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**D E C I S I O N**  
**of 21 September 2004**

**Case Number:** T 0206/03 - 3.2.5

**Application Number:** 97113369.9

**Publication Number:** 0857586

**IPC:** B43K 1/12

**Language of the proceedings:** EN

**Title of invention:**  
Pen point for a marking pen

**Patentee:**  
TOMBOW PENCIL CO., LTD.

**Opponent:**  
Schwanhäusser Industrie Holding GmbH & Co.

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 123(2)

**Keyword:**  
"Extension beyond the application as filed - yes"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 0206/03 - 3.2.5

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.5  
of 21 September 2004

**Appellant:** TOMBOW PENCIL CO., LTD.  
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**Respondent:** Schwanhäusser Industrie Holding GmbH & Co.  
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**Representative:** Leissler-Gerstl, Gabriele  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 11 December 2002  
revoking European patent No. 0857586 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** W. Moser  
**Members:** H. M. Schram  
W. R. Zellhuber

## Summary of Facts and Submissions

I. The appellant (patentee) lodged an appeal against the decision of the Opposition Division revoking the European patent No. 0 857 586 on the grounds that none of the requests of the appellant met the requirements of Article 123(2) EPC.

II. Oral proceedings were held before the Board of Appeal on 21 September 2004.

III. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the following documents filed on 19 August 2004:

(i) claim 1 filed as main request; or

(ii) claim 1 filed as first auxiliary request; or

(iii) claim 1 filed as second auxiliary request; or

(iv) claim 1 filed as third auxiliary request.

The respondent (opponent) requested that the appeal be dismissed.

IV. Claim 1 according to the main request reads as follows:

"1. A pen point for a marking pen, comprising a base portion (2) obtained by bundling synthetic fibers having a fiber diameter of between 1 and 10 Denier, dipping the bundle in a synthetic resin adhesive, and drying and solidifying the resulting bundle, said base

portion consisting of a holder portion (2b) having a circular cross section and a pen tip (2a) molded into a knife cut shape, said pen point having a drawing portion having long sides (4) and short sides (5), and a coating member (3) with which the holder portion together with the outer periphery of the pen tip being integrally coated, whereby the wide sides of the pen tip being devoid of a coating, said coating member being formed of a thermoplastic synthetic resin, characterized in that said coating member has a thickness of between 0.01 and 2.00 mm, and that the pen tip protrudes beyond said coating member by 2.00 mm or less, whereby one short side of the drawing portion being spaced farther apart from said coating member than the other short side."

Claim 1 according to the first auxiliary request reads as follows:

"1. A pen point for a marking pen, comprising a base portion (2) obtained by bundling synthetic fibers having a fiber diameter of between 1 and 10 Denier, dipping the bundle in a synthetic resin adhesive, and drying and solidifying the resulting bundle, said base portion having a pen tip (2a) polished into a knife cut shape and a holder portion (2b) connected with the pen tip, said pen point having a drawing portion having long sides (4) and short sides (5), said base portion and the outer periphery of the pen tip being integrally coated with a coating member (3) formed of a thermoplastic synthetic resin, characterized in that said coating member has a thickness of between 0.01 and 2.00 mm, and that the pen tip protrudes beyond said coating member by 2.00 mm or less, whereby one short

side of said drawing portion being spaced farther apart from said coating member than the other short side."

Claim 1 according to the second auxiliary request reads as follows:

"1. A pen point for a marking pen, wherein a pen tip (2a) having a base portion (2) obtained by bundling synthetic fibers having a fiber diameter of between 1 and 10 Denier, dipping the bundle in a synthetic resin adhesive, and drying and solidifying the resulting bundle, said base portion being molded into a knife cut shape and said pen point having a drawing portion having long sides (4) and short sides (5), is integrally coated with a coating member (3) formed of a thermoplastic synthetic resin together with the base portion, whereby the pen tip protrudes a bit beyond said coating member characterized in that said coating member has a thickness of between 0.01 and 2.00 mm, and that one short side of said drawing portion being spaced farther apart from said coating member than the other short side."

Claim 1 according to the third auxiliary request reads as follows:

"1. A pen point for a marking pen, wherein a pen tip (2a) having a base portion (2) obtained by bundling synthetic fibers having a fiber diameter of between 1 and 10 Denier, dipping the bundle in a synthetic resin adhesive, and drying and solidifying the resulting bundle, said base portion being molded into a knife cut shape and said pen point having a drawing portion having long sides (4) and short sides (5), is

integrally coated with a coating member (3) formed of a thermoplastic synthetic resin together with the base portion, whereby the pen tip protrudes beyond said coating member characterized in that said pen tip protrudes beyond said coating member by 2.00 mm or less, that said coating member has a thickness of between 0.01 and 2.00 mm, and that one short side of said drawing portion being spaced farther apart from said coating member than the other short side."

V. The appellant argued essentially as follows:

The feature "said pen point having a drawing portion having long sides (4) and short sides (5)", which was present in all requests, was disclosed in column 2, lines 16 and 17, and in Figures 2 and 5, of the application as filed (all references to the "application as filed" refer henceforth to the published version). A marking pen having a rectangular drawing portion allowed a user using a scale to select one of two line widths corresponding to the lengths of the short and long sides, respectively (see column 3, lines 26 to 31). The drawing portion of the marking pen shown in Figures 1, 3 and 6 was generally oblique with respect to the longitudinal axis of the marking pen, at an angle suitable for the general user to hold the pen at the same angle with respect to the writing surface. As shown in Figure 6, in order to draw a thick line with the help of a scale, the marking pen was held at said oblique angle with respect to the writing surface against the scale, so that a short side was parallel and adjacent the scale. The last feature of all requests, namely that one short side of the drawing portion is spaced farther apart from the coating member

than the other short side, simply meant that the pen tip protruded farther beyond the coating member at the short side away from the scale than at the short side adjacent the scale. This feature was clearly disclosed in Figures 1, 3 and 6, which all pertained to the same embodiment of the invention. Moreover, the person skilled in the art reading the description and studying the Figures of the application as filed would appreciate that for achieving the object of the invention, i.e. to provide a pen point for a marking pen which, when drawing lines using a scale, prevented the scale from becoming stained by the pen, or vice versa when different colours were used, it was not necessary to provide a coating member on the side of the pen tip that was not in contact with the scale. The person skilled in the art would realize that keeping the lateral side of the pen tip, having an acute angle with the drawing portion (referred to as the "top of the pen point" 7, cf. Figure 3), free from coating, opened the possibility to use this top as an ordinary pen for drawing thin lines. For the above reasons, and having regard to the fact that drawings as originally filed form an integral part of the disclosure of the invention, the last feature of claim 1 of the main request and of the first to third auxiliary requests fulfilled the requirements of Article 123(2) EPC.

VI. The respondent argued essentially as follows:

The description of the application as filed was silent about the feature that one short side of the drawing portion was spaced farther apart from the coating member than the other short side. There was nothing in the description about using the top of the pen point

for drawing lines by hand; on the contrary, the whole disclosure was concerned with using the marking pen with a ruler. Features could exceptionally be taken from originally filed drawings, if said features were, firstly, clearly and unambiguously derivable from the drawings and, secondly, said features were not at odds with the other parts of the disclosure (see T 169/83, OJ EPO 1985, 193). The "spaced farther apart" feature met neither of these requirements. Figures 4 and 6 showed a pen tip, whereby the spacing between the drawing portion and the coating member was the same at both short sides. Figure 1 was flawed in that the width of the pen tip 2a was larger than the width of the corresponding holder portion 2b, and in that the outer edge of the coating was flush with the pen tip, implying that the thickness of the coating was zero. The latter contradicted the embodiment shown in Figure 2, which showed a pen point having a coating with a thickness different from zero. Leaving one lateral side of the pen tip free from coating was at odds with the disclosure in column 3, line 49ff., of the application as filed. It followed that none of the requests of the appellant met the requirements of Article 123(2) EPC.

## **Reasons for the Decision**

### *Article 123(2) EPC*

1. The appeal must fail, since the feature "one short side of the drawing portion being spaced farther apart from said coating member than the other short side" (see claim 1 according to the main request) and "one short



side of said drawing portion being spaced farther apart from said coating member than the other short side" (see claim 1 according to the first, second and third auxiliary request; the difference with respect to the main request is underlined by the Board) is not disclosed in the application as filed, contrary to Article 123(2) EPC.

2. The appellant has conceded that neither the description nor the claims - taken alone - provide a basis for the above-mentioned feature (henceforth referred to as the contested feature).

The solution proposed in the application as filed to the problem of avoiding a ruler is being stained by the pen tip, is essentially to coat the peripheral surface of the pen point, with the possible exception of a small peripheral area that "protrudes" beyond the coating member by at most 2,0 mm (see column 1, lines 49 and 50, column 3, lines 49 to 56, column 4, lines 25 to 29, column 5, lines 14 to 25, of the application as filed). The explanation for this upper limit given in the application as filed is that the "hardness" of the pen tip (which decreases as the amount of protrusion increases) should not decrease too much, see column 3, lines 49 to 56, of the application as filed. There is no passage in the application as filed, wherein the protrusion length of the pen tip beyond the coating member is discussed in relation to thickness of the ruler, or in relation to the short or long sides of the drawing portion.

The argument of the appellant that a skilled reader would realize that a marker pen is generally held in a vertical position at a slightly oblique angle to the writing surface, so that effectively only the edge of the pen tip, which forms an acute angle with the writing surface, is in contact with the ruler and needs to be coated, cannot be accepted. The passage at column 3, lines 26 to 36, of the application as filed makes it clear that the user can select any orientation of the drawing portion with respect to the ruler and thus select any line width between the two "extremes": drawing a line in the direction of the major and minor axis of the drawing section results in a thin line and a thick line, respectively.

3. The Board agrees with the appellant that drawings as originally filed are an integral part of the disclosure of the invention and that the EPC does not prohibit the amendment of claims to include features from drawings, provided such features are clearly, unmistakably and fully derivable from the drawings by the person skilled in the art and not at odds with the other parts of the disclosure.

Figures 1, 3 and 6, of the application as filed seem to disclose a pen point having a rectangular drawing portion, whereby the short side of the drawing portion at the top of the pen point protrudes beyond the coating member by a certain distance, whereas the opposite short side (adjacent the ruler in Figure 6) does not visibly protrude beyond the coating member.

The appellant has submitted that a minimal protrusion at the short side opposite the top of the pen point was present to prevent the coating from contacting the writing surface when using a ruler, since such a frictional contact would impede the smooth drawing of lines. In the judgement of the Board, the question whether the protrusion length at this other short side is zero, or close to zero, is not relevant for deciding whether Figures 1, 3 and 6, of the application as filed provide a disclosure of the contested feature. The issue is not whether the contested feature is realized in an embodiment of the invention shown in one of these Figures, the issue is rather whether an embodiment discloses the contested feature.

Figures 1, 3 and 6, of the application as filed seem at best to disclose an embodiment, whereby one short side of the drawing portion is spaced apart from said coating member, whereas the other short side is not spaced apart from said coating member, or spaced apart from said coating member by a very small distance.

The contested feature "one short side of the drawing portion being spaced farther apart from said coating member than the other short side" does not put any restriction on the protrusion lengths, apart from being different at opposite short sides. There is no disclosure or teaching derivable from the drawings of the application as filed that the protrusion lengths of the pen tip at the short sides can be freely chosen, as long as both lengths are different. This feature thus constitutes an intermediate generalization of what is disclosed in said drawings.

It follows from the above that the contested feature extends beyond the content of the application as filed, cf. Article 123(2) EPC.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

M. Dainese

W. Moser