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**Datasheet for the decision
of 19 September 2006**

Case Number: T 0697/05 - 3.2.07

Application Number: 01309259.8

Publication Number: 1216758

IPC: B05B 7/24

Language of the proceedings: EN

Title of invention:

Identifier label application system

Applicant:

DataDot Technology Limited

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 56

Keyword:

"Remittal based on filing of narrower claims producing a
'fresh case'"

Decisions cited:

-

Catchword:

-



Case Number: T 0697/05 - 3.2.07

DECISION
of the Technical Board of Appeal 3.2.07
of 19 September 2006

Appellant: DataDot Technology Limited
19 Rodborough Road
Unit 9
French Forest, NSW 2086 (AU)

Representative: Pratt, David Martin
Withers & Rogers LLP
Goldings House
2 Hays Lane
London SE1 2HW (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 7 January 2005
refusing European application No. 01309259.8
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. Holtz
Members: P. O'Reilly
K. Poalas

Summary of Facts and Submissions

- I. European application No. 01 309 259.8 was refused by the examining division for lack of inventive step.

The examining division gave their decision on the basis of the state of the file as requested by the applicant in its letter of 4 October 2004. In its decision grounds the examining division referred to the summons to oral proceedings dated 17 May 2004 in which the examining division had provisionally indicated that the subject-matter of claim 1 lacked an inventive step over a combination of D1 and the general knowledge of the skilled person.

- II. The appellant (applicant) filed an appeal against the decision.

The appellant argued that the examining division was wrong in their interpretation of the disclosure of D1.

- III. In a communication accompanying an invitation to oral proceedings the Board set out its provisional opinion.

In the communication the Board indicated that in addition to the question of whether the arguments of the appellant overcame the grounds of the attacked decision the question of whether the subject-matter of claim 1 involved an inventive step over either of D3 or D4 in combination with D2 would have to be discussed.

- IV. Before the date appointed for oral proceedings there was an exchange of communications between the appellant and the Board in which the Board mentioned D5. The

exchange resulted in the filing by the appellant of a set of amended claims with letter of 18 August 2006.

V. The Board subsequently cancelled the oral proceedings.

VI. The independent claims of the set of claims filed with letter of 18 August 2006 read as follows:

"1. A method of applying identifier labels to an article, the method comprising providing a container (105) having a body (105'') containing a plurality of predetermined identifier labels therein and a base fluid into which the identifier labels are mixed to form a mixture, and providing a dynamic fluid to cause the mixture to be discharged via a discharge outlet for application to the article, wherein the container (105) has a discharge part (105') which is coupled to the body (105'') so as to form part of the container (105), the discharge part (105') having a passage (110a) with an inlet portion and a discharge portion (110), the inlet portion being releasably coupled to means (104) for supplying the dynamic fluid so that dynamic fluid flowing through the passage (110a) draws the mixture via a tube (107) into the passage (110a) for discharge through the discharge portion for application to the article, characterised in that the identifier labels are in the form of microdots, the base fluid is an adhesive base fluid, the base (105a) of the container (105) remote from the discharge part (105') is of a conical shape, and the tube (107) extends into the pointed end portion of the conically-shaped base (105a)."

"8. Apparatus for applying identifier labels to an article, the apparatus comprising a container (105) having a body (105'') containing a plurality of predetermined identifier labels therein and a base fluid into which the identifier labels are mixed to form a mixture, means (104) for providing a dynamic fluid into the container (105) to cause the mixture to be discharged via a discharge outlet for application to the article, wherein the container (105) has a discharge part (105') which is coupled to the body (105'') so as to form part of the container (105), the discharge part (105') having a passage (110a) with an inlet portion and a discharge portion (110), the inlet portion being releasably coupled to the means (104) for feeding the dynamic fluid so that dynamic fluid flowing through the passage (110a) draws the mixture via a tube (107) into the passage (110a) for discharge through the discharge portion for application to the article, characterised in that the identifier labels are in the form of microdots, the base fluid is an adhesive base fluid, the base (105a) of the container (105) remote from the discharge part (105') is of a conical shape, and the tube (107) extends into the pointed end portion of the conically-shaped base (105a)."

VII. The appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution based on the claims filed with letter of 18 August 2006 in order to allow for a further search of these claims.

VIII. The documents cited in the present decision are the following:

D1: US-A-5 763 176

D2: EP-A-0 492 333

D3: Motor Industry Management, June 1994, page 4

D4: Mail on Saturday, 11 September 1994, page 30.

D5: US-H-1691

Reasons for the Decision

1. *Novelty*

1.1 The examining division did not contest the novelty of the subject-matter of the claims and the Board has no reason to disagree with that opinion.

2. *Inventive step*

2.1 The presently valid independent claims differ essentially from the independent claim filed with letter of 19 August 2003 on the basis of which the examining division took its decision. In particular, the current independent claims include the feature that the base of the container remote from the discharge part is of a conical shape. This feature has been taken from the description of the application in suit. The examining division has therefore not examined the question of inventive step for a claim including this feature. It is also possible and likely that the European search was not directed to the possibility of a claim including this feature. It could therefore be necessary that a further search has to be carried out

in order to ascertain any further prior art which may be relevant to the amended claims.

2.2 In view of the above explained situation and the intended remittal (see below) the Board considers that it would not be appropriate to express any view with regard to inventive step. The Board would also note that the views expressed with regard to D5 and its relevance to inventive step in point 3.1 of the communication of the Board dated 24 July 2006 were provisional. These views which were expressed before the receipt of subsequent argumentation by the appellant should not be considered to be in any way conclusive.

3. *Other requirements of the Convention*

3.1 The independent claims of the current request differ from the independent claim on which the appealed decision was based both in terms of the wording of the claims and in terms of the features contained in the independent claims. In view of its intention to remit the case the Board has not considered whether the application as amended meets the other requirements of the Convention, e.g. Articles 84 and 123(2) EPC. The applicant is thus given the opportunity to argue its case before two instances on all the requirements of the Convention.

4. *Remittal to the department of first instance*

4.1 The examining division has not yet examined the independent claims as amended during the appeal proceedings with regard to inventive step and the other

requirements of the Convention. In accordance with Article 111(1) EPC, the Board therefore considers it appropriate to remit the case to the department of first instance so as to give the appellant the possibility to argue its case before two instances.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

G. Nachtigall

C. Holtz