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**D E C I S I O N**  
**of 24 November 2003**

**Case Number:** T 1121/02 - 3.2.4

**Application Number:** 97901287.9

**Publication Number:** 0889689

**IPC:** A01K 3/00

**Language of the proceedings:** EN

**Title of invention:**

A fencing element

**Applicant:**

Chamove, Arnold Shirek

**Opponent:**

-

**Headword:**

Electric Fencing Element

**Relevant legal provisions:**

EPC Art. 52(1), 56

EPC R. 71(2)

**Keyword:**

"Inventive step - (no)"

"Features making no contribution to technical character cannot support the presence of an inventive step"

**Decisions cited:**

T 0931/95, T 0026/81, T 0641/00

**Catchword:**

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Case Number: T 1121/02 - 3.2.4

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.4  
of 24 November 2003

**Appellant:** Chamove, Arnold Shirek  
Pahiatua Track, R.D. 1  
Palmerston North (NZ)

**Representative:** McCallum, Graeme David  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 23 April 2002  
refusing European application No. 97901287.9  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** C. A. J. Andries  
**Members:** M. G. Hatherly  
H. Preglau

## Summary of Facts and Submissions

I. The Examining Division's decision refusing the European patent application No. 97 901 287.9 (International publication No. WO-A-97/28332) was posted on 23 April 2002.

On 20 June 2002 the appellant (applicant) filed an appeal and paid the appeal fee. The appellant filed the statement of grounds on 2 September 2002.

II. Claim 1 of the main request filed with the letter dated 3 July 2003 reads:

"An elongate electric fencing element (T) characterised in that said fencing element has along its surface contrasting markings (D,L) which are a deterrent to an animal, said contrasting markings being such as to resemble the warning patterning of another animal and being selected from the group consisting of:

- (i) a repetitive linear array of transverse stripes;
- (ii) a repetitive linear array of diagonal markings; and
- (iii) regular or irregular shapes on a contrasting background."

Claims 2 to 9 of the main request include all the features of claim 1 of the main request.

Claim 1 of the auxiliary request filed with the letter dated 23 June 2003 reads:

"An elongate electric fencing element (T) characterised in that said fencing element has along its surface contrasting markings (D,L) which are a deterrent to an animal, said contrasting markings being a repetitive linear array of transverse stripes and being such as to resemble the warning patterning of another animal."

Claim 2 to 8 of the auxiliary request include all the features of claim 1 of the auxiliary request.

III. The following documents played a role in the appeal proceedings:

D1: US-A-5 163 658

D2: US-A-5 029 819

D3: DE-A-3 822 529

D4: US-A-5 036 166

E5: Page from magazine filed with the statement of grounds of appeal, with a picture and description of Gallagher Electronics Turbo Tape

E8: NZ-A-222568

Statutory Declaration by Dr Arnold Shirek Chamove, dated 26 August 2002

Annex Exhibit ASC1 - a summary of research by Dr Arnold Shirek Chamove

IV. The examining division found in its decision that the subject-matter of all claims then on file lacked novelty or inventive step.

The appellant filed amended claims with the statement of grounds of appeal and explained why he considered the examining division's interpretation of the prior art was wrong. He explained that the present invention concerned an electric fencing element for containing non-human animals and represented a discovery that animals could be inherently dissuaded from coming into contact with a fencing element by providing the latter with contrasting markings which resembled the warning patterns of another animal. The study referred to in Dr Chamove's Statutory Declaration and Annex Exhibit ASC1 showed that fencing elements according to the invention were many more times more effective than existing ones. Prior art tapes with longitudinally extending stripes were simply intended to enhance the visibility of the tape, not to have a deterrent effect. The appellant cited several publications detailing the warning patterns and animal behaviour.

V. In its communication dated 10 February 2003 and posted on 12 February 2003, the board provisionally argued that the claimed subject-matter lacked novelty over various prior art fencing elements and lacked inventive step over others.

In section 8.3 of this communication the board stated *inter alia* the following:

"For the purpose of discussion, the board will provisionally accept the argument of the appellant

that the contrasting markings on a fencing element according to the alleged invention do have an effect on the animal seeing them.

These contrasting markings provide the animal with information which the animal's brain then processes to arrive at the conclusion that the fencing element is to be avoided. Therefore the board does not see that the claimed subject-matter provides a **technical** contribution to the prior art and does not see that the kind of contrasting markings have a **technical** effect but considers the contrasting markings to be merely a presentation of information which accordingly cannot contribute to inventive step.

Therefore it seems that it is not possible for a person skilled in the art to derive from the patent application any objective technical problem that has to be solved.

The improvement envisaged by the present patent application is essentially a presentation of information to the animal, which therefore cannot contribute to inventive step."

- VI. The appellant replied by letters of 23 June 2003 and 3 July 2003 enclosing amended claims, commenting on the efficacy of the claimed fencing elements as evidenced by the tests referred to in Dr Chamove's Statutory Declaration and Annex Exhibit ASC1, and arguing that it would not be obvious to proceed from the prior art to the claimed fencing elements.

VII. In the annex to the summons to oral proceedings, the board made *inter alia* the following provisional, non-binding comments:

"3. If something is to be an invention within the meaning of Article 52(1)EPC, then it is an implicit requirement of the EPC that it must have a technical character, see headnote 1 of decision T 931/95 (OJ EPO 2001, 441). Moreover, unless a technical problem can be derived from the application, an invention within the meaning of Article 52 EPC does not exist, see the headnote of decision T 26/81 (OJ EPO 1982, 211).

As stated in headnote 1 of decision T 641/00 (OJ EPO, 2003, 352) "An invention consisting of a mixture of technical and non-technical features and having technical character as a whole is to be assessed with respect to the requirement of inventive step by taking account of all those features which contribute to said technical character whereas features making no such contribution cannot support the presence of inventive step."

4. In the present claims 1 of the main and auxiliary requests, the only **technical** feature is the elongate electric fencing element and this is known from D1, D4, E5 or E8.

The contrasting markings of a repetitive linear array of transverse stripes or a repetitive linear array of diagonal markings or regular or irregular

shapes on a contrasting background are not technical features.

The markings are said in these claims to be "such as to resemble the warning patterning of another animal" but this is not a **technical** effect (and is moreover merely a theory - see lines 21 to 26 on page 2 of the originally filed description which state that "A **possible** explanation for this phenomenon is that such animals have a built-in instinct which warns them that other creatures bearing dark and light colouring in an alternating linear pattern or bold spots are harmful and therefore to be avoided.")

The contrasting markings therefore do not contribute to the solution of any technical problem by providing a technical effect and therefore have no significance when assessing inventive step.

5. The board thus maintains its position set out in sections 8.1 to 8.6 of the communication of 10 February 2003 that, starting from an elongate electric fence known from D1, D4, E5 or E8, neither a technical problem nor a technical contribution over the prior art can be found in the subject-matter of claim 1 of the present main request and claim 1 of the present auxiliary request.

The board therefore considers that neither of these claims involves an inventive step as required by Article 52(1) EPC.



6. Moreover even if, impermissibly, the non-technical features of claim 1 of the present main request and claim 1 of the present auxiliary request were taken into account for assessment of inventive step, then D1 (discussed in section 8 of the board's first communication) would remain extremely relevant.

Lines 65 to 68 of column 2 of D1 state that "Additionally, the strip may have printing designs ... to create a particular visual or aesthetic impression." Lines 17 to 19 of column 4 state that "It is possible, for example, to indicate that the fence is electrified by embossing a notice or warning on the fence."

In the middle of page 2 of the letter of 23 June 2003 the appellant states that such markings do not fall within the scope of the present claim 1 of the main request.

The board considers that the notice or warning would be something like a lightning symbol or wording such as "WARNING - LIVE". The lightning symbol and the individual letters W, A and so on are shapes (whether these are regular or irregular shapes is debatable) and, in order to be visible, they would have to be on a contrasting background.

Consequently the board considers that the skilled person in the art would as a matter of routine provide an elongate electric fencing element with

contrasting markings along its surface satisfying alternative (iii) of claim 1 of the main request.

7. Further, even if, impermissibly, the non-technical features of claim 1 of the present main request and claim 1 of the present auxiliary request are taken into account for assessment of inventive step, then, in view of

- the prior art electric fence of D1 with its notice or warning, or
- the prior art electric fences of D4, E5 and E8 with horizontal stripes in various colours, or
- the prior art fencing with the chevron pattern (i.e. diagonal marking) in the first column, third row of Figure 22 of D2, or
- prior art barricade or cordon tapes with a variety of markings,

the board considers that it would be a matter of routine to the skilled person in the art to provide elongate electric fencing elements with contrasting markings along their surfaces according to the alternatives (i) and (ii) of claim 1 of the main request and according to claim 1 of the auxiliary request."

The board concluded the annex by stating in section 8 that "At least at present, the board cannot see any way

in which the basic objections against this patent application can be overcome."

- VIII. The appellant replied by letter of 20 October 2003 simply that "the applicant will not be represented at the Oral Proceedings", without submitting further arguments or requests.
- IX. The oral proceedings were held on 24 November 2003 in the appellant's absence, in accordance with Rule 71(2) EPC.
- X. The appellant's requests are to set the examining division's decision aside and to grant a patent with the following documents:

Main request:

- claims 1 to 5 filed with the letter dated 3 July 2003,
- claims 6 to 9 filed with the letter dated 23 June 2003,
- description pages 1, 4, 6 and 7 filed with the letter dated 23 June 2003,
- description pages 2 and 5 of the published application WO-A-97/28332,
- description page 3 filed with the letter dated 3 July 2003,

- drawings sheets 1 and 2 of the published application WO-A-97/28332.

Auxiliary request:

- claims 1 to 8 filed with the letter dated 23 June 2003,
- description pages , 3, 4, 6 and 7 filed with the letter dated 23 June 2003,
- description pages 2 and 5 of the published application WO-A-97/28332,
- drawings sheets 1 and 2 of the published application WO-A-97/28332.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The board has reconsidered its provisional negative opinion but has reached the same conclusion, that starting from an elongate electric fence known from D1, D4, E5 or E8, neither a technical problem nor a technical contribution over the prior art can be found in the subject-matter of claim 1 of the present main request and claim 1 of the present auxiliary request (as explained in section 5 of the annex to the summons to oral proceedings and quoted in section VII of this decision).

The board therefore finds that neither of these claims involves an inventive step as required by Article 52(1) EPC.

Moreover even if, impermissibly, the non-technical features of claim 1 of the present main request and claim 1 of the present auxiliary request were taken into account for assessment of inventive step, then the claimed subject-matter would still lack inventive step (as explained in sections 6 and 7 of the annex to the summons to oral proceedings and quoted in section VII of this decision).

3. The board still sees no way in which the present application can proceed to grant and therefore cannot allow the appeal.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

G. Magouliotis

C. Andries