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Datasheet for the decision of 23 June 2008

Case Number: T 0223/06 - 3.4.03

Application Number: 00202715.9

Publication Number: 1081541

IPC: G03B 17/26

Language of the proceedings: EN

Title of invention:
Film unit having radio-frequency identification transponder

Patentee:
Carestream Health, Inc.

Opponent:
Agfa-Gevaert N.V.

Headword:
-

Relevant legal provisions:
RPBA Art. 13

Keyword:
"Admissibility of late filed documents (yes)"
"Novelty (main request) - no"
"Inventive step (auxiliary request) - no"

Decisions cited:
T 0343/99

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0223/06 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 23 June 2008

Appellant II: (Opponent)
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Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office posted 14 December 2005 concerning maintenance of European patent No. 1081541 in amended form.**

Composition of the Board:

Chairman: R. G. O'Connell
Members: E. Wolff
J. Van Moer

Summary of Facts and Submissions

I. These are appeals against the proposed maintenance of EP 1 081 541 in amended form.

II. The appellant proprietor requests that the decision under appeal be set aside and the patent maintained on the basis of the main or auxiliary requests filed at oral proceedings before the board.

III. The main request of the appellant opponent is that the decision under appeal be set aside and that the patent be revoked.

IV. The independent claim of the main request reads as follows:

"1. A film unit comprising:

photographic film for capturing images;
a radio frequency identification transponder disposed in association with said photographic film to convey information about the photographic film; said transponder being retained in said association during said capturing; and

a holder for the photographic film; and

said radio frequency identification transponder is [sic] joined to said photographic film."

V. The independent claim of the auxiliary request reads as follows:

"1. A film unit comprising:

photographic film for capturing images;

a radio frequency identification transponder disposed in association with said photographic film to convey information about the photographic film; said transponder being retained in the said association during said capturing;

a holder for the film;

and wherein said radio frequency identification transponder is a flexible inlay transponder joined to said photographic film."

VI. The appellant opponent argued as follows:

Document D45, and especially its abstract, was more relevant than any of the previously cited documents. It disclosed all the features of claim 1 of the main request, thereby depriving the claim of novelty, and in combination with common general knowledge in the art rendered claim 1 of the auxiliary request obvious.

Document D45 explicitly referred to a film as the medium for recording images. There was no difference between a photographic film and a radiographic film other than spectral sensitivity. They were both films sensitive to photons. Neither claim 1 of the main request nor claim 1 of the auxiliary request contained anything that limited it to a specific kind of film responsive to a particular range of wavelengths.

The feature that the transponder was "*being retained in the said association during said capturing" was* a method feature, which could not be used to limit claim 1 which was an apparatus claim.

Document D45 did not contain any indication that the transponder was applied only after the image was recorded. On the contrary, the indication was that the transponder was already present at the formation of the image. The memory contained information about the patient and/or the image and the purpose of the system was to provide a link between patient and image. This alone suggested the presence of the transponder before the image was taken. Also, the transponder contained information about the image, which again indicated that the transponder was present when the image was taken. This view was confirmed by the alternative implementation using a cassette, which in the appellant proprietor's own words contained a screen which was erasable and could be reused several times.

VII. The appellant proprietor argued as follows:

Document D45 should not be admitted into the proceedings, or, if admitted, the case should be remitted to the department of first instance. However, should the board decide to admit document D45 into the proceedings, then the appellant proprietor's view was that it deprived neither the invention claimed in claim 1 of the main request of novelty, nor the invention claimed in claim 1 of the auxiliary request of an inventive step, since, unlike the claimed inventions, document D45 was not concerned with

photographic films, ie films suitable for use in commercial photography.

Claim 1 of the main request was limited to photographic film of the kind of film used in commercial photography. Document D45 in contrast disclosed a photostimulable phosphor x-ray film which was quite different from the photographic film of the invention.

The photostimulable phosphor x-ray film referred to was not a film at all, because when a photostimulable phosphor was used to record x-ray images, it was not a film that was used, but a screen, as explained on page 5, lines 43-44 of document D45. Screens were erasable, and could be reused.

The images formed were not photographic images because the description referred throughout to radiographic images.

According to the description in document D45, the cassette was exposed, then provided with the EEPROM carrier. Therefore the memory was not being retained "during said capturing" as required by claim 1

Reasons for the decision

1. *Admissibility of the appeal*

1.1 Both appeals are admissible.

2. *Admissibility of document D45*

2.1 Document D45 was filed eleven days before the date of the oral proceedings.

2.2 The appellant proprietor argued that the document had been filed too late to be admitted into the proceedings, particularly as there had been insufficient time to consult the proprietor. Should the board nevertheless decide to admit the document, then the case should be remitted to the department of first instance.

2.3 The appellant opponent submitted that document D45 was more relevant than any of the documents previously cited against the patent and that it should therefore be admitted, even though it was filed only shortly before the oral proceedings.

2.4 The Rules of Procedure of the Boards of Appeal provide (Article 13(3) RPBA) that once oral proceedings have been appointed an amendment to a party's case shall not be admitted if issues are raised that cannot reasonably be dealt with without adjourning the oral proceedings. In all other circumstances, it is a matter for the discretion of the board whether or not an amendment of a party's case should be admitted (Art. 13(1) RRPBA).

2.5 There is by now an established trend in the jurisprudence of the boards of appeal according to which the decision whether or not to admit a late filed document should rest on the complexity of the legal and technical issues raised by its late submission rather than *prima facie* relevance. Thus, in case T 343/99 the board admitted a late filed document into the

proceedings because the document could be readily understood and the complexity of the technical issues was "*not such that the other party or the board could not have been expected to deal with the document without adjournment of the oral proceedings (see point 2 of the headnote of decision T 0633/97)*". In that case, the board concluded that the criterion of relevance of the document concerned did not appear to offer a convincing approach, "*because in application of this criterion the document would in practice have had to be looked at, and arguments heard, in advance of any conclusion as to relevance being reached*". (T 343/99, points 2.1 and 2.2)

2.6 Document D45 was submitted only eleven days before the oral proceedings. The cited part of the document is its abstract, consisting of two columns of text of about ten lines each, and a schematic drawing which can be fully understood with the aid of that text. In view of the clear statement in the abstract about "the memory provided either on the film or on the cassette", no reference to the body of the description is required to clarify that the expression "photostimulable phosphor x-ray film" used in the abstract is intended to include a suitable film. The document was published before the priority date of the opposed patent and serves merely as prior art for the assessment of novelty and inventive step.

2.7 The amendment of the case referred to in Art. 13 RPBA is the late filing of a document. The content of this document, on account of its brevity and lack of technical complexity, can be comprehended almost immediately; being merely a prior art document, it also

does not introduce any new legal issues. Applying the criteria outlined in the preceding paragraph, the board therefore admits document D45 into the proceedings. Furthermore, given the simplicity and brevity of the document's disclosure and the public interest in the avoidance whenever possible of protracted proceedings, the board refuses the appellant proprietor's request for remittal of the case to the department of first instance.

The main request

3. The appellant opponent had raised various issues concerning claim 1, which were all decided in favour of the appellant proprietor. In view of the order below only novelty needs to be discussed here.

4. Novelty

4.1 Document D45 describes a medical X-ray station which uses a film cassette containing a photostimulable phosphor x-ray film. A memory for storing data relating to the patient and/or the recorded image is provided on either the film or the cassette. A radio frequency transmitter/receiver enables data to be recorded on or read from the memory.

4.2 The abstract of D45 refers to the memory being provided on the film or the cassette, clearly referring to them as alternatives. That the transponder can be used with either of these alternative forms of image storage is confirmed in the body of the description. There (page 5, lines 43 to 46), it is explained that the system was designed in particular for use with a photostimulable

phosphor screen but alternative means of storing medical images such as radiographic film are also expressly referred to.

4.3 The stated purpose of the radio frequency identification transponder which according to claim 1 is joined to the film of claim 1, is to convey information about the photographic film.

4.3.1 In document D45 (abstract, left-hand column, lines 5 to 7, and right-hand column 6 to 9), the memory for storing data relating to the patient and/or the film, together with the radio transmitter and receiver for recording and reading data fulfil the same function as, and hence form, a radio frequency identification transponder, with the radio frequency transmitter and receiver for reading and recording data being referred to in D45 as "RF tag". According to the description of document D45 the tag used is a commercially available RF tag as marketed by Mikron GmbH.

4.3.2 That a separate item such as a tag is "provided on ... the film" as in document D45 is merely another way of saying that the tag is joined to or affixed to the film. The board cannot discern any technical differences between these different ways of stating that the transponder is attached to the film.

4.3.3 According to D45, the memory serves to store data relating to the patient and/or the film. In both cases these data constitute information about the film - either which patient the film is associated with or details about the film itself. Those data are read or recorded by the radio frequency transmitter and

receiver. Thus, the RF tag clearly conveys information about the film in the sense of claim 1.

4.3.4 Nothing in document D45 suggests that the RF tag is provided only after recording the image. On the contrary, the skilled person would conclude from reading just the abstract that the RF tag needs to be present before the image is recorded. This would be the most reliable manner of maintaining the association between x-ray image and patient. Furthermore, presence of the memory with its associated radio transmitter and receiver before recording the image would be the simplest way of ensuring that data relating to the film can be recorded. The board judges that the memory and its associated radio transmitter and receiver also fulfil the requirement of claim 1 that the transponder be retained in its association with the film, that is, that it remain joined to, or be provided on, the film during image capture.

4.4 Neither can the board identify a clear and recognisable boundary between a photostimulable phosphor screen and a film, since the main difference appears to be that in the case of a screen there is a thin layer, or film, on a rigid substrate which film constitutes the active part responsive to photons. This means that even in the case of a screen the memory is either provided on the cassette or it is provided on the film covering the substrate.

4.5 Photons interact with the film to produce an image in both a photographic film and a radiographic film. Document D45 refers to the x-ray sensitive film as being photostimulable. When describing the formation of

x-ray images one commonly refers to x-ray photography. Thus, although x-ray films are generally thicker and less flexible than films used in commercial photography, and have their optimum response at shorter wavelengths, the board does not see a difference in kind between the terms photographic film and radiographic film which could serve as a technical distinction for excluding x-ray films, and therefore the prior art disclosure, from the ambit of the claim. The board therefore concludes that the term photographic film subsumes x-ray films.

4.6 For the reasons set out, it is the considered view of the board that neither the reference in claim 1 to *photographic film,* nor the requirement of the "*transponder being retained in the said association during said capturing",* nor the feature that the transponder serves to "*convey information about the photographic film* provide a distinction between the claim and the disclosure of the prior art document D45. The subject matter of claim 1 of the main request is therefore not new.

The auxiliary request

5. *Novelty*

5.1 Claim 1 of the auxiliary request differs from claim 1 of the main request in that it specifies that the *radio frequency identification transponder is a flexible inlay transponder.* As there is no mention of a flexible transponder, or even an inlay transponder in document D45, claim 1 of the auxiliary request is new.

6. *Inventive step*

6.1 Document D45 constitutes the closest prior art for assessing whether the invention claimed in claim 1 involves an inventive step.

6.2 Claim 1 of the auxiliary request differs from claim 1 of the main request solely in that the claim now specifies that the transponder joined to the film is a flexible inlay transponder. This difference also provides the only distinction between the disclosure in document D45 and the claimed invention.

6.3 As discussed in relation to the main request, the term photographic film has a range of meanings. It embraces films of different kinds for forming photographic images at different ranges of wavelengths, such as x-ray films, which in practice tend to be flexible in the sense that they are not completely rigid, and films for commercial photography which are generally provided in wound up form inside a casing or around a film spool. Since they are stored in tightly wound form inside their casing, but need to be unrolled to be flat in the image plane of a camera, these films have to be highly flexible. These films are as such well known and have been commercially available for many years. Thus, for example, the introductory part of the patent explains that for many years encodings have been provided on films and cameras.

6.4 Comparing the claimed invention with the teaching of the closest prior art, document D45, leads to a formulation of the objective technical problem to be solved as that of extending the provision of

transponders to situations in which the film is highly flexible.

6.5 As explained in the opposed patent, transponders which consist of a flexible sheet bearing the antenna and a chip are known as inlay transducers. It is further explained (col. 6, lines 12 to 16, and lines 32 to 34)that such inlay transducers were marketed by Texas Instruments as Tag-it™ Inlays.

7. The obvious solution to the problem of extending the application of transponders to highly flexible photographic films is to use a commercially available tag which is itself flexible and can therefore follow the deformation of the film to which it is attached. The invention as claimed in claim 1 consists of no more than that. Since inlay transponders are as such flexible, the adjective "flexible" in claim 1 does not add anything further.

8. In the board's judgement, therefore, the subject matter of claim 1 of the main request is not new and that of claim 1 of the auxiliary request lacks an inventive step.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked

Registrar | Chair

S. Sánchez Chiquero | R. G. O'Connell