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**D E C I S I O N**  
of 18 December 2002

**Case Number:** T 0489/02 - 3.2.7

**Application Number:** 95933920.1

**Publication Number:** 0781243

**IPC:** B65D 85/00

**Language of the proceedings:** EN

**Title of invention:**

Positive sleeving system for photographic negatives

**Applicant:**

PAKON INC.

**Opponent:**

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**Headword:**

-

**Relevant legal provisions:**

EPC Art. 54 (2)(3), 89, 111(1)

**Keyword:**

"Document part of prior art - priority right not checked by  
Examining Division"

"Novelty-yes"

"Remittal to first instance"

**Decisions cited:**

-

**Catchword:**

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Boards of Appeal

Chambres de recours

**Case Number:** T 0489/02 - 3.2.7

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.7**  
**of 18 December 2002**

**Appellant:** PAKON INC.  
106 Baker Technology Plaza  
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**Representative:** Cross, Rupert Edward Blount  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 10 December 2001  
refusing European patent application  
No. 95 933 920.1 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** A. Burkhart  
**Members:** P. A. O'Reilly  
J. H. P. Willems

## Summary of Facts and Submissions

- I. The appellant (applicant) filed an appeal against the decision of the Examining Division to refuse the European application No. 95 933 920.1.
- II. The Examining Division held that the subject-matter of claim 1 lacked novelty and the subject-matter of claim 8 lacked an inventive step.

The most relevant prior art documents for the present decision are:

D2: US-A-5 431 449

D4: US-A-4 979 032

D5: EP-A-0 624 823 (considered during the appeal proceedings)

- III. The appellant requested that the decision of the Examining Division be reconsidered.
- IV. Independent claim 1 of the only request reads as follows:

"1. A storage medium for storing photographic negatives and identifying the stored photographic negatives, the storage medium comprising a plurality of sleeves, each of which has a first outer surface, wherein positive images of the photographic negatives are printed directly upon the first outer surface of the sleeves in a first location corresponding on a one-to-one basis to a second location in which the respective photographic negatives are stored."

Independent claim 8 (filed with the appeal) of the only request reads as follows:

"8. A method creating a storage medium for storing photographic negatives by obtaining a positive image of a photographic negative and placing a representation of the positive image onto a storage medium in which the photographic negative is stored, the method comprising:  
deriving from the photographic negative electronic data representing the photographic negative;  
electronically processing the electronic data representing the photographic negative to obtain electronic data representing a positive image of the photographic negative; and  
printing a representation of the positive image onto the storage medium in which the photographic negative is stored."

V. In their decision the Examining Division essentially argued as follows:

- (i) Document D2 discloses a film sheet 2 provided at the rear side of the index print 1 (column 2, lines 17, 18). The index print and film sheet form together sleeves receiving the negatives and positive images are stored on the index print. There is clearly a one-to-one relationship between the positive images and the location of the corresponding photographic negative.
- (ii) The subject-matter of claim 1 therefore lacks novelty. The subject-matter of claim 8 lacks an inventive step in view of documents D2 and D4.

VI. The appellant argued in his written submission essentially as follows:

- (i) In document D2 the images are not printed directly on the outer surfaces of the sleeve itself as required by claim 1 of the application. In document D2 the images are printed on an index print to which the sleeves are attached. If the sleeves become detached from the index print then there is no longer a positive print on the outside of the sleeves containing the negatives.
- (ii) The method claims filed with the appeal have been amended compared to the method claims which were the subject of the decision so as to make them dependent upon claim 1 which is novel and inventive.

### **Reasons for the Decision**

#### *Prior art pursuant to Articles 54(2) and 54(3) EPC*

1.1 The decision of the Examining Division relies for a large part on document D2. This document is relied upon for novelty against claim 1 and, along with document D4, for inventive step against claim 8. The state of the art to be taken into consideration is, according to Article 54(2) EPC, that which is available to the public before the filing date of the application, or, taking into account Article 89 EPC, the priority date. The claimed priority date for the present application is 13 September 1994 and its filing date is 12 September 1995. Document D2 was published on 11 July 1995. This publication date is therefore after the claimed priority date, but before the filing date of the present application. In order therefore to

decide whether or not document D2 belongs to the prior art in the sense of Article 54(2) EPC it must first be decided whether the claims under consideration are entitled to the claimed priority date. The decision of the Examining Division under appeal contains no reference to the priority date or the priority document. Also, none of the communications of the Examining Division which preceded their decision contain any reference to the priority date. The Board therefore comes to the conclusion that the Examining Division took no consideration of priority date or the content of the priority document when reaching their decision. The Board does not wish to anticipate any first instance examination of the priority document, but would note that a perusal of the priority document suggests that the document is at least very similar to the application as filed. There is thus at least a reasonable chance that it could support the priority date for the independent claims. There is thus also a reasonable chance that document D2 does not form part of the state art according to Article 54(2) EPC.

1.2 Therefore, the Examining Division should not have taken document D2 into account without first investigating the right to priority of the patent application and establishing the status of document D2.

1.3 The Board has itself found out that there is an equivalent European application to document D2 claiming the same priority as document D2 (European application No. 94 102 510.8; publication No. EP-A-0 624 823), which forms part of the prior art pursuant to Article 54(3) EPC for the commonly designated contracting states. Such an earlier application may only be taken into account for the purposes of novelty.

*Novelty*

- 2.1 Although document D5 has not been considered by the Examining Division it is essentially identical in content to document D2 on which the Examining Division have expressed their views. For this reason the Board considers it appropriate to refer to document D5 for novelty against claim 1.
- 2.2 Document D5 (and document D2) discloses a film sheet 2 which has pockets 2a for films (column 2, lines 24 to 32 of document D5). This film sheet is attached to the index print 1 by adhesive or the like (column 2, lines 7 to 9). In their decision the Examining Division referred to column 2, lines 17 and 18 of document D2 (corresponding to column 2, lines 21 to 23 of document D5) and stated that the film sheet and the index sheet form together sleeves. The Board cannot however agree with this since the next lines state "The film sheet 2 has small pockets 2a for storing a plurality of piece of divided developed film". Thus, the index print 1 does not form the outside of the film sheet. The film sheet itself has pockets and hence forms a sleeve. This sleeve has outer surfaces. One of these outer surfaces is attached to the index print 1. It is on this index print that the images are formed. Neither of the outer surfaces of the film sheet, i.e. sleeve, have any images. This means that there are no positive images printed directly on a first outer surface of the sleeves as required by claim 1. Therefore, the subject-matter of claim 1 is novel over document D5 (and hence also over document D2).

*Inventive step*

3. The question of whether or not document D2 belongs to the state of the art pursuant to Article 54(2) can be relevant to the question of inventive step. As the Examining Division have not investigated this question whilst taking account of the claimed priority date, it would not be appropriate for the Board to express an opinion with regards to inventive step.

*Remittal to the Examining Division*

4. In view of the above considerations regarding the state of the art the Board comes to the conclusion that the question of the priority right of the patent application has not been considered by the Examining Division. If the independent claims are entitled to the priority date then the factual situation will have changed completely, in particular with regard to inventive step. In accordance therefore with Article 111(1) EPC, the Board considers it appropriate to remit the case to the first instance for further examination so as to give the appellant the possibility to argue his case before two instances.



## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The application is remitted to the first instance for further prosecution, inter alia for examination whether or not document D2 belongs to the state of the art in the meaning of Article 54(2) EPC in conjunction with Article 89 EPC.

The Registrar:

The Chairman:

D. Spigarelli

A. Burkhardt