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**Datasheet for the decision
of 9 August 2011**

Case Number: T 1973/09 - 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, 108, 109(1), 122

EPC R. 101(1), 136(4)

Relevant legal provisions (EPC 1973):

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Keyword:

"Decision by department of first instance - competence to grant re-establishment into time limit for filing notice of appeal: no"

"Reimbursement of fee for re-establishment: yes"

"Appeal admissible: yes - legitimate expeditions"

"Inventive step: no"

Decisions cited:

T 0473/91, T 0808/03

Catchword:

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Case Number: T 1973/09 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 9 August 2011

Appellant:
(Applicant)

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

Representative:

Knott, Stephen Gilbert
Mathisen & Macara LLP
120 Bridge Road
Chertsey
Surrey KT16 8LA (GB)

Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted 8 May 2009
refusing European patent application
No. 01309259.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: K. Poalas
Members: P. O'Reilly
E. Dufrasne

Summary of Facts and Submissions

- I. The examining division decided to refuse European application No. 01 309 259. The examining division considered that the subject-matter of claim 1 lacked an inventive step (Article 56 EPC) and moreover lacked clarity (Article 84 EPC).
- II. The appellant (applicant) filed an appeal against that decision.
- III. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 7 filed with letter of 23 July 2008.
- IV. Claim 1 of the set of claims reads as follows:

"A method of applying identifier labels to an article comprising holding an adhesive base fluid and a plurality of identifier labels in a container (105), providing a dynamic fluid to cause the identifier labels to be discharged from a discharge part (105') of the container (105) for application to an article, characterised in that the identifier labels are in the form of microdots, the method including mixing the microdots with the adhesive base fluid in the container (105) with the container (105) including a conical base (105a) remote from the discharge part (105') to facilitate said mixing, the dynamic fluid flowing through a passage (110a) in the discharge part (105') having an inlet portion and a discharge portion (110) so that dynamic fluid flowing through the passage (110a) draws the mixed microdots and adhesive base fluid via a tube (107) in to the passage (110a) for discharge."

V. The documents cited in the present decision are the following (the allocation of the numbers differs in part from the allocation used in the preceding decision T 697/05 on the same application):

D1: US-A-5 763 176

D2: US-H-1691

D3: US-A-4 390 452

D4: US-A-4 243 734

D5: US-A-5 429 392

A1: Download from Badger Air-Brush Company for Badger 100 Airbrush

A2: William White, "The microdot history and application", 1992, Phillips Publications, pages 1 and 2.

VI. The arguments of the appellant may be summarised as follows:

The subject-matter of claim 1 involves an inventive step.

Although microdots have been known a long time it was not known how to apply them to an object. In particular they are so heavy that they would not stay in suspension in the carrying solution. Also, it was not known how to ensure that they are attached to the object to which they are applied. The invention solves these problems by providing an arrangement whereby there is mixing of the microdots and base fluid aided by a conical shape of the container, and the base fluid is an adhesive to facilitate their attachment to the object to which they are applied. Furthermore, the

argument that microdots may be smaller than the size of a full stop, i.e. 0,8 mm, is not supported by any evidence. The provision of feature a) as referred to by the examining division is therefore not obvious.

D4 does not disclose microdots but rather ultra-microdots as indicated in document A2. Moreover, D4 is not concerned with applying the ultra-microdots. Also D3 does not discuss how to apply microdots. D5 refers to microdots "dispersed into contaminated soil" but gives no information how this is achieved. Also, D1 contains no information other than a reference to a Badger Air Brush 100 or aerosol device. A Badger Air Brush 100 does not, however, function in the manner set out in claim 1.

D2 describes an electrostatic spraying apparatus which is a different type to that of claim 1. Also, the container is part-spherical which would not lead a skilled person to consider a conical shape. Therefore also the features of claim 1 of mixing the identifier labels with the adhesive base fluid in the fluid container and the container having a conical base are not obvious to the skilled person.

Reasons for the Decision

1. *Request for re-establishment of rights* (Article 122 EPC)

1.1 By its decision dated 23 September 2009, the formalities officer acting on behalf of the examining division allowed the applicant's request for re-

establishment of rights dated 25 August 2009. This decision had the effect that the notice of appeal was deemed to have been filed in due time and the proceedings were continued.

- 1.2 Under Rule 136(4) EPC, the department competent to decide on a request for re-establishment of rights is the department competent to decide on the omitted act.
- 1.3 In the present case the omitted act is the filing of the notice of appeal, which is to be carried out within the time limit defined under Article 108 EPC. The department competent to decide whether the appeal is inadmissible for non-compliance with Article 108 EPC is, under Rule 101(1) EPC, the Board of Appeal.

Therefore only the Board of Appeal is entitled to decide upon the request for re-establishment of rights.

- 1.4 Article 109(1) EPC, which empowers the department of first instance in *ex parte* proceedings to set aside its own decision if it considers an appeal to be "admissible **and** well founded" (emphasis added by the Board), provides an exception to the principle of general devolutive effect of the appeal, in order to allow an interlocutory revision. This exception, as such, has to be construed narrowly in connection with the interlocutory revision, and not as a broader entitlement for the first instance to decide whether an appeal is admissible (T 473/91, OJ EPO 10/93, 630, T 808/03 of 12 February 2004, not published in OJ EPO, and Case Law of the Boards, 6th. edition 2010, VI.E.3.1, page 495). This is reflected in the Guidelines for Examination (E-VIII, 2.2.7) which indicate that the

request for re-establishment is only then to be considered by the competent department if interlocutory revision is to be granted, which in the present case it was not.

This exception is necessary since interlocutory revision requires that an appeal exists before a positive decision can be taken for the appellant to grant the interlocutory revision. When it considers the appeal to be well-founded, the department of first instance is required therefore to form an opinion as to the admissibility of the appeal. This does not infringe upon the power of the Boards of Appeal to decide upon the admissibility of appeals since it applies only to well-founded appeals which in the case that they are also considered by the department of first instance to be admissible never reach the Boards of Appeal. Since the department of first instance only takes positive decisions on admissibility of an appeal in the case of well-founded appeals the rights of the appellant, at least in so far as it has not requested the refund of the appeal fee, are preserved, since it achieves what it has requested without the necessity of going through a complete appeal procedure.

- 1.5 The department of first instance, however, in the present case followed neither Article 109(1) EPC nor the Guidelines for Examination since it decided upon the request for re-establishment of rights to conclude that the appeal was admissible, but **not** well founded. The decision of the department of first instance was thus *ultra-vires*.

1.6 Since the department of first instance was not empowered to take the decision that it did, the Board sets aside the decision of the department of first instance to allow the request for re-establishment of rights.

2. *Admissibility of the appeal*

2.1 The Board has considered the fax transmission report submitted by the appellant with its letter of 8 September 2009 and concludes from this that the letter dated 29 June 2009 containing the notice of appeal in the present case was sent and received by the EPO on that same date.

2.2 However, the Board notes that the facsimile number of the addressee of the fax (+49 089 2399 **2528**) is in fact the number of the Treasury and Accounts department of the EPO, i.e. it is not the facsimile number (+49 089 2399 **4465**) of the filing office of the EPO in Munich (Article 3 of the Decision of the President of the EPO dated 12 July 2007 concerning the filing of patent applications and other documents by facsimile, Special edition 3/2007 of OJ EPO, page 7, and point 3 of Notice from the EPO dated 12 July 2007 concerning the availability of the EPO filing offices, Special edition 3/2007 of OJ EPO, page 6).

2.3 Should it have been established that the said notice of appeal was not duly filed at the EPO, the appellant could at least legitimately have expected to receive a corresponding warning from the EPO that its filing was deficient, i.e. that it was sent to the wrong fax number, because the deficiency was readily identifiable

for the EPO. Since 20 days then remained for the appellant to file a notice of appeal at a correct EPO address, the Board is convinced that the appellant would have filed its already prepared notice of appeal again at the correct address, both in due time and in due form.

- 2.4 Therefore, applying the established case law on the principle of protection of legitimate expectations, the Board deems that the notice of appeal was filed on 29 June 2009, i.e. in due time.

Since the order for payment of the appeal fee was part of the same letter dated 29 June 2009, the same applies to the payment order.

- 2.5 Consequently, the Board deems the appeal to be admissible without any necessity to consider a re-establishment of rights.

3. *Re-imburement of the fee for re-establishment of rights*

- 3.1 In view of the above finding that the appeal was admissible without consideration of the request for re-establishment of rights, the request for re-establishment of rights has no more basis.

- 3.2 Therefore, the Board orders the reimbursement of the corresponding fee already paid by the appellant.

4. *Inventive step*

4.1 In its decision the examining division took D1 as the closest prior art document.

It considered that the subject-matter of claim 1 differed from the disclosure of this document by the following features of the claim:

- a) the identifier labels are in the form of microdots;
- b) the identifier labels are mixed with the adhesive base in the fluid container; and
- c) the container has a conical base.

The appellant also disputes that the following feature of claim 1 is disclosed in D1:

- d) there is a dynamic fluid flowing through a passage in the discharge part so that the dynamic fluid draws the mixture of the microdots and base fluid via a tube into the passage for discharge.

4.2 The examining division considered that the feature a) was not a real limitation to the claim since it considered that the term microdot was not clear (see points 4 and 6 of the decision grounds).

The appellant argues that the term microdot is well-known and clear. It further argues that microdots are at least an order of magnitude larger than the microbeads disclosed in D1.

The Board agrees with the appellant that the term is clear. However, it disagrees as regards the range of sizes for a microdot.

In A2, which the appellant supplied, it is stated under "Definitions" that the term microdot refers to a 100X reduction of a standard document page. It is indicated that the term is derived from the German term "Mikrat" which was related to the size of a standard full stop at the end of a typewritten sentence. Also, under "Definitions" there is a reference to "Ultra-microdot" which is a 400X to 750X reduction discovered by British agents "among microdots intercepted at their Bermuda facility". These more highly reduced images are thus also a form of microdot. This is consistent with the information contained in D4 that the size range for the micro-dots disclosed therein (see column 4, lines 44 to 50) is 0.003 to 0.125 inches (76 to 3175 μm) which overlaps with the range of 0.05 to 100 μm given in D1 for the micro-beads (see column 3, lines 17 to 23).

The appellant argues that a microdot has a size of approximately 0.8 mm or 800 μm (see letter of 11 July 2011, point 3.d) referring to the definition of microdot given in A2. In this argument the appellant does not address the whole of the extract which as explained goes on to indicate that much smaller sizes are possible. Also, D4 makes it clear that microdots can be at least an order of magnitude smaller than the value suggested by the appellant and hence comparable with the micro-beads known from D1. The arguments of the appellant that microdots are at least an order of magnitude greater than the micro-beads and thus would not be expected to remain in suspension is therefore based on an arbitrary choice of the possible range of sizes of microdots. No basis can be found in the file for such an arbitrary selection.

Furthermore, there is nothing in the application as originally filed to suggest that the size and density of the microdots as well as the physical properties of the base fluid were such that they would not remain in suspension. The application as originally filed makes no reference as to the state of the microdots in the base fluids. The arguments of the appellant regarding the size of microdots and the alleged consequential effects on how they are contained in a fluid are thus based neither on the evidence regarding the size of microdots nor on any information in the application as to how they contained in the fluid, i.e. whether or not suspended.

Therefore, in the view of the Board the replacement of the micro-beads of D1 by microdots would have been an obvious alternative for the skilled person depending upon the information that is to be carried by the identifier label.

- 4.3 The examining division considered that feature b) was an obvious measure for the skilled person. If the microdots did not remain in suspension in the base fluid, as alleged by the appellant, then they would accumulate at the bottom of the container. This effect would have been apparent to the user and would immediately have given rise to the problem of maintaining mixing. In particular, the examining division noted the need to mix non-soluble labels and referred to D2 in this context. In D2 (see column 2, line 65 to column 3, line 2) there is a specific reference to mixing in the container. It is moreover self-evident that where small particles contained in a base fluid are to be sprayed then it is necessary to

keep them mixed as otherwise a mixture thereof will not be sprayed.

Therefore the provision of feature b) was obvious for the skilled person.

4.4 The examining division considered that feature c) was an obvious measure for the skilled person. In particular it referred to D2 in this context.

The appellant has pointed out that the container of D2 has a base with a round shape which does not suggest a conical shape. In this context the Board notes that no limitations are provided in the claim or description as to the apex angle of the claimed conical shape. It could be an angle as shown in figure 1 of the application or it could be quite a large angle of more than 90° and approaching, for example 170° . The shape of such a container would be very similar to that of the container shown in the figures of D2. According to the description of the application on page 4, lines 1 to 4 the conical shape facilitates a desired mixing. This is clearly due to the smaller cross section at the lower section. Other shapes having a smaller cross section at their lower section would achieve the same effect. The shape disclosed in D2 is such a shape with a smaller cross section at the lower section and its effect on mixing is already disclosed in that document. The claimed conical shape is thus just a variation of the known shape which provides a smaller cross section at the lower section.

The provision of feature c) was thus obvious for the skilled person.

- 4.5 With regard to feature d) the examining division argued that this feature is disclosed in D1 due to the reference to a Badger Air Brush 100 therein.

The appellant has supplied a download from the Badger Air-Brush Company website (A1) showing this article. It apparently is supplied as a gravity feed model or side feed model whereby the side feed may operate in the same manner as set out in the claim. It is not, however, necessary to come to a conclusion in this respect since D1 discloses that instead of the Air Brush 100 "other known aerosol devices could be adapted" (see column 5, lines 18 to 20). D2 discloses such an aerosol device which operates in the manner set out in feature d). Since the problem is merely that of spraying a liquid the fact that D2 is disclosed with respect to spraying a pesticide would not itself be a reason for the skilled person not to consider the teaching of the document when considering spraying a liquid held in a reservoir, whereby mixing thereof is desired. Also the fact that D2 shows an electrostatic spraying device is not relevant as the charge is added at the exit and in any case electrostatic spraying is not excluded by claim 1.

Thus, even in the case that feature d) is considered not to have been disclosed in D1 it still would have been obvious to the skilled person to provide this feature.

- 4.6 The appellant argued that there was a prejudice against the use of microdots because of their size and that the prior art used smaller particles as for example in D1,

D4 and D5. It argued that the skilled person did not know how to apply microdots.

As explained above in point 4.2 the Board considers that the term microdot covers particles having the sizes set out in these documents. Even if that were not the case there is no evidence in any of these documents concerning any kind of prejudice for using microdots having a size of approximately 800 μm . There is also no evidence that there actually is any particular problem in applying microdots in general because of their alleged weight. The application gives no hints of any problems in this direction, in particular there is no indication that the microdots would not stay in suspension.

The appellant suggests that the problems of spraying are overcome by providing a container with provision for mixing. Even if it were accepted that the microdots do not remain in suspension this problem would be immediately apparent as they would be left at the bottom of the container. It is not beyond the wit of the skilled person or indeed of an unskilled person to provide for mixing when particles do not mix of their own accord. The problem of non-mixing of particulates in liquids is one met in daily life and solved either by manual shaking or mixing means. D2 shows that in fact this problem is known and already solved by providing mixing means (see point 4.3 above).

The appellant also suggested that the skilled person would not know how to ensure that the microdots adhere to the object to which they are applied. It is, however, already indicated in the closest prior art, i.e. D1

(see column 4, lines 25 and 26), to provide adhesives in the base fluid, which is the reason why this feature is contained in the preamble of claim 1.

The appellant suggests that D1, D4 and D5 disclose only very small particles so that the skilled person would understand that only such small particles could be applied and not larger ones such as microdots. The Board cannot agree with this view since as already explained under point 4.2 above firstly it considers that the size range of these particles overlaps with the one of the microdots and secondly it has not been documented by the appellant that there would be a problem with larger particles and that the problem would be such as to produce a prejudice.

4.7 Therefore, the subject-matter of claim 1 lacks an inventive step in the sense of Article 56 EPC.

Order

For these reasons it is decided that:

1. The fee for re-establishment is to be reimbursed.
2. The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

K. Poalas