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D E C I S I O N
of 21 September 1995

Case Number: T 0032/93 - 3.4.2

Application Number: 86115311.2

Publication Number: 0228536

IPC: G03B 21/64

Language of the proceedings: EN

Title of invention:

Container for slides and a method for automatically packaging the slides in the container

Patentee:

TECNODIA S.P.A.

Opponent:

Geimuplast Peter Mundt GmbH & Co. KG

Headword:

-

Relevant legal provisions:

EPC Art. 56

Keyword:

"Inventive step - (yes) after amendments"

Decisions cited:

G 0002/88

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: T 0032/93 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 21 September 1995

Appellant:
(Opponent)

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Representative:

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Respondent:
(Proprietor of the patent)

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Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office dated 1 December
1992 concerning maintenance of European patent
No. 0 228 536 in amended form.

Composition of the Board:

Chairman: E. Turrini
Members: R. Zottmann
M. Lewenton

Summary of Facts and Submissions

I. The Appellant (Opponent) lodged an appeal against the decision of the Opposition Division to maintain the patent No. 0 228 536 (application No. 86 115 311.2) in amended form.

II. The following documents will be cited in this decision:

- (10) Japan Camera Trade News, Tokyo, May 1983, page 29 column 2 to column 3 last but one paragraph,
- (11) CH-A-631 405 and
- (27) US-A-3 872 645.

III. In a communication the Board expressed its preliminary opinion that claim 1 referring to a container for mounted slides was not novel since the known containers for film strips had the same characteristics as the container of claim 1, that a use claim could be acceptable and that the claims contained further deficiencies.

To meet these objections, the Respondent filed amended claims.

IV. Oral proceedings were held. At the beginning the Appellant put forward that (use) claim 1 was inadmissible since it did not contain all features of (apparatus) claim 1 on which the appealed decision was based and referred to decision G 0009/92 ("reformatio in peius"), but did not maintain its objection against an amended claim 1 worded as in section VI.

V. The Respondent requested that the patent be maintained in amended form with the following documents:

claim 1 as presented in the oral proceedings; claims 2 to 11 of the auxiliary request as submitted with the letter dated 4 January 1995;

description: column 1 and 2, amended as shown in the annex of the letter of 4 January 1995, column 3 to 6 line 2 of EP-B-0 228 536, amended as shown in annex II of the appealed decision; Figures 1 to 5 of EP-B-0 228 536.

The Appellant requested that the decision under appeal be set aside and that the patent be revoked.

VI. The independent claims read as follows:

"1. Use of a container consisting of a continuous strip (1) of transparent material folded longitudinally and welded together along transverse lines (3) to define a plurality of transverse pockets (4) closed at one and open at the other end, said strip (1) bearing a plurality of reference marks (6) separated by a distance equal to the distance between the axes of adjacent transverse pockets (4), as container housing mounted slides, wherein each pocket is adapted to contain a predetermined plural number of mounted slides and is constructed such that the slides are inserted into the pocket through its open end and the insertion of a slide moves a previously inserted slide forward into the pocket."

"6. A method of automatically packaging mounted slides in a container consisting of a continuous strip (1) of transparent material folded longitudinally and welded together along transverse lines (3) to define a plurality of transverse pockets (4), closed at one end and open at the other end, said strip (1) bearing a

plurality of reference marks (6) separated by a distance between the axes of adjacent transverse pockets (4), characterised in that it comprises:

- feeding the continuous strip (1),
- successively positioning the various pockets (4) of the continuous strip (1) with their open end facing an insertion member (20) for said mounted slides (5),
- inserting one by one said mounted slides (5) into said pockets through their open end and moving each previously inserted slide forward through one position into the pocket by the entry of a slide,
- providing an output signal when the mounted slides inserted into one and the same pocket reach a predetermined plural number,
- said output signal operating a member which drives said strip (1) to advance said strip (1) stepwise through a distance equal to the pitch of said pockets (4) as determined by sensing the reference marks (6), after each of the pockets has been filled with the predetermined plural number of mounted slides according to said output signal,
- transversely cutting the strip (1) on termination of the packaging cycle."

Claims 2 to 5 are dependent on claim 1 and claims 7 to 11 are dependent on claim 6.

VII. The Respondent's argumentation is summarized as follows:

D11 is the starting point since this document deals with the insertion of mounted slides into pockets. The container is foldable, but the insertion is very complicated and also the manufacture of the container as can be seen from Figure 5.

The subject-matters of D10, D11 and D27 are quite different. D10 and D11 use foldable material whereas D27 uses stiff material, so that it is not obvious to transfer features from D27 to D10 and D11.

An adaptation of D27 for mounted slides does not lead to a solution according to claim 1 or 6.

VI. The Appellant's argumentation is summarized as follows:

From D11 it is known to insert mounted slides in single pockets and D10 teaches to insert film strips into pockets according to the attacked patent. It is admitted that the mechanical characteristics of film strips and mounted slides are different. However, the film strips and mounted slides belong to closely related technical fields, such that the skilled person dealing with improvements of inserting mounted slides into pockets will take into account the field of film strip insertion. Therefore, he would test whether mounted slides can be inserted into film sleeves and would have no difficulties to realize it.

As a further consequence and when seeking for a better method for inserting mounted slides into pockets, he will find D27 from which he learns to insert a (further) film strip into an elongated pocket by moving a previously inserted strip forward. Only simple tests are necessary to adapt the container of D27 in such a manner that it is suitable for mounted slides.

Reasons for the Decision

1. The appeal is admissible.
2. *Requirements of Article 123(2) and (3) EPC*

Claim 1 maintained according to the appealed decision is directed to an apparatus ("container housing mounted slides ... "). It has been reworded as use claim ("use of a container ... as container housing mounted slides ... ") containing all features of said apparatus claim. In view of decision G 0002/88 of the Enlarged Board of Appeal, such a claim is not open to objection under Article 123(3) EPC. Corresponding considerations apply to claims 2 to 5.

As to the requirements of Article 123(3) of claims 6 to 11, the Board is satisfied that said claims comply with said article, too.

The same applies to all claims with respect to Article 123(2) EPC.

3. *Novelty*

None of the available documents discloses insertion of a plurality of mounted slides into one of a plurality of transverse elongated pockets of the well-known folded containers destined for inserting film strips. Therefore, the claimed subject-matter is novel. Since novelty is not in dispute, it is not necessary to give detailed reasons for this finding.

4. *Inventive step of claim 1*

4.1 Use of foldable containers consisting of a continuous strip of transparent material and comprising individual pockets as containers housing mounted slides, wherein each pocket is adapted to contain one mounted slide and wherein each pocket is constructed such that one slide is inserted into a single pocket through its open end, represents the nearest prior art and is for example described in D11.

With respect to the use as defined by claim 1, said prior art has particularly the drawback that automatic packaging of mounted slides in photographic laboratories is relatively slow.

4.2 The problem underlying the subject-matter of claim 1 is, therefore, to allow accelerated automatic packaging of mounted slides.

4.3 It is undisputed that containers for film strips or sections having the characteristics of claim 1 were already existing before the priority date of the patent-in-suit and that such containers could be used, if of convenient size, also for mounted slides. Since there were numerous sizes of films on the one hand and of mounted slides on the other hand, there did exist containers provided for housing film sections also appropriate to contain a predetermined plural number of mounted slides of a certain format and to insert such slides into the pocket through its open end whereby the insertion of a slide moves a previously inserted slide forward into the pocket. Containers with the essential features of the container described in claim 1 of the attacked patent are disclosed in D10.

However, it is the opinion of the Board of Appeal that the skilled person would not have tried to use such containers for inserting and housing mounted slides. In view of the considerably different mechanical characteristics of pieces of film in comparison with mounted slides, the skilled person would not have thought that the prior art relating to film packaging could be used in solving any problems concerned with the packaging of mounted slides. Furthermore, the kind of packaging of mounted slides known up to the priority date of the contested patent is so different from the kind of packaging of film sections into the container as defined in claim 1 (see e.g. D11) that any change which is leading to such a use would be obvious only in hindsight.

- 4.4 The Appellant alleges that the skilled person, when seeking for a better method for inserting mounted slides into pockets, would find D27 from which he would learn to insert a (further) film strip into an elongated pocket by moving a previously inserted strip forward. Only simple tests would be necessary to adapt the container of D27 in such a manner that it is suitable for mounted slides.

The container of D27 (jacket J) is adapted to insert and house very thin microfilm strips and comprises two relatively stiff rectangular panels (10, 11) with adhesively applied longitudinal ribbons (13 to 17) defining rectangular longitudinal pockets (channel-like chambers A through E) having substantially the same thickness as the microfilm (see e.g. column 5 lines 21 to 23). The mutual position between pocket and trackway along which the continuous film strip is advanced during insertion must be extremely accurate, as any slight displacement of the container from its proper position makes the insertion difficult (see column 5 lines 34 to

36); for this reason, the engagement between pins (19A, 20A) of a platform of a carriage and locating holes (19, 20) of the container (J) is necessary. The presence of said pins does not allow the container to be formed from a continuous strip. The container cannot be produced by simply welding two sheets of transparent material, and this because said ribbons have to be applied. Due to the fact that the channel-like pockets have to be substantially as narrow as the microfilm to avoid overlapping of the preceding film section by the following one, entrance slots (10A to 10E) in the upper panel (10) of the container are necessary, because the open ends of the pockets are too tight to insert the film (see column 3 lines 1 to 3 and 16 to 18). The film sections are thus advanced along a way at an angle. Further means (e.g. pressure roller 46, jacket clamp 34, inclination of the platform for the container J with respect to the film trackway) are necessary to allow correct insertion of the film sections.

Therefore, a container of this type and the operating machine for inserting the microfilm sections into such a container according to D27 are unsuitable for mounted slides, which are rigid and cannot advance along a curve. As a consequence, the skilled person when trying to solve the above-cited problem, namely to improve the speed of packaging mounted slides, would not take into account any teaching from D27.

But even if he did, he would not arrive at a subject-matter with the features of claim 1. Since the operating machine is unsuitable for the containers of the type described in claim 1 of the patent in suit, he would not take into consideration use of such

containers, but rather adapt the dimensions of the container of D27 to the dimensions of the mounted slides and omit said entrance slots. The result would be a rectangular, relatively stiff container with ribbons and locating holes.

- 4.5 The Board has also considered the remaining documents on file and found them non-prejudicial to claim 1. Therefore, said claim involves an inventive step within the meaning of Article 56 EPC and consequently said claim is allowable under Article 52(1) EPC.
5. Since the independent method claim 6 contains all features corresponding to the features of claim 1, a corresponding reasoning leading to the same result is valid for claim 6, too.
6. The dependent claims concern particular embodiments of the subject-matters of claims 1 or 6. Therefore, they are likewise allowable under Article 52(1) EPC.
7. However, the description has to be brought into conformity with these claims and the relevant prior art to be cited and disclosed in the introductory part of the description (Rule 27(1) EPC).

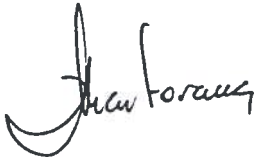
Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent on the basis of the following documents:

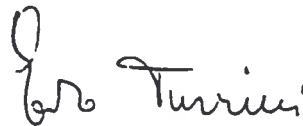
Claim 1 as presented in the oral proceedings; claims 2 to 11 of the auxiliary request as submitted with the letter dated 4 January 1995;
the description of the European patent specification to be adapted;
Figures 1 to 5 of the European patent specification.

The Registrar:



P. Martorana

The Chairman:



E. Turrini

ff 7.11.95
ee