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**Datasheet for the decision
of 17 August 2016**

Case Number: T 1712/13 - 3.2.05

Application Number: 06815475.6

Publication Number: 1934060

IPC: B43K31/00

Language of the proceedings: EN

Title of invention:

Hand-Held Dry-Erase Board System

Applicant:

Julia Rhodes

Relevant legal provisions:

EPC 1973 Art. 84, 54, 56

EPC Art. 123(2)

Keyword:

Amendments - do not add subject-matter (yes)

Claims - clarity (yes)

Novelty - (yes)

Inventive step - (yes)



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Case Number: T 1712/13 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 17 August 2016

Appellant: Julia Rhodes
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Representative: Thomas Prock
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 2 May 2013 refusing European patent application No. 06815475.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Poock
Members: S. Bridge
F. Blumer

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the examining division refusing European patent application No. 06 815 475.6
- II. The examining division held that claim 1 of the then pending main request is not clear (Article 84 EPC 1973) and that the subject-matter of claim 1 lacks an inventive step (Article 56 EPC 1973).
- III. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims filed as main request with letter of 12 August 2016 while conditionally withdrawing all previous requests.
- IV. Claim 1 according to the main request reads as follows:
- "A hand-holdable dry-erase board writing system comprising:
a dry erase marker (40); and
a dry erase board having:
 a first writable surface (22), on which a dry-erase marker (40) can be used, the first writable surface being located within, or on a side of, a frame (20); and
 a handle (30) comprising an upper end (32) and a lower end (34);
characterised in that:
 only the upper end (32) of the handle (30) is attached to, or integrally formed with, the frame (20); and
 the handle (30) has a size and shape suitable for being held while writing and for holding up the

hand-holdable dry-erase board for others to view;
and
the handle (30) includes a clip (50) which can
removably retain the dry erase marker (40)."

V. The following documents were referred to in the
decision under appeal:

D1: US-A-5,997,309;

D2: GB-A-2 296 898.

The following further documents were cited in the
international search report:

ISR1: US-A-5,626,478.

ISR2: US-A-5,743,414;

ISR3: US-A-6,932,531;

ISR4: US-A-5,263,866.

VI. In the written procedure, the appellant argued
essentially as follows:

The amendments made to claim 1 (main request) now match
the understanding of the invention considered by the
Board of Appeal in their preliminary opinion. Claim 1
has also been amended to recite that the handle
"includes" a clip and a dry erase marker. Basis for
this amendment can be found in in lines 17 to 19 of
page 9 and lines 16 to 23 of page 10 of the applica-
tion. It is clear to the skilled person whether a given
clip was able to removably retain a given dry erase
marker. Claim 1 is therefore both clear (Article 84 EPC
1973) and in accordance with Article 123(2) EPC.

The claimed features are considered to solve an
objective technical problem of providing a hand-
holdable dry-erase board writing system with improved
means for the twin task of holding the dry-erase board

while writing and holding up the board for others to view. Accordingly, claim 1 is novel and inventive over the prior art.

The description has been amended to meet the requirements of the EPC.

Reasons for the Decision

1. Amendments

The respective basis in the application as published for each of the features of claim 1 according to the main request is indicated in italic square brackets as follows:

"A hand-holdable dry-erase board [*page 2, lines 26 to 28*] writing system comprising:
a dry erase marker (40) [*page 10, lines 16 and 17*]; and
a dry erase board having:

 a first writable surface (22), on which a dry-erase marker (40) can be used [*page 5, lines 10 and 11*], the first writable surface being located within [*page 5, lines 5 and 6*], or on a side of [*implied by page 8, lines 20 to 22*], a frame (20); and

 a handle (30) comprising an upper end (32) and a lower end (34) [*page 8, lines 7 and 8*];

characterised in that:

 only the upper end (32) of the handle (30) is attached to [*page 8, lines 7 to 9, figures*], or integrally formed with [*page 9, lines 10 to 13*], the frame (20); and

 the handle (30) has a size and shape [*page 5, lines 18 to 20*] suitable for being held while writing [*page 11, lines 9 to 11*] and for holding up the hand-holdable

dry-erase board for others to view [page 11, lines 17 and 18]; and

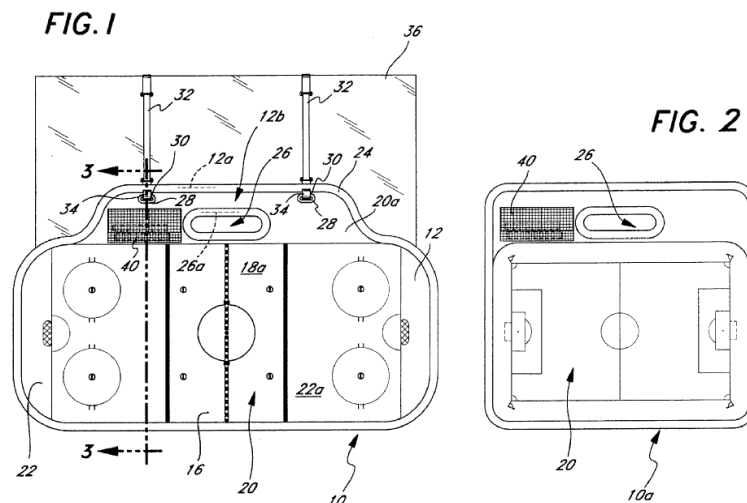
the handle (30) includes a clip (50) which can removably retain the dry erase marker (40) [page 8, lines 9 to 10 and page 9, lines 17 to 19]."

These features were originally disclosed in combination so that the requirements of Article 123(2) EPC are met.

The wording of claim 1 is also clear (Article 84 EPC 1973).

2. Prior art

Document ISR1 discloses a coaching device comprising a board 12 having a surface 20 which may be written upon with a dry erase marker so that the writing may be easily removed and the surface reused (column 1, lines 7 to 13).



A case 40 secured to the board 12 is located outside the area 20 and is adapted to hold one or more dry erase markers 42 (column 2, lines 20 to 23, column 3, line 65 to column 4, line 3).

An elongated opening 26 in the board 12 near the perimeter 12a, preferably centrally located along one side 12a of the perimeter, forms a handle which enables

the user's fingers to pass through the opening 26, with the user's thumb wrapped around the board section 12b between the opening 26 and the perimeter's edge 12a (column 2, lines 3 to 7; column 3, lines 44 to 51).

3. Novelty

3.1 The subject-matter of claim 1 according to the main request differs from document ISR1 in that:

- only the upper end of the handle is attached to, or integrally formed with, the frame;
- the handle includes a clip which can removably retain the dry erase marker; and
- the handle has a size and shape suitable for being held while writing and for holding up the hand-holdable dry-erase board for others to view.

3.2 The subject-matter of claim 1 according to the main request:

- is similarly distinguished from the display device of document D1 which does not disclose a handle in which only the upper end is attached to, or integrally formed with, the frame and the handle does not include a clip for removably retaining a dry erase marker;
- further differs from the magnetic display device of document D2 in that the writing system, comprises a dry erase marker instead of a magnetic pen and in that the writable surface is suitable for writing with the dry-erase marker;
- further differs from the board disclosed in document ISR2 in that the writing system is hand-holdable and has a handle;
- further differs from the dry erase marker of document ISR3 in that the writing system comprises a hand-holdable dry-erase board with a handle;

- further differs from the board of document ISR4 in that the writing system is a dry-erase board with a handle.

3.3 In consequence, none of the available prior art (see section V above) discloses a handle in which only the upper end is attached to, or integrally formed with, the frame and wherein the handle includes a clip for removably retaining the pen.

3.4 The subject-matter of claim 1 according to the main request is thus new with respect to the available prior art (Article 54 EPC 1973).

4. Inventive step

4.1 Since document ISR1 discloses a hand-holdable dry-erase board writing system with a handle and means for removable retaining a dry erase marker, it comes closest to the disclosed invention and thus constitutes the closest available prior art.

4.2 According to the application as filed, the technical effect of such a handle is that the hand-holdable dry-erase board writing system may be held while writing (page 11, lines 9 to 11) and can be held up for others to view (page 11, lines 17 and 18) while efficiently combining the dry-erase board and marker into one convenient package (page 4, lines 2 to 6) for carrying around (page 3, lines 21 to 22).

4.3 The corresponding partial objective technical problems thus are to provide a hand-holdable dry-erase board writing system with improved means for the twin task of holding the dry-erase board while writing and holding

up the board for others to view while retaining the marker.

- 4.4 With respect to the second partial problem ("*retaining the marker*"), the provision of a clip is generally known, for example, from document ISR2 above (column 4, lines 53 to 57; column 2, line 63 to column 3, line 9; figures 1 and 2). Although none of the available prior art documents explicitly suggest using a clip in a board which is explicitly described as being portable, the use of a clip on a portable board does not require an inventive step, since such clips are known as such and the resulting advantages can be readily contemplated in advance.

Although none of the available prior art documents suggest locating means for carrying the marker on the handle, the application as filed does not disclose any particular advantages for this configuration. Thus no contribution to inventive step arises from this particular feature.

- 4.5 However, none of the available prior art documents disclose the first partial problem or suggest as solution a handle which is only attached to, or integrally formed with the dry-erase board at one end, the handle having a size and shape suitable for being held while writing and for holding up the hand-holdable dry-erase board for others to view. Such a handle in which

only the upper end 32 of the handle 30 is attached to, or integrally formed with, the frame 20

is not disclosed in any of the available prior art and therefore, providing such a handle for solving the above objective technical problem is not obvious.

In consequence, the subject-matter of claim 1 according to the main request involves an inventive step (Article 56 EPC 1973).

5. Dependent claims

Dependent claims 2 to 6 of the main request are respectively based on originally filed dependent claims 3, 5, 10, 11 and 12. Dependent claim 7 corresponds to one of the alternatives of claim 1 (see also page 9, lines 11 to 12 of the application as published). The dependent claims are clear and thus do not give rise to any objections under Article 84 EPC 1973. The requirements of Article 123(2) EPC are also satisfied.

The subject-matter of the dependent claims is carried by the inventive step of claim 1. The dependent claims thus meet the requirements of Articles 54 and 56 EPC 1973.

6. Description

The amended description satisfies the requirements of the EPC: the description was brought into line with the claims of the main request and the closest prior art (document ISR1) has been acknowledged therein. The amended description no longer contains any unclear statements with respect to the scope of the claims.

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 with the order to grant a patent on the basis of the following documents:
 - Claims 1 to 7 filed as main request with letter of 12 August 2016;
 - Description, pages 2, 3, 5, 7 and 12 filed with letter of 12 August 2016;
pages 4 and 10 filed with letter of 15 August 2016;
pages 6, 8, 9 and 11 as published;
 - Figures 1 to 5 as published.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated