

Candidate's Answer Paper
(Examination Paper C)

ANNEX 1 - THE NOTICE OF OPPOSITION

FACTS AND ARGUMENTS

The English Version of A1 is opposed

(1) Documents Referred To:

(a) Publications

A3, A4, A5, A6
A7 - US 4 321 000

(b) Other Evidence

Affidavit evidence regarding prior use of apparatus according to A3 will be supplied

(2) Priority Date of Claims of A1

A1 does not claim priority. Therefore the earliest possible date to which all claims of A1 are entitled is the filing date of A1 i.e. 30 May 1990.

Claim 2 is expressed as "Apparatus ... in particular according to claim 1". This must be interpreted (by Guidelines C-III 4.6) as not limiting the claim to being dependent on claim 1. Therefore Claim 2 must be read both (a) as an independent claim and (b) as a dependent claim on claim 1.

(3) Relevant dates of the Documents Referred To

A3 is a letter dated 12.01.90. The date of A3 being 'made available to the public' is its date of receipt (Board of Appeal Decision) i.e. around 14-15.01.90 - Affidavit evidence could be supplied to prove this if necessary. A3 is therefore prima facie, a prior publication to A1.

The acts referred to in A3 - both the use at a "number of prior fairs" (6th paragraph) and the proposed use at the Culinary Products Fair of 25-31.05.90 - are prior use to A3. Again, affidavit evidence can be supplied if necessary.

A4 was made available to the public on 14.03.90 - the "inscription date" - and is therefore full prior art under A54(2) to A1. (If a DE utility model is not in fact made available on this date, then it was published on 02.04.90 and so would still be full prior art).

A5 was published on 19.04.84 and so is full prior art to A1.

A6 has a priority date of 23.05.90 and a publication date of 27.11.91. Assuming that the priority claim is valid, A6 is therefore prior art under

A54(3) to A1 for the designated states of ES, FR and IT. (Under A54(3), "filing date" is the priority date, by A89).

A7 - as A7 is cited in A1, it seems likely to have been published prior to the filing date of A1. (US publications are published at grant). This would be checked. If it were not published, then the only way that it could have been incorporated in A1 is if a copy of it was sent to the EPO - see Guidelines C-II, 4.18.

(4) Observations under A100(c) - Added Subject Matter

A1 contains matter not included in the application as filed.

Page 2, lines 9-11, indicates that, inter alia, the conduits may be arranged vertically. This was not disclosed in the application as filed and is therefore not impermissible under A123(2).

Furthermore, Page 2 lines 12-14 and claim 6 refer to the inclusion of dye in the water. Again, this was not disclosed in the application as filed and is contrary to A123(2). It may have been included in A7 cited on P.1 of A1, but by T689/90 such features are prima facie, "not within the content of the application as filed". Only if the description as filed left the skilled reader in no doubt that protection was sought for this feature, and that it solved the problem addressed by the invention, can it be introduced and not contravene A123(2). This is clearly not the case here.

Furthermore, Page 2 line 9 of A1 now states that the air curtain spacing of 6-9 cm is a preferred feature. In the spec. as filed, these limits were indicated to be essential, (see p.2 third paragraph and claims 1 and 2 as filed), and so again is impermissible under A123(2).

(5) Observation on Novelty and Inventive Step of A1

Claim 1 of A1 lacks inventive step over A5. A5 relates to the same field as A1 (apparatus for generating a fog screen) and addresses the same problem - that of dispersion of the screen (page 1, first paragraph). A5 provides a row of regularly spaced nozzles (8) - the nozzles are only indicated to be preferably spaced further apart at the top (P.1 lines 33-35) - arranged in a straight line (see Fig. 1), connected to a water feed conduit (3). The conduit must in turn be connected to a water pump in the conventional manner.

There are two air feed conduits (7,7') connected to air pumps (10,10') which produce air curtains (5,5') on both sides of the screen (6).

A5 also suggest using an aspirator (see P.2 2nd Paragraph), albeit without the air curtains, arranged opposite the row of nozzles, and which must of course be connected to a suction device.

Given that A5 proposes two ways of addressing the same problem of preventing the screen dispersing, the skilled person would clearly combine the two solutions to achieve improved performance. Therefore claim 1 lacks inventive step over A5.

Claim 2 (as an independent claim) lacks novelty over A6. A6 relates to apparatus for generating a fog screen, and discloses a row of regularly spaced nozzles (4a, 4b, 4c). These nozzles may be associated with different screens, but claim 2 is not limited to a single screen. The nozzles are arranged in a straight line (see Fig. 2) and are connected to a water conduit (8) and then to water pumps (7a, 7b, 7c). There are two air feed conduits (13) connected to an air pump (via 12) and arranged to produce air curtains on either side of the screen (see Fig. 1). The water conduit (8) and the air feed conduits (12) are both mounted on a common carrier - basin (10) - see Fig. 1.

Claim 2 (as independent) also lacks novelty over A5, in which the air feed conduits (7,7') and the water feed conduit (3) are both mounted on a common carrier - the structure of the expirator (2), see Fig. 1 and Fig. 2.

Claim 2 as dependent upon claim 1 lacks inventive step over A5 for the same reasons as given above.

Claim 3 as dependent upon either claim 1, claim 2 (independent) or claim 2 (as dependent on claim 1) lacks inventive step over A5 and A4. A4 relates to exactly the same field as A5 (and A1) - that of producing a projections screen composed of water droplets (albeit for a window display) - and so would be taken into account by a person skilled in this art. A4 teaches that, in order to achieve a better screen area, two sets of nozzles (1, 1a, 1b) may be used. It is clear from the figure of A4 that the nozzles of 1a and 1b eject water at a small angle than that of nozzle 1, in order to obtain a "complementary spray pattern". (Claim 3 is not limited to all the nozzles of A1 being in a single row). Therefore, in order to obtain the same advantage of claim 3 (homogeneity of the screen - P2, last paragraph), the stalled person would combine A4 with A1. Therefore, claim 3 lacks inventive step.

Claim 4 lacks novelty over both A5 and A6 for the reasons given above in relation to claim 2 (independent).

Claim 5 lacks inventive step over A5 and A3. A5 does not specifically state that the screen can be generated near ground level, but such use is known for this type of screen from A3 (and the affidavits relating to use of A3). In the prospectus 1234, it clearly shows that screens are generated near ground level which spectators can walk through (the letter of 12.01.90 indicates that the screens are installed "on two sides of the pedestrian path" - last paragraph). The screen of A5 would be used in this way (A5 indicates that can be used with 'dry fog nozzles', which are suitable for this purpose). Therefore, claim 5 lacks inventive step.

Claim 6 (as dependent on claim 4) lacks inventive step over A5 and A7, and (as dependent on claim 5) over A5, A7 and A3. The use of dye in the water is a standard feature, known from the prior art - see for example A7, and it does not therefore involve an inventive step to add this feature to those of claims 4 or 5.

Notes to Client

- (1) A1 cannot be attached only for ES, FR and IT - with the exception of when using A6 which applies only to these states. I have therefore attached all claims for all states. If you wish to negotiate with the proprietor of A1, they may (unlikely) agree to cancel EP(ES), EP(FR) and EP(IT) in return for you abandoning your opposition.

However, even if that was done, the EPO could continue the opposition of their own motion under A114 and R60(2), if the patent was clearly invalid (T/197/88 and G9/91).

- (2) The opposition could be filed in Spain under A14(4) and R6(2), with a reduction in fees from DM 1200 to DM 960 i.e. a saving of DM 240. However, the entire statement of grounds would have to be translated into Spanish and filed at least simultaneously with the English version - see G6/91, T 290/90 and Guidelines E III 2.2. Time is short, and translation would I think cost more than DM 240 anyway. There would therefore, be no saving, and so I have filed the opposition in English.

(3) Addition of Subject Matter

- (3a) The addition of method claim 4 per se does not seem to be objectionable. It is for substantially the same invention as original claim 2. It therefore complies with A82 (unity) - which cannot be objected to in opposition anyway, as it is not a ground under A100(a) - and A123(2) - see Guidelines C IV 3.2. It was confirmed in G2/88 that a change of claim category (and therefore presumably the addition of another category) is not objectionable per se, as long as subject matter is not added. Also we cannot object to extension of protection (A123(3)) as such, as that only applies to granted patents.

- (3b) However claim 4 (and claims 1 and 2 (as independent)) omit the limitation of curtain width to 6-9cm. I have argued that this is addition of subject matter, but I think that this argument is weak, as the original specification of A1 indicated that this was for a prototype apparatus (i.e. may be construed as merely an example). However, it was original claims 1 and 2 as an essential feature, and it is worth a try. Deletion of a feature from a claim per se is not objectionable, as long as subject matter is not added - see eg T260/85.

- (3c) Similarly, the movement of the suction conduit from the pre-char part of claim 1 to the char part is not, per se, objectionable, as long as subject matter is not added. The patentee is allowed to reformulate the problem and relevant prior art during examination - see eg T96/86. Again, extension of protection itself is not a valid ground of opposition.

- (3d) Claim 2 as an independent claim is not added subject matter, as original claim 2 was independent.

- (4) The utility model 8710321 disclosed in A4 was not used as this did not add anything not already available.
- (5) I have included provision for affidavits from your employees. I suggest that these are filed (together with a translation into GB, FR or DE) as soon as possible. I do not think that it will then be necessary for them to give evidence in person (thus saving further costs), although this is allowable. The point of the affidavits will be to prove that spectators had walked through these type of displays prior to 30.05.90 - as this is not entirely proven by A3. (see point (8)).
- (6) I attached claim 6 both on grounds of added subject matter and inventive step. I think that the first ground is valid, but includes the second just in case.
- (7) A5 is the main document used to attack A1. A5 specifically teaches away from horizontally spaced nozzles, and so it is possible that A1 could be limited to such an arrangement, allowing a successful argument of inventive step.
- (8) The EPO would not grant an extension for filing the witness statements. However, these can be filed later (but as soon as possible), with a translation being filed up to one month later (R6(2)).
- (9) It is also possible (although unlikely) that A1 could be amended to the limitation of distance between air screens at 6-9cm. A5 discloses a distance of 10-30cm, and 6-9 could be a selection from this, although I think that is not inventive as one skilled in the art would simply experiment until the optimum values were found.



Notice of Opposition to a European Patent

European Patent Office

StudentBounty.com

Tabulation marks

for

I. Patent opposed

Opp. No. OPPO (1)

Patent No. 0 455 676

Application No. 90 110 306.7

Date of mention of the grant in the European Patent Bulletin (Art. 97(4), 99(1) EPC) 21 July 1993

Title of the invention:

WATER-FOG SCREEN

II. Proprietor of the Patent

first named in the patent specification

Opponent's or representative's reference (max. 15 spaces)

OREF

III. Opponent

OPPO (2)

Name

PUBLICIDAD CONSULTING SA

Address

MIGUEL ANGEL, 43
28010 MADRID

State of residence or of principal place of business

SPAIN

Telephone/Telex/Fax

Multiple opponents

further opponents see additional sheet

IV. Authorisation

1. Representative

(Name only one representative to whom notification is to be made)

OPPO (9)

Name

MR ORVIZ GONZALES
34, RUE DE LA MAIRIE
F-75116 PARIS, FRANCE

Address of place of business

Telephone/Telex/Fax

Additional representative(s)

(on additional sheet/see authorisation)

OPPO (5)

2. **Employee(s)** of the opponent authorised for these opposition proceedings under Art. 133(3) EPC

Name(s):

Authorisation(s)

not considered necessary

V. Opposition is filed against

— the patent as a whole

— claim(s) No(s).

VI. Grounds for opposition:

Opposition is based on the following grounds:

(a) the subject-matter of the European patent opposed is not patentable (Art. 100(a) EPC) because:

— it is not new (Art. 52(1); 54 EPC)

— it does not involve an inventive step (Art. 52(1); 56 EPC)

— patentability is excluded on other grounds, i. e.

(b) the patent opposed does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art. 100(b) EPC; see Art. 83 EPC).

(c) the subject-matter of the patent opposed extends beyond the content of the application/ of the earlier application as filed (Art. 100(c) EPC, see Art. 123(2) EPC).

VII. Facts and arguments

(Rule 55(c) EPC)
presented in support of the opposition are submitted herewith on a separate sheet (annex 1)

VIII. Other requests:

In the event that the Opposition Division forms an intention to refuse the opposition, oral proceedings are requested before the issuance of such a decision.

IX. Evidence presented

Enclosed =
will be filed at a later date =

Publication date

A. Publications:

1

Particular relevance (page, column, line, fig.):

do

2

Particular relevance (page, column, line, fig.):

3

Particular relevance (page, column, line, fig.):

4

Particular relevance (page, column, line, fig.):

not

use

5

Particular relevance (page, column, line, fig.):

6

Particular relevance (page, column, line, fig.):

7

Particular relevance (page, column, line, fig.):

Continued on additional sheet

B. Other evidence

X. Payment of the opposition fee is made

as indicated in the enclosed voucher for payment of fees and costs (EPO Form 1010)

XI. List of documents

Enclosure
No.

No. of copies

- 0 Form for notice of opposition (min. 2)
- 1 Facts and arguments (see VII.) (min. 2)
- 2 Copies of documents presented as evidence (see IX.)
- 2a — Publications (min. 2 of each)
- 2b — Other documents (min. 2 of each)
- 3 Signed authorisation(s) (see IV.)
- 4 Voucher for payment of fees and costs (see X.)
- 5 Cheque
- 6 Additional sheet(s) (min. 2 of each)
- 7 Other (please specify here):
Receipt for documents

**XII. Signature
of opponent or representative**

O. Gonzales
Authorised Representative

Place Paris, France

Date 15/4/94