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D E C I S I O N
of 23 May 2003

Case Number: T 0654/01 - 3.2.7

Application Number: 95929452.1

Publication Number: 0775053

IPC: B65C 11/00

Language of the proceedings: EN

Title of invention:

Labeller for the placement of an adhesive label onto a compact disc

Patentee:

Neato, LLC.

Opponent:

ScanMos Electronic GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 54, 56

Keyword:

"Withdrawal of opposition"
"Inadmissible extension (no)"
"Novelty (yes)"
"Inventive step (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0654/01 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 23 May 2003

Appellant: Neato, LLC.
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Former Respondent: ScanMos Electronic GmbH
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Representative: Müller, Enno, Dipl.-Ing.
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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 4 May 2001
concerning maintenance of European patent
No. 0 775 053 in amended form.

Composition of the Board:

Chairman: A. Burkhart
Members: H. E. Felgenhauer
E. Lachacinski

Summary of Facts and Submissions

I. Both, the patent proprietor and the opponent filed an appeal against the interlocutory decision of the Opposition Division maintaining the European patent No. 0 775 053 in amended form.

The opposition has been filed against the patent as a whole based on the grounds of opposition according to Article 100(a) EPC (lack of novelty and inventive step) and Article 100(c) EPC (inadmissible extension).

The Opposition Division held that the grounds for opposition did not prejudice the maintenance of the patent in its amended form.

The following documents have been considered:

D1: JP-A-5 325 495 (with German translation)

D3: DE-B-2 009 816

D4: JP-A-2 127 230.

The opponent withdrew its opposition with letter dated 23 January 2002.

II. The remaining appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted.

Claim 1 as granted reads as follows:

"1. A labeller for the placement of an adhesive label (400) onto a compact disc (200), the adhesive label

having a central aperture (430) corresponding to a central area (220) of the compact disc and the compact disc having a centre hole (210) that is smaller than the central area and that corresponds to a spindle hole, said labeller being characterized in comprising:

a positioning element (300), preferably fabricated from plastics, including an elongated stock (310), optionally adapted for use as a handle, having a diameter that is slightly less than the centre hole of the compact disc; a body member (330) concentric with the elongated stock and having a diameter that is slightly less than the central aperture of the adhesive label; and a surface area (320) between and abutting said elongated stock (310) and said body member (330); and

a positioning plate (500) having a top surface (510) and a positioning hole (520) through said top surface, preferably in the centre of the positioning plate, said positioning hole (520) having a diameter that is slightly larger than the diameter of the body member (330) so that the body member can pass through the positioning hole while avoiding side to side movement of the positioning element (300);

the arrangement being such that in use the label (400) may be placed on the top surface (510) of the positioning plate (500), the compact disc (200) placed against said surface area (320) with the elongated stock (310) passing through the centre hole (210) of the compact disc and the body member (330) passed through the central aperture (430) so as to allow the adhesive face of the adhesive label and the compact disc to come into contact with each other."

III. The appellant argued essentially as follows:

The feature introduced into amended claim 1 concerning the provision of a guide and defining "said guide centering said positioning element in said positioning plate upon insertion of said guide in said positioning hole" is neither an essential feature nor described as being one. Lack of this feature in claim 1 as granted thus does not lead to this claim not satisfying the requirement of Article 123(2) EPC.

Reasons for the Decision

1. Claim 1 as granted differs from amended claim 1 according to the interlocutory decision in that the following features are not comprised:
 - (a) the labeller comprises "a guide", "said guide centering said positioning element in said positioning plate upon insertion of said guide in said positioning hole", and
 - (b) "the top surface (510) designed so that the compact disc (200) can rest upon it without extending over its edges".

Furthermore claim 1 as granted comprises the feature

- (c) "a surface area (320) between and abutting said elongated stock (310) and said body member (330)"

which within amended claim 1 is formulated as "a surface area (320) between and integrally linked with said elongated stock (310) and said body member (330)".

1.1 Admissibility of the omission of feature (a)

Claim 1 (in the following: claim 1 as granted) is directed to a labeller for the placement of an adhesive label onto a compact disc which comprises a positioning element and a positioning plate.

According to the application as filed the problem to be solved is to provide a labeller which enables an accurate placement of labels onto compact discs. This problem is solved essentially in that the positioning element of the labeller localizes the label and the disc in a fixed relationship to each other, such that both elements can be brought into intimate contact and adhered together in the given relationship (page 2, lines 15 to 28).

In order for the positioning element to function this way it is essential to have, as defined in claim 1, a structure such that it includes an elongated stock, having a diameter that is slightly less than the centre hole of the compact disc and a body member concentric with the elongated stock and having a diameter that is slightly less than the central aperture of the adhesive label. Furthermore a surface area is provided between and abutting said elongated stock and said body member.

As further defined in claim 1 the compact disc may be placed against said surface area with the elongated stock passing through the centre hole of the compact disc and the body member passed through the central aperture of the adhesive label so as to allow the adhesive face of the adhesive label and the compact disc to come into contact with each other.

Feature (a) which according to the contested decision is essential, such that absence of this feature within claim 1 as granted leads to this claim not satisfying the requirement of Article 123(2) EPC, does not directly relate to the localization of the label and the compact disc in a fixed relation. Instead, this feature defines a guide centering the positioning element in a positioning hole of the positioning plate.

Within the application as filed it is indicated that a member (in the terminology of claim 1: the body member) will locate the label (page 4, lines 28 to 31) and that this member is preferably a conical tipped member, which provides an initial conical taper so that the tip may be easily guided through the label into the positioning hole (page 4, line 31 to page 5, line 2; page 5, lines 23 to 26). It is thus evident that the guide according to feature a) consists of the tip of the body member which is formed to serve the function of allowing the body member to be easily guided through the label into the positioning hole of the positioning plate.

Due to the fact that the body member is referred to as being preferably a conical tipped cylinder it is furthermore directly and unambiguously derivable that provision of the guide according to feature a) is - with respect to the problem being solved - not an essential feature but an optional one by means of which - as a further advantage - insertion of the body member into the positioning hole is facilitated.

A further indication for the fact that provision of a guide according to feature a) concerns a preferred structure of the positioning element but not a

structural element essential for the problem being solved can be derived from considerations given with respect to the elongated stock localizing the compact disc. For this stock it is stated within the application as filed that, since the disc is rigid and easy to handle, no taper is necessary in order to place the disc on the localization system (page 5, lines 8 to 13).

Consideration of the statements concerning the structure of the two elements for localization, namely the body member and the elongated stock, in context exemplifies under which conditions it can be preferred to provide a guide on the body member, namely in case disadvantages due to lack of rigidity of the labels are to be avoided.

In view of this disclosure remaining references within the application as filed to a guide being provided on the body member clearly and unambiguously relate to preferred embodiments.

Thus it is directly and unambiguously derivable from the application as filed that feature (a) concerns a preferred but not an essential structure of the body member. Consequently the absence of this feature in claim 1 as granted does not lead to the requirement of Article 123(2) EPC not being satisfied.

1.2 Admissibility of the absence of feature (b) and of the amendment of feature (c)

Features (b) and (c) of amended claim 1 are not explicitly referred to in the contested decision.

Feature (b) defines the outer dimension for the top surface, which is such that the compact disc can rest upon it without extending over its edges.

According to a further feature of claim 1 "the label (400) may be placed on the top surface of the positioning plate" which already implies that the entire label can rest on the top surface. This holds true the more since the adhesive label is adhered to the compact disc by application of a force between these elements (application as filed claim 11; page 6, lines 24, 25).

In view of the implicit disclosure concerning the outer dimension of the top surface with respect to the outer dimension of the label, absence of feature b) in claim 1 as granted does not lead to Article 123(2) EPC not being satisfied.

The formulations of feature c) according to claim 1 as granted and as amended differ only with respect to their wording, wherein both formulations satisfy the requirement of Article 123(2) EPC.

1.3 Claim 1 as granted thus satisfies the requirement of Article 123(2) EPC.

2. *Novelty and inventive step*

Since feature a) which is not present in claim 1 as granted is not the only distinguishing feature with respect to the closest prior art according to document D1, as can be derived from the contested decision (cf. reasons of the decision, section 5.1), the labeller according to claim 1 is new in the sense of Article 54

EPC.

Within the contested decision it is further correctly indicated (cf. reasons of the decision, section 5.4) that neither document D1 considered by itself nor in combination with documents D3 and D4 could have suggested a labeller comprising a positioning element for the proper alignment of the adhesive label and of the compact disc as defined by the amended claim 1. Since concerning the alignment of the label and the disc the position element is defined in the same way in claim 1 as granted the absence of feature a) thus does not affect this claim involving inventive step in the sense of Article 56 EPC.

The above applies for corresponding reasons with respect to claim 6 as granted, which is directed to a method for applying an adhesive label onto a disc, within which a positioning element and a positioning plate corresponding to the ones defined in claim 1 are used.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is maintained as granted.

The Registrar:

The Chairman:

D. Spigarelli

A. Burkhart