see above.

- 2.2.4 With regard to the argument based on **G 1/21**, for the board this decision is not relevant to the present case as dealing with the question whether oral proceedings before the boards of appeal can also be held by videoconference. Apart from not being applicable to the case at hand, neither the passages cited by the appellant nor any other part of this decision can be interpreted as a bar to presenting new arguments during oral proceedings, be it before a Board of Appeal or before the first instance. Thus, there is also no need or reason for a referral to the Enlarged Board.

In this context, it can also be noted that Article 114(2) EPC provides for late filed facts and evidence to be disregarded, but not arguments. If indeed nothing new could be presented during oral proceedings, it would be questionable which purpose such time consuming proceedings would serve. The importance the EPC has given to oral proceedings is evidenced by the fact that parties have a right to request them. Oral proceedings are not merely of a discretionary nature. Should decision **J 6/22** of 26 July 2023, in particular paragraphs 50 to 53, take a different stance in this regard, this is not followed by the Board. Rather, they must be viewed as an integral part of the judicial exercise of decision-making. While it is true that oral proceedings are always held after the preparatory written phase of a case, they are not a mere appendix to the written proceedings, but the time and place where the parties' arguments are put to the test by direct discussion, by argument and counterargument.

- 2.2.5 The Board further finds no evidence on file for the allegation that after the main request was held not

allowable, the proprietor was not given sufficient time to react. Much more, according to the minutes, the proprietor asked for and was given an interruption of one hour to prepare new auxiliary requests.

- 2.2.6 Finally, it is correct that, while the minutes state that the division decided to reject the proprietor's request not to allow the opponent's new arguments presented at the oral proceedings, no reasons for this rejection are given in the decision.

But even if *arguendo* this omission could be classified as a procedural violation in the sense of Rule 111(2) EPC, it is not a substantial one since it had no bearing on the outcome of the proceedings. As set out above, the decision is not based on new grounds or facts. Furthermore, the new lines of attack, whether allowed or not, had no bearing on the outcome of the decision, which is exclusively based on grounds and facts raised in the written procedure, and not on the different ones allegedly presented for the first time during oral proceedings. The division could thus even leave open the question whether or not to admit these new attacks.

A reasoned decision on the question of the admission of the allegedly new lines of attack would thus not have altered the reasons on which the revocation of the patent was based. In other words, the decision is not based on this alleged procedural defect so that the opposition division did not commit a substantial procedural violation which would justify a remittal of the case to the first instance.

3. Auxiliary request

For the board this request, with claim 1 reading as follows:

"1. An embossing cylinder (22) for tissue paper lamination process, that process combining DESL process (1), and Point to Point process (2), wherein, the first paper layer (3) passes through its respective first embossing cylinder (5, 14) comprising elements of cylinders, the second paper layer (4) passes through its respective second embossing cylinder (6, 15, 22), the two paper layers (3, 4) jointly operate with calendering rolls (7, 8, 16, 17) and other sizing rollers (10, 18), wherein after the embossing of the first and second paper layers (3, 4), the said layers (3, 4) overlap, characterized in that the second embossing cylinder (22) comprises combination of higher elements (23) for DESL process and lower elements (24) for Point to Point process, wherein top surfaces of the relief formed by lower elements (24) of second embossing cylinder (22) are glued to the top surfaces of the relief formed by the elements of the first embossing cylinder (5, 14) such that reliefs formed by the elements of the first embossing cylinder are fitted with the reliefs formed by higher elements (23) of the second embossing cylinder (22) forming several reliefs on paper surface composing figures, ribbing and all sorts of drawings."

is not allowable under Article 123(3) EPC for the following reasons.

- 3.1 The above amended claim 1 is directed to an embossing cylinder for a specific tissue lamination process which, according to established practice (see Case Law

of the Boards of Appeal, 10th edition, I.C.8.1.5), has to be interpreted as being an embossing cylinder suitable for carrying out said specific tissue lamination process, without however being limited to this specific process, since the claim is now directed to a physical entity, namely an embossing cylinder.

In contrast, granted claim 1 was directed to a specific process in which the above cylinder was used, so that its scope of protection included only this specific process. As other kinds of processes are now included, since no longer limited to said specific one, the scope of protection of the thus amended claim 1 of the auxiliary request is broader than that of claim 1 as granted, so that the proposed amendment is not allowable under Article 123(3) EPC.

- 3.2 The appellant argued that there was no extension of scope because said amended claim 1 was to be interpreted as being limited to the process mentioned in the claim, which was in essence the same as defined in granted claim 1.
- 3.3 The board cannot accept this argument, because such interpretation is not in agreement with the established practice of interpretation of product claims with purpose characteristics, see above. As an example, one might consider a hypothetical method in which a single paper layer is structured by passing it through a nip of the structured roller of claim 1 and a soft rubber roller. This method is manifestly not included in the scope of protection of granted claim 1 but would be included in the scope of protection of claim 1 of the auxiliary request, thereby showing an enlargement of the scope of protection.

4. It follows from the above considerations that none of the appellant's requests is allowable, so that the appeal cannot succeed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Pinna

J.-M. Schwaller

Decision electronically authenticated