# Candidate's Answer Paper

Statement of Facts and Arguments

Opposition to EP-B-556 660 (Application No. 93 202 005.6) [English Version]

Penseel U.V.

by Fratelli Tempera

1. The patent should be revoked in its entirety under Art 100(a) EPC because the subject matter of the claims is not patentable within the terms of Art 52 to Art 57 EPC and under Art 100(c) EPC because the subject matter of the patent extends beyond the content of the application as filed.

2. Documents relied on

   The following documents will be referred to in this statement.

   2.1 A2: EP-A-530 140 (English translation)

   This document was published on 23 Feb 1993 but claims priority from 29 Aug 1991. It is therefore relevant for determination of novelty of claims of the patent entitled to the priority date (claims 1 to 5, see below) under Art 54(3) for commonly designated states AT, CH/LI, DE, FR, GB and LU, under Art 54(4) and for determination of novelty and inventive step of claims of the patent entitled only to the European filing date (claim 6, see below).

   2.2 A3: EP-A-550 450 (English translation)

   This document was published on 17 Aug 93 but claims priority from 17 Feb 92 and is therefore relevant for determining novelty of all claims under Art 54(3) for commonly designated states DE, ES, IT, NL and SE under Art 54(4).

   2.3 A4: WO92/01405 (Published 6 Jan 92)

   2.4 A5: Painting, Volume 3, 20 Mar 92

   Although this document bears a date of 20 Mar 92, it was in fact available to the public on 19 Mar 92. This is because issues of "Painting" were generally known to be available at the reception desk of the publisher's office on the day before the cover date. Thus, following T 381/87, the document A5 was available on that day (regardless of whether or not anyone actually asked for it). Evidence of the availability of this particular issue will be provided in due course.

   Thus A5 is relevant for determining novelty and inventive step of all claims.

   2.5 A6: GB-A-2 243 609 (Published 14-8-91)

2.7 A7: Exhibition by inventor on 23 Sep 92)

The inventor present to an officially recognised exhibition a prototype corresponding the apparatus disclosed in the Figures of the priority document (priority document enclosed as A7). Although this was an officially recognised exhibition and took place less than 6 mths before the filing date of the application, no mention of the exhibition was mentioned on filing as required by Art 55(2) and no copy of the relevant certificate of exhibition was supplied as required by Rule 23. Thus the patentee cannot benefit from the provisions of Art 55(1)(b) and A7 is to be taken into account.

It is relevant against claims not entitled to priority, following G 3/93, ie claim 6.

Further evidence of the structure of the prototype exhibited will be provided in due course.

3. Priority

3.1 Claim 6 requires that the end member which carries the drive shaft is unitary with the housing. Neither this claim nor any description corresponding to it appears in the priority document. In fact the Figures of the priority document illustrate an apparatus in which the end member is separate from the housing.

3.2 Therefore claim 6 is entitled only to the European filing date of 10 Mar 93.

Claims

All of claims 1 to 4 and 6 are claims to an apparatus whereas claim 5 is directed to a paint roller. I shall deal with claim 5 first.

4. Claim 5

4.1 The patent explains that the apparatus is designed for cleaning conventional paint rollers (see Annex 1, page 2, lines 10 and 11). Thus presumably conventional paint rollers are adapted to engage with the apparatus of claim 4, as specified in claim 5.

4.2 This fact is supported by the evidence various items of prior art. A4 describes at line 26 that truncated cones may be used to support (and thus engage with) conventional rollers. A5 also suggests use of a truncated cone (2, see line 1 of para 4 of A5) to support a conventional roller. Clearly conventional commercially available rollers (before the claimed priority date) are inherently of a shape such that they are adapted as set out in claim 5.

4.3 Thus claim 5 clearly lacks novelty over the common general knowledge which is paint rollers commercially available before the priority date.

5. Claim 1

5.1 This claim requires an apparatus "for" the defined purpose. As is well established in EPO practice (see Guidelines C-III, 4.8), this must be interpreted as meaning "suitable for" the

defined use.

5.2 Novelty

A2 discloses an apparatus suitable for cleaning a paint roller of the defined type (see lines 24-25). This may be by rotation at high speed (eg with use of a drive motor, line 24). The apparatus comprises an elongate housing, formed from the two half cylinders 2 in Figures 1 and 2, which receive the roller (see line 15). At one end of the housing is mounted a drive shaft (item 10 in Figure 1 and line 22) carrying a drive head (6, see line 23 and Figure 1) for engagement with the roller (see line 23). Closure means are provided by the connection of the two half cylinders (line 14), which form an opening (passage 5) to receive the handle (see lines 16 and 17).

5.3 Thus A2 discloses an apparatus having all features of claim 1, which lacks novelty over A2.

5.4 A3 discloses an apparatus suitable for cleaning a paint roller of the defined type - see line 13 which refers to rollers with handles. The aim is to rotate the roller at high speed (see line 33-34). The apparatus comprises an elongate housing for receiving the roller (item 1, Figure 1) and a drive shaft mounted in one end of the housing (item 11, Figure 1 and line 24). This carries a drive head 10, described as a support in A3, which engages with the roller (see lines 22-23). Closure means are provided by the door 5 (Figure 2) which has an opening formed by 3a and 3b (Figure 2) for receiving the handle (lines 18-19).

Thus A3 discloses an apparatus having all features of claim 1, which lacks novelty over A3.

5.5 Inventive Step

The patent indicates that the invention disclosed is directed to solving various problems. One is (a) to shorten the time required to clean paint rollers. Another is (b) to reduce the amount of cleaning liquid required. Another problem with the prior art is said to be (c) the necessity to remove the handle for cleaning, and a further problem is said to be (d) the avoidance of splashing.

5.6 Problem (a) appears to be solved by introduction of the rapidly spinning drive shaft. Problem (b) appears to be solved by reducing the volume of the container in which the roller is held. Problem (c) appears to be solved by providing an opening in the apparatus for receiving the handle. Problem (d) appears to be solved already in A4, as admitted by the patentee.

5.7 A skilled person faced with all of these problems would turn to A5 as closest prior art, an item from a well known publication in the painting field. This is concerned with the problem of splashing, as is the proprietor.

5.8 The apparatus of A5 provides a container (item 1) which contains the roller. It is small and thus reduces the amount of cleaning liquid required, solving problem (b). The housing is provided with closure means (item 4, see para 4 of A5) which has an opening for receiving the handle (item 5, see para 4 of A5). This latter feature solves problem (c).

5.9 The only remaining problem with A5 appears to be (a) - the spinning of the rollers to be done manually (there are no mechanical means provided for this).

5.10 However, A6 is concerned with this very problem (see line 6 of A6) and provides means for rapid spinning of the roller within the container by means of attaching it to the drive shaft of an electric drill.

5.11 Since A6 and A5 are clearly in the same field (cleaning of paint rollers) the skilled person would consider them together in the hope of solving his problem of the time-consuming nature of the cleaning operation in A5 (as closest prior art).

5.12 Thus the skilled person would see that the way to solve this problem is to modify the lower end of the apparatus of Fig 1 to provide a drive shaft connected to the truncated conical support already present and engaged with the roller. This support would then form a drive head and the skilled person would have arrived at an apparatus according to claim 1.

5.13 Thus claim 1 lacks inventive step in view of A5 in combination with A6.

5.13a Further, claim 1 lacks inventive step over A6 as starting point read in the light of A5. A6 provides all features of claim 1 with the exception of a closure means - the container is open at one end.

5.13b On reading A5 (which would be combined with A6 as discussed in paragraph 5.11 above) the skilled person would realise the advantages of having a self-contained apparatus having the closure means of A5 and would modify the A6 apparatus accordingly.

5.12 Thus claim 1 also lacks inventive step over A6 read in the light of A5.

5.13 A4 describes an apparatus having all features of claim 1 except the provision of a drive means and suitability for use with rollers having handles.

5.14 In view of A6, however (same field as A4, as demonstrated by same international classification) the skilled person would modify to solve problems (a) and (c) and provide drive means as in A6 and an opening at the handle end (as in A6) to allow for use of rollers with handles.

5.15 Thus claim 1 lacks inventive step in view of A4 plus A6.

5.16 The means for receiving the handle in the closure means and the drive means are in fact independent - there is no synergistic effect between them. Each solves its own problem. Thus the feature of providing means in the closure means can also be derived from A5. Claim 1 lacks inventive step over A4 plus A5 and A6.

6. Claim 2

6.1 Inventive Step

As discussed in paragraphs 5.7 to 5.12 above, the apparatus of claim 1 lacks inventive step in view of A5 when combined with A6

6.2 A6 discloses a separate member (16 in Fig 1 of A6) which attaches to the drill, which contains the drive shaft and gripper with claws to engage with the roller.

6.3 On seeing this the skilled person would see the convenience of having a separate drive shaft / drive means component at the relevant end of the container and include this feature when modifying the apparatus of A5.

6.4 Therefore claim 2 lacks inventive step over A5 read in the light of A6.

6.5 Similarly, when modifying the apparatus of A6 in the light of A5 as discussed in paragraphs 5.12 and 5.13 above, the skilled person would already have a separate member holding the drive shaft.

6.6 Therefore claim 2 lacks inventive step over A6 read in the light of A5.

7. Claim 3

7.1 Novelty

As explained above in paragraph 5.2, A2 discloses an apparatus having all features of claim 1. The additional features of claim 1 are provision of a closure means integral with the housing, which is disclosed in A2 (the two half cylindrical parts from both housing and closure means) and the provision of a drain passage in the closure means for exit of excess liquid from the housing, which is also disclosed in A2 (see line 26 of A2 and item 3 in Fig 1).

7.2 Thus all features of claim 3 are disclosed in A2 and claim 3 lacks novelty over A2.

8. Claim 4

8.1 Inventive Step

When dependent on claim 2, claim 4 lacks inventive step in view of A5 read in the light of A6. A5 already contains a frustoconical head for engaging with the roller. When modifying the apparatus of A5 (as discussed in paragraphs 5.6 to 5.12 and 6.2 to 6.3 above) the skilled person would retain this structure and thus arrive at an apparatus according to claim 4.

8.2 Claim 4 lacks inventive step over A5 plus A6.

9. Claim 6 (effective date 10-3-93)

Inventive Step

9.1 As discussed above in paragraph 2.7, A7 is relevant against claim 6.

9.2 A6 discloses an apparatus having all features of claim 1. It corresponds exactly with the apparatus of Figure 1 of the patent with the exception that in A7 the drive shaft is carried on a separate end-member (3) (as in claim 3). Further, the drive head has fins (12) for engagement with the end of the roller.

9.3 The only feature of claim 6 not disclosed in A6 is the end member being unitary with housing.

9.4 This feature is however disclosed in various prior art documents in the field of paint roller cleaning. For instance in A2 (relevant for inventive step of claim 6, as discussed in paragraph 2.1 above) the closure means is formed simply by connection of the two halves of the housing and is thus integral with the housing. The end members in A5 (lower end in Figure 2) and in A4 (base 12 of container) are formed as integral parts of the housing.

9.5 This appears to be a standard variant, which the skilled person would use on combining A7 with any of A2, A5 and A4.

9.6 Furthermore, the patentee has presented no advantage for this feature, in particular no unexpected advantage. It appears to solve no problem not solved by the apparatus of A7.

9.7 Claim 6 thus lacks inventive step over A7 plus any of A2, A5 or A4.

10. Description

10.1 The patent should be revoked under Art. 100(c) because matter has been added to the description.

10.2 It has been added at page 2, line 6 of annex 1 that a particular range of rotational speeds can be used. These speeds cannot be directly and unambiguously derived from the application as filed. It would not be possible for the skilled person to derive that these speeds are particularly suitable on the basis of the application as filed, and to derive that these are to be selected.

11. Requests

11.1 The opponent requests revocation of the patent in its entirety.

11.2 Prior to any decision other than this, the opponent requests oral proceedings.

12. Fee

12.1 The opposition fee is being paid separately by deduction from our deposit account no. xxxxx.

Legal Points/Notes for Letter to Client

1. I have not named myself or Mr Aspirino as opponent. I am not entitled to act as opponent if I am really acting on behalf of a client (T 10/82, confirmed in T 635/88). Further, naming Mr Aspirino as opponent would appear to be deliberate concealment of the true identity of the opponent and contrary to R55(a) (see T 219/86). He could act on his own behalf, even though he would appear not to have much of an interest in paint rollers, being at a pharmaceutical firm (an interest is not required - T 635/88), but not if Fratelli Tempera are the true opponent.

I would in practice discuss this with my client - they might decide not to file opposition at all

under these circumstances.

2. The opponent is an Italian resident and thus entitled to file opposition in Italian under Art 14(4) and obtain a reduction of 20% in the opposition fee under R6(3) and Art 12(1) RFees. However, this is not practical, since I will write the opposition in English and we would have to translate it into Italian.

3. I have not submitted an authorisation in my favour, since under the Decision of the President of 19-7-91, this is not necessary for professional representatives (unless later requested).

4. Added matter - I have not attacked claim 1 on this basis because the additional material appears to be based on the description at page 2, line 6 ("spun with the aid of a high speed motor") which I think from client's letter was included in original application.

   Description - attack is perhaps weak if the skilled person would know a portable drill (page 1, line 31) rotates at 500-800 rpm, as suggested by client. However, it is the only 100(c) objection we have so I put it in. Patentee could amend to delete offending matter anyway (unless we argue description means "high speed" in cl 1 is now restricted to 500-800 ppm by interpretation using description. They can't delete without contravening Art 123(3)).

5. I have not put in the drawings in client's Exhibit as evidence of A7. I think these may be confidential (they say "property Pluseel UV). I would use the priority doc (which the client has) instead.

   I have not used our knowledge of the apparatus before the priority date (20-1-92) as prior art, since this appears to have been under confidentiality (contract manufacturing). I think it highly unlikely Fratelli would have been permitted to reveal it. In practice I would check this and perhaps use it if possible.

6. Due date for opposition - 9 mths from mention of grant (Art 99(1) EPC), ie 26-3-97.

7. Hard to attack claim 4 when dependent on claim 3 - in A3 closure means (door) does not have drain passage (in end of container instead). No real inventive step argument for claim 3 though.

8. Need to discuss with client during proceedings strengthening attacks on claim 4 (see 7), and claims 2 and 3.

# Notice of Opposition to a European Patent

Eur… Office

Tabulation marks

for EPO u…

## I. Patent opposed

Opp. No. OPPO (1)

| | |
|---|---|
| Patent No. | 0 556 660 B1 |
| Application No. | 93202005.6 |
| Date of mention of the grant in the European Patent Bulletin (Art. 97(4), 99(1) EPC) | 26-06-96 |

Title of the invention:

CLEANING APPARATUS

## II. Proprietor of the Patent

first named in the patent specification: PENSEEL U.V.

Opponent's or representative's reference (max. 15 spaces): FTOPP.1 OREF

## III. Opponent

OPPO (2)

Name: FRATELLI TEMPERA

Address:
VIA CARABAGGIO 35
I - 20100 MILANO

State of residence or of principal place of business: ITALY

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: U. TINTORETTO

Address of place of business:
VIA DEI TINTORI 16
I - 50100 FIRENZE

ITALY

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
☐ has/have been registered under No.

To 1./2.

EPO use only

## 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. Art. ☐

(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 wishes to take any decision other than revocation of the patent, oral proceedings are requested.

## IX. Evidence presented

Enclosed =

will be filed at a later date =

A. **Publications:**

Publication date

1

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

2

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

3

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

4

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

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**

Continued on additional sheet

## X. Payment of the opposition fee is made

☐ as indicated in the enclosed voucher for payment of fees and costs (EPO Form 1010) debiting our deposit account number xxxxx.

☐

EPO use only

## XI. List of documents

| Enclosure No. | | | No. of copies | | EPO use only |
|---|---|---|---|---|---|
| 0 | ☒ | Form for notice of opposition | 2 | (min. 2) | |
| 1 | ☒ | Facts and arguments (see VII.) | 2 | (min. 2) | |
| 2 | | Copies of documents presented as evidence (see IX.) | | | |
| 2a | ☒ | — Publications | 2 | (min. 2 of each) | |
| 2b | ☒ | — Other documents (A7) | 2 | (min. 2 of each) | |
| 3 | ☐ | Signed authorisation(s) (see IV.) | | | |
| 4 | ☒ | *Voucher for payment of fees and costs (see X.)* | 1 | | |
| 5 | ☐ | Cheque | | | |
| 6 | ☐ | Additional sheet(s) | | (min. 2 of each) | |
| 7 | ☐ | Other (please specify here): | | | |

## XII. Signature of opponent or representative

Place FIRENZE

Date 21-3-97