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D E C I S I O N
of 9 September 2005

Case Number: T 0218/04 - 3.2.5

Application Number: 99100608.1

Publication Number: 0987208

IPC: B65H 37/00

Language of the proceedings: EN

Title of invention:
Coating film transfer apparatus

Patentee:
TOMBOW PENCIL CO., LTD.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 54, 84, 123(2)

Keyword:
"Novelty (yes)"

Decisions cited:
-

Catchword:
-



Case Number: T 0218/04 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 9 September 2005

Appellant:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 21 August 2003
refusing European application No. 99100608.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: W. Moser
Members: W. Zellhuber
P. E. Michel

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal against the decision of the Examining Division refusing European application No. 99100608.1 (publication No. 0 987 208).

II. With regard to the subject-matter of the claims on which the decision under appeal is based, the Examining Division held that the subject-matter of claim 1 was not novel having regard to the prior art as disclosed in document

D4: US 5,303,759.

The Examining Division was of the opinion that a person skilled in the art could "derive from D4, Figs. 1 to 6 and 7b to 9b not only the structure of the tip but equally the technical function of the tip, thereby implicitly disclosing the subject-matter of claim 1 of the present application via the second embodiment of D4", cf. point 10.1 of the decision under appeal.

III. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the following documents:

claims: claims 1 to 6 filed on 21 May 2005;

description: pages 4 to 7, and 9, filed on 15 December 2003, and pages 1 to 3, 8, 10 and 11, filed on 21 May 2005;

drawings: Figures 1 to 9 of the application as filed.

IV. Claim 1 of the sole request reads as follows:

"1. A coating film transfer apparatus comprising a supply reel (2), a winding reel (3), said reels being mounted in a case (1), and a pressing lever (9) projecting out from a cutout hole (1a) provided in the case and having a flat bottom end face (9b), a tape (12) provided with a transfer coating film (12b) being movable from the supply reel to the winding reel, a part (12a) of the tape is reversed along the bottom end face of the pressing lever from a forward to a backward running direction for being wound up by the winding reel, whereby by pressing the bottom end face of the pressing lever onto a desired location of a paper surface the transfer coating film is affixed to the desired location of the paper surface and then an excessive portion of the transfer coating film is cut off, said bottom end face of the pressing lever having a width in the back and forth directions, a sharp first linear edge (9c) being provided between said bottom end face and a front face (9e) of the pressing lever, characterized in that a sharp second linear edge (9d) is provided between said bottom end face (9b) and a rear face (9f) of the pressing lever, in which an angle slightly larger or slightly smaller than a right angle is between the bottom end face (9b) and the front face (9e) of the pressing lever (9) defining said sharp first linear edge (9c), and between the bottom end face (9b) and the rear face (9f) of the pressing lever defining said sharp second linear edge (9d)."

V. The following documents are referred to in the present decision:

D1: EP-A 0 427 870

D4: US-A 5,303,759

D7: US-A 3,308,002

VI. In the written procedure, the appellant argued essentially as follows:

There was no teaching in any one of the references cited which would justify the Examining Division's opinion that the subject-matter of claim 1 of the sole request was not novel.

In particular, document D1 disclosed a pressing lever having a single linear edge formed upstream of a flat pressure surface. At a transition area between the pressure surface and a winding surface downstream of the pressure surface, a curved surface portion was provided.

Document D4 provided no technical teaching to an expert about the structure of the pressing lever. Furthermore, as regards the shape of the tip end of the pressing lever, the drawings of document D4 did not contain any clear technical teaching. Moreover, the structure of the tip end did not play any role for the functioning of the apparatus disclosed in document D4. Document D4 concerned a specific type of mounting of the pressing lever to a casing such that it could perform a pendulum movement.

The subject-matter of claim 1 of the sole request was thus novel.

Reasons for the Decision

1. *Admissibility of the amendments (claims 1 to 6)*

- 1.1 The subject-matter of claim 1 according to the sole request is disclosed in the printed version of the application as filed in claims 1 and 4 in connection with the passage in column 6, lines 51 to 55 of the description. The features of dependent claims 2 to 6 are disclosed in claims 3 and 5 to 8, respectively, of the application as filed.

The amendments thus comply with the requirements of Article 123(2) EPC.

- 1.2 Claim 1 defines the structure of the tip end portion of the pressing lever in that it specifies that there is a flat bottom end face and sharp linear edges provided between the bottom end face, on the one hand, and the front and rear faces of the pressing lever, on the other. Furthermore, an angle slightly larger or slightly smaller than a right angle is between the bottom end face and each of the front and rear faces of the pressing lever, thereby defining said sharp first and second linear edges.

In the Board's judgement, the structure of the tip end of the pressing lever is thus defined sufficiently clearly and comprehensibly for a person skilled in the art.

The feature of dependent claim 2 is not in contradiction to the last-mentioned feature of claim 1, since an inclination of the bottom end face with respect to front and rear faces would give rise to a structure of a pressing lever as defined in claim 1 in combination with claim 2 of the sole request.

Therefore, the subject-matter of claims 1 to 6 of the sole request meets the requirements of Article 84 EPC.

2. *Novelty*

- 2.1 None of the documents cited in the Search Report or by the Examining Division discloses a coating film transfer apparatus according to claim 1 of the sole request, wherein, in particular, a sharp second linear edge is provided between the bottom end face and the rear face of the pressing lever.
- 2.2 Document D1 shows pressing levers having one sharp linear edge and one rounded edge, cf. in particular Figures 4 and 7 to 9.
- 2.3 Document D4 discloses a dispenser for applying a material onto a substrate, wherein the applicator device comprises an applicator body 6 which is movably mounted and includes an applicator lip 4, cf. abstract and Figures. The embodiments shown in Figures 1 to 5, 6 to 8 and 9a, 9b, respectively, concern different types of mounting assemblies allowing the applicator lip to orient itself for full surface contact with the substrate, cf. column 6, lines 9 to 21, column 7, line 59 to column 8, line 2, and column 8, lines 53 to 60.

The applicator lip 4 has a wedge-like structure (cf. column 3, lines 13 to 16 and the Figures), over which the carrier strip 1 is guided and whereat the coating material is peeled off from the carrier strip as the latter is being reversed over the applicator lip 4, cf. column 6, lines 3 to 5.

Figures 1 to 5 of document D4 show an applicator lip having a single sharp linear edge. In Figures 8 and 9 of document D4, the front end part of the applicator lip is depicted including two parallel lines. The description corresponding to these drawings is silent about the structure of that front end part of the applicator, and, apart from the above-mentioned functioning of reversing the carrier strip, no further objects of the applicator lip are disclosed.

In the Board's judgement, it is not directly and unambiguously derivable from the drawings in document D4 that the two parallel lines shown in these drawings indicate two sharp linear edges in connection with a flat bottom end face. Moreover, there is no hint in the description which may give rise to such an assumption.

Consequently, the subject-matter of claim 1 of the sole request is neither explicitly nor implicitly disclosed in document D4.

- 2.4 Document D7 discloses a pressing lever (hammer member) having a bottom end face with two linear edges thus allowing to transfer the portion of the coating film beneath the bottom end face, cf. column 2, lines 26 to 39 and Figure 3. However, the apparatus according to

document D7 does not comprise means for rewinding the transfer film.

The other documents cited in the course of the appeal proceedings are of less relevance.

- 2.5 Therefore, the subject-matter of claim 1 according to the sole request is novel within the meaning of Article 54 EPC with regard to the cited prior art.
3. Since the issue of inventive step has not yet been considered by the Examining Division, the Board, based on the discretionary power conferred to it by Article 111(1) EPC, considers it appropriate to remit the case to the Examining Division for further prosecution.
4. The Board notes that the description pages 8 and 9 comprise references to documents ("documents (3)-(6)", "reference document 2") which are not defined in the description of the application as amended. Furthermore, the reference signs 21, 31 and 41 referred to on page 10, first complete paragraph, of the description do not correspond to those used in the corresponding drawings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

D. Sauter

W. Moser