Candidate's examination paper (Examination paper C/1992)

Notes to Examiner

1. Opposition must be filed today (A. 99(1)) unless today is a dies non.

2. On Client's Letter

   (a) I have been able to attack all of the claims - this will give maximum protection against infringement.

   (b) Added Subject Matter

   See Notice of Opposition for how I have treated this.

   (c) Deletion of Apparatus Claims

   Case Law and Guidelines state that subject matter can be reinstated if the deleted subject-matter has not been unconditionally abandoned.

   So you are quite right about what you say on abandonment. However, it is quite possible that Diacolor made no such unconditional abandonment, merely deletion and a suggestion of filing divisionals, which (Case Law holds) does not amount to the same thing.

   For the time being, I will attack all of Claims 4 to 6 on A. 123(2) grounds, but will inspect the file relating to this patent to see if the attack is justified by the comments made by the patentee. If it is not, I have other fall-back attacks on Claims 4-6

   N.B. Divisional applications cannot now be filed (R. 25) since parent patent is no longer pending.

   N.B. Also in regard to the official communications, lack of unity (A. 82) is not a post-grant grounds of rejection (G 1/91!).

   N.B. I should search to see if any divisionals were in any case filed.

   (d) Re: A5

   I make other comments on this document in my Opposition Statement.

   (i) Accelerated prosecution of our Present Opposition

   Notice This is certainly possible - it is a procedural right for all. However, we need effectively justified reasons for this. Being sued for infringement of another patent, where the subject-matter of the patent is distinguished from

the subject-matter of the present patent, woul
justify acceleration in itself I feel. Do you h
any further reasons for requiring acceleration?

(ii) Defence Against Infringements

(a) If an opposition has been filed against A5, can intervene (A. 105 EPC) by filing a notice of Intervention WITHIN THREE MONTHS (A. 105(1)) of the instigation of infringement proceedings.

N.B. Restitutio (A. 122) does not apply to missed opposition deadline (because only applies usually to patentee (G 1/86).

(b) Can otherwise apply to revoke under National Italian Law the Italian Patent (A. 138).

(c) Either way, you will need prior art to invalidate the patent. I can carry out searches.

(d) Of course, another defence against infringement is that you do not infringe! I can investigate.

(e) Other more minor defences possible (eg. Competition Law; lack of ownership of rights, etc.).

(e) Re: A7

You will see from my Opposition Statement that I feel A7 to be relevant. It does not show a prejudice so much as proves that the problem to be solved by the invention was already known (otherwise there may be thought to be inventive step in discovering a problem).

Age The age of the document can be useful evidence in inventive step. In this case, it works in our favour because it shows there has been a long-felt need; A8 (v. recent) has only just come to fulfil the need.

Notes to Examiner on my Opposition Statement

1. I have made no direct use of DE-A-3035060 acknowledged eg. in A1 because I cannot find any sufficiently pertinent disclosures.

2. Re: para 1 of my Opposition Statement.

Dependent on the content of EP-A-85420222.5 ("EP-IT"), Claim 3 may be entitled to priority. I shall assume (unless told otherwise) that it is not entitled, because this gives a broader possibility of attack.

Also, (see the Official Communication) Claims 4 to 6 may entitled to their priority date because IT 85 5 9688 may disclose the subject matter of these claims in its claims (w know it does not in the description and drawings). Again, I shall assume no entitlement.

3. Re: para 3(b).

As discussed above, this is possibly weak, but the worst it can do is to attract a correcting assertion from the Patent Proprietor.

4. I have made no direct use of A5 because of an absence of pertinent disclosures.

5. Re para 6, the opposed patent discloses a problem different for that in A7 (see pp. 1 and 2). However, the problem disclosed in A7 is the closest and most pertinent.

6. Re para 9, my first argument concerning Claim 3 (see T 37/82) is weak, because the problem to which Claim 3 is drawn can be reformulated by the proprietor. It puts the argument in as a line of defence against Claim 3 being entitled to its priority date.

Opposition Statement

1. Evidence relied on

(a) Publications

DE-A-2944000 (A3)
GB-A-2149322 (A4)
EP-A-0220995 (A5) (evidencing the content of EP-IT EP-A-85420222.5)
US-4793549 (A6)
FR-1438474 (A7)
"Information Leaflet" (A8)

(b) Other Evidence

Official Communication by EPO Examining Division concerning the Opposed Patent (A2)

2. Priority

The Opposed Patent (the "Patent") is not entitled to its date of priority for any of the Claims.

As regards Claims 1 and 2, EP-IT (EP-A-85420222.5) discloses the subject matter of these claims.

"Regarding Claim 1, EP-IT discloses a flexible tape as recited (p. 1, ll. 16-20 of A5, which acknowledges EP-IT), each frame being adhered to two parallel strips ("deux rubans de bande adhésive parallèles"). The adhesive has a peeling strength

such that it adheres more strongly to the strips than t frames (p. 2, ll. 23, 24 of A5). Regarding Claim 2, the s may be of paper (p. 2, l. 22 of A5)."

EP-IT has a priority date (08.07.85) more than twelve months earlier than the filing date of the Opposed Patent (11.07.86) and hence, by virtue of A. 87(1), since it is in respect of the same invention as Claims 1 and 2, these claims cannot be entitled to the priority. No recourse to A. 87(4) is possible for the patent proprietor, since EP-IT has been published. Reference is made to A2 to prove the above assertions.

It is asserted that Claim 3 is also not entitled to priority. I request to inspect the relevant files in order to prove this assertion, if true.

As regards Claims 4 to 6, these Claims are also not entitled to priority (A. 87 (1)) because the priority application (IT 85 59 688) to this present application contains no disclosure, at least in its description or drawings, of the subject matter of these claims. It is asserted that no subject matter in the claims of the Italian priority document is relevant either, but opportunity is requested to inspect the relevant documents to prove this assertion.

3. Added subject matter

(a) Claim 4 violates A. 123(2) and is hence not allowable. Claim 4 of the A1 Patent differs from the application as originally filed in that it omits disclosure of the "step-wise" and "stand-still" features. However, A1, p. 3, ll. 15ff describes these features as essential. According ... to decision T 269/85, omission of essential features violates A. 123(2) because it presents the skilled person with information (a wider scope of claim) not disclosed in the application as filed.

(b) Claims 4 to 6 violate A. 123(2) because the subject-matter of these claims was deleted during the prosecution of the application. Its reinstatement would violate A. 123(2).

4. State of the art

A3 is available under A. 54(2) because it was published on 14.05.81, before the filing date of A1.

The same is true for A4 (published on 12.06.85), A6 (published on 04.11.85), and A7 (published on 27.06.67).

As regards EP-IT, this document is available under A. 54(3) against all states of relevance (priority date = 08.07.85, published 14.01.87).

As regards A8, the prior art in this document is available under A. 54(2). Whilst it has a publication date of August 1986, it refers to sales (i.e. "use" in the sense of A. 54(2))

in June 1986, before the filing date of A1. Furthermore, A refers to even earlier use of materials whose adhesive laye is practically completely removable. Further evidence can be adduced on this point if necessary.

Claim 1

5. Novelty

Claim 1 lacks novelty in the light of EP-IT (see A5)(A. 54(3)). It has been shown in the section 2 above that EP-IT discloses all of the features of Claim 1.

6. Inventive step

Claim 1 lacks inventive step over A3 in conjunction with A7 and Common General Knowledge.

A3 discloses a flexible tape (see Fig. 1), each frame being lodged fixedly to two parallel strips ("3 + 5" in Fig. 1) by those strips. A3 does not disclose adhesion to each frame. Starting from A3 as the closest prior art, the objective technical problem to be solved by Claim 1 of the present invention is how to use adhesive strip attachment to the frames of a type where the adhesive does not leave traces on the frames.

This is clear from A7 (p. 1, lines 21-24). A1 is in the same technical field as A3.

However, it was common general knowledge that certain adhesive substances can be lifted off as item without leaving a trace (see eg. A8 - line 1) "Sie alle kennen ..."). Further evidence on this point can be adduced if necessary. Thus it would have been obvious for the skilled person to use an adhesive having such properties to solve this problem.

This is particularly clear from the third para of A8, which discloses a suitable adhesive band, which the skilled person would have found particularly obvious to use.

Hence Claim 1 lacks inventive step (A. 56).

Claim 2

7. Novelty

Claim 2 lacks novelty over EP-IT (see A5)(A. 54(3)).

It has been shown in Section 2 above that EP-IT discloses all of the features of Claim 2 as well as Claim 1 on which it is dependent.

8. Inventive step (A. 56)

The subject-matter of Claim 2 is known from A3 (see p. 2, ll. 12-14 which discloses that the bands may be made of paper).

Hence Claim 2 lacks inventive step over the disclosure of A3 in conjunction with A7 and common general knowledge.

Claim 3

9. Inventive step (A3)

It is known from A3 (Fig. St 1-4, p. 1, ll. 17-19 and Claim 1, eg.) to provide two further parallel paper strips ("2,4") ("paper" - see p. 2, ll. 11-14) covered with adhesive on the side facing the frames (see Fig. 2) located as specified (see Figs. 1 and 3), and that the superposed strips are releasably adhered to each other in spaces between the frames (see Fig. 2, and Claim 1).

Claim 3 is distinguished only in that the adhesive has a peeling strenght such that it adheres more strongly to the strips than to the frames. As is clear from A1(p. 2, ll. 17-20) the advantages of the s-m of Claim 3 is enhanced fixing and improved positioning, achieved by 2 paper strips. Hence the feature in Claim 3 concerning the adhesive does not contribute to the affording of this advantage, and can be ignored for the purposes of A. 56 (see T 37/82). The adhesive feature is to be considered within the routine competence of the skilled person.

Furthermore, this feature concerning the adhesive has already been shown to be obvious in the light of A7 and CGK for the first bands. It must also be obvious for the 2nd bands in view of its foreseeable technical advantages.

Hence Claim 3 (dependent on Claim 2) lacks inventive step over either A3 by itself or A3 in conjunction with A7 and CGK.

Claim 4

10. Inventive step

Claim 4 lacks inventive step over A4 in conjunction with A6 and common general knowledge. A4 discloses (p. 2, lines 7-9 and Fig. 1) a method for assembling flexible tape comprising means "rollers" to feed two parallel paper strips ("3"), which strips are provided with adhesive, and means (the rollers again) to deposit and press framed transparencies on to the strip, etc.

That the strips could be made of paper is of common general knowledge. The advantage given in the Patent for the feature is that one can write on it (p. 2, ll. 15-16). This is a foreseeable technical advantage and hence the "paper" feature

is obvious. In addition, Claim 6 implies the strips need in any case not be of paper.

Faced with the apparatus of A4, a problem which would clearly occur in use is how to incorporate this apparatus into a functioning conveyor belt system (see, eg. A4, p. 1, lines 17ff or A6, p. 1). A6, is in a closely related technical field to A4 (it has a similar IPC and deals with precisely the same problem as A4, discloses the solution to this problem).

A6 discloses (p. 1, ll. 27-31) and the drawings/apparatus for feeding framed transparencies having "two polygonal rollers, an endless chaim consisting of pivotally intercoupled feat links". The chain is wound around the rollers (see the figures). Drive means for the rollers is provided (p. 1, ll. 29 "driven" and figures).

It would have been obvious for the skilled person to combine the teachings of A4 and A6 to yield the subject matter of Claim 4; no technical prejudice is encountered since the rollers of A4 can be easily brought to bear or / to moving chain.

Hence Claim 4 lacks inventive step (A. 56).

Claim 5

11. Inventive step

The subject matter of Claim 5 is obvious in view of A6. A6 discloses stepwise motion of the chain via the rollers (p. 2, ll. 6ff and Claim 1) in synchronism with the frame of the film.

If the skilled person is to use this apparently essential feature of A6, it would be within his routine competence to arrange to operate the deposit and press means of A4 "during the stand-still periods of the chain" by obvious analogy with the tray-by-tray motion of A6.

Hence, Claim 5 lacks inventive step over A4 in conjunction with A6.

Claim 6

12. Inventive step

The subject-matter of Claim 6 is obvious from A3, which discloses two further strips on the other faces of the frames in superposed relation (see the figures) and pressing means ("Preßstempel" - p. 2, line 26) to adhere the strips to each other in spaces (see the figures again).

If a machine suitable for the two further strips were desired which is an obvious desideratum (cf A3, p. 1, l. 11) it would be obvious to provide a further means, by analogy with that

already disclosed in A4, to achieve this further effect
unexpected effect ensues from this further provision.

Hence Claim 6 lacks inventive step over A4 in conjunction wi
A6 and A3.