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**Datasheet for the decision
of 10 September 2021**

Case Number: T 0274/17 - 3.2.02

Application Number: 10800015.9

Publication Number: 2454966

IPC: A61M5/46, A61M37/00

Language of the proceedings: EN

Title of invention:

TATTOOING APPARATUS CAPABLE OF ADJUSTING THE CONCENTRATION OF
PIGMENT FLUID FOR TATTOOS OR SEMI-PERMANENT TATTOOS

Patent Proprietor:

Bomtech Electronics Co., Ltd.

Opponent:

MT.DERM GmbH

Headword:

Relevant legal provisions:

EPC Art. 54, 56

EPC R. 103(1)(a)

Keyword:

Novelty - (yes)

Inventive step - (yes)

Reimbursement of appeal fee - substantial procedural violation
(no)

Decisions cited:

Catchword:



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Case Number: T 0274/17 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 10 September 2021

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
6 December 2016 concerning maintenance of the
European Patent No. 2454966 in amended form.**

Composition of the Board:

Chairman	M. Alvazzi Delfrate
Members:	S. Dennler
	W. Sekretaruk

Summary of Facts and Submissions

I. The appeals lie from the Opposition Division's decision to maintain the contested patent in amended form. The Opposition Division found, *inter alia*, that the subject-matter of claim 1 as granted lacked novelty in view of

D1: EP 1 882 491 A1.

II. In its statement of grounds of appeal the appellant-opponent ("the opponent") requested that the decision under appeal be set aside and that the patent be revoked. Oral proceedings were requested as an auxiliary measure.

III. In its statement of grounds of appeal the appellant-patent proprietor ("the proprietor") requested, as a main request, that the decision under appeal be set aside and that the patent be maintained as granted. As an auxiliary measure, the proprietor requested that the patent be maintained in amended form on the basis of one of the first to third auxiliary requests filed with the statement of grounds of appeal, or, as a fourth auxiliary request, in the form allowed by the Opposition Division.

The proprietor further requested that the appeal fee be reimbursed. Oral proceedings were also requested as an auxiliary measure.

IV. The parties were summoned to attend oral proceedings on 25 August 2021.

By letter dated 7 July 2021 the opponent announced that it would not attend the oral proceedings.

By letter dated 2 August 2021 the proprietor declared that its request for oral proceedings did not apply to the situation in which the Board set aside the impugned decision and maintained the patent as granted.

The oral proceedings were cancelled by a communication dated 9 August 2021.

- V. Claim 1 of the **main request** (claim 1 as granted) reads as follows:

*A tattooing apparatus, comprising:
a tattoo needle (37) movable back and forth to a skin to allow a staining solution for tattoo contained in the apparatus to penetrate into the skin and thus to get a tattoo; **characterized in that**
the tattooing apparatus further comprises
a chamber pressure adjusting member (70) to adjust a degree of opening and closing an inlet of a storing chamber (34) in which the staining solution for tattoo is stored, thus to adjust a pressure in the storing chamber (34).*

- VI. In addition to D1 the following documents are also relevant to the present decision:

D2: US 4,798,582

D11: US 567,482

D15: *Valve Selection Handbook*, 5th edition, Peter Smith and R. W. Zappe, Elsevier (2004), pages 48-49, 52-53, 96-101, 108-113, 118-123, 136-137

VII. The opponent's arguments, as far as relevant to the present decision, may be summarised as follows:

Novelty over D1

The tattooing apparatus disclosed in Figure 1 of D1 comprised all the features of claim 1 as granted. In particular, paragraph [0013] disclosed that the storing chamber 20 could comprise an inlet formed as a vent valve to let air from outside enter the chamber, as in the contested patent. The vent valve could open or close the inlet, thus "adjust[ing] [its] degree of opening and closing" between a (fully) open position and a (fully) closed position. Hence, a chamber pressure adjusting member as defined in claim 1 was disclosed in D1. The subject-matter of claim 1 as granted was therefore not new over D1.

Inventive step starting from D1

The opponent also argued, in respect of the fourth auxiliary request, that the subject-matter of claim 1 lacked an inventive step.

D1 did not mention any specific construction for the vent valve. The objective technical problem to be solved starting from D1 was therefore merely to select a valve design to implement the vent valve in practice.

Faced with this problem, the person skilled in the art would have obviously consulted standard adjustable valves for controlling flow rates. Valves of this kind that were well known in the art included, for example, rotating valves (as shown e.g. in D15, pages 48-49), which would have enabled the opening of the inlet of the storing chamber to be continuously adjusted.

Moreover, a similar mechanism to that in the contested patent was disclosed in D11 to control the flow of ink flowing out of a shading pen (column 1, lines 40-49; Figure 3). In view of the similarity between this shading pen and the tattooing apparatus from D1 (which could also be qualified as a "tattooing pen" according to D2, column 2, lines 37 and 42), the person skilled in the art would have been prompted to implement this mechanism in the tattooing apparatus known from D1.

Hence, it would have been obvious to the person skilled in the art starting from D1 to arrive at the subject-matter of claim 1. The subject-matter of claim 1 therefore did not involve an inventive step in view of the combination of D1 with common general knowledge (as reflected in e.g. D15), D15 itself, or D11.

VIII. The proprietor's arguments, as far as relevant to the present decision, may be summarised as follows:

Novelty over D1

The expression "to adjust a degree of opening and closing an inlet" used in claim 1 had to be interpreted in the context of the patent. As supported by the description and emphasised by the use of the word "and", this expression necessarily referred to adjustment between configurations in which the inlet was at the same time open *and* closed (i.e. partly open and partly closed), albeit to different degrees. Only this interpretation was compatible with the technical problem addressed in the patent.

By contrast, the vent valve disclosed in D1 merely allowed the inlet to be either fully opened or fully

closed. Hence, it could not anticipate the chamber pressure adjusting member of claim 1 as granted, and therefore the subject-matter of this claim was new.

Inventive step starting from D1

The chamber pressure adjusting member from claim 1 as granted solved the technical problem of facilitating tattooing with varying colour intensities (concentrations).

D1 did not address this problem and neither disclosed nor suggested achieving adjustment of a discharging amount of the staining solution by adjusting the degree of opening and closing of an inlet. The person skilled in the art therefore would not have been motivated to implement the solution defined in claim 1 as granted.

D11 and D15 (which, furthermore, did not belong to the technical field of tattooing instruments) merely represented what the person skilled in the art *could* have (but not necessarily *would* have) done to implement the vent valve from D1 in practice.

The subject-matter of claim 1 as granted thus involved an inventive step.

Reimbursement of the appeal fee

The decision under appeal was based on an erroneous interpretation of the expression "to adjust a degree of opening and closing an inlet" by the Opposition Division, which had thus committed a substantial procedural violation. This interpretation was incompatible with the description of the patent and did not make technical sense in the context of the

technical problem addressed in the patent. This made the reimbursement of the appeal fee equitable.

Reasons for the Decision

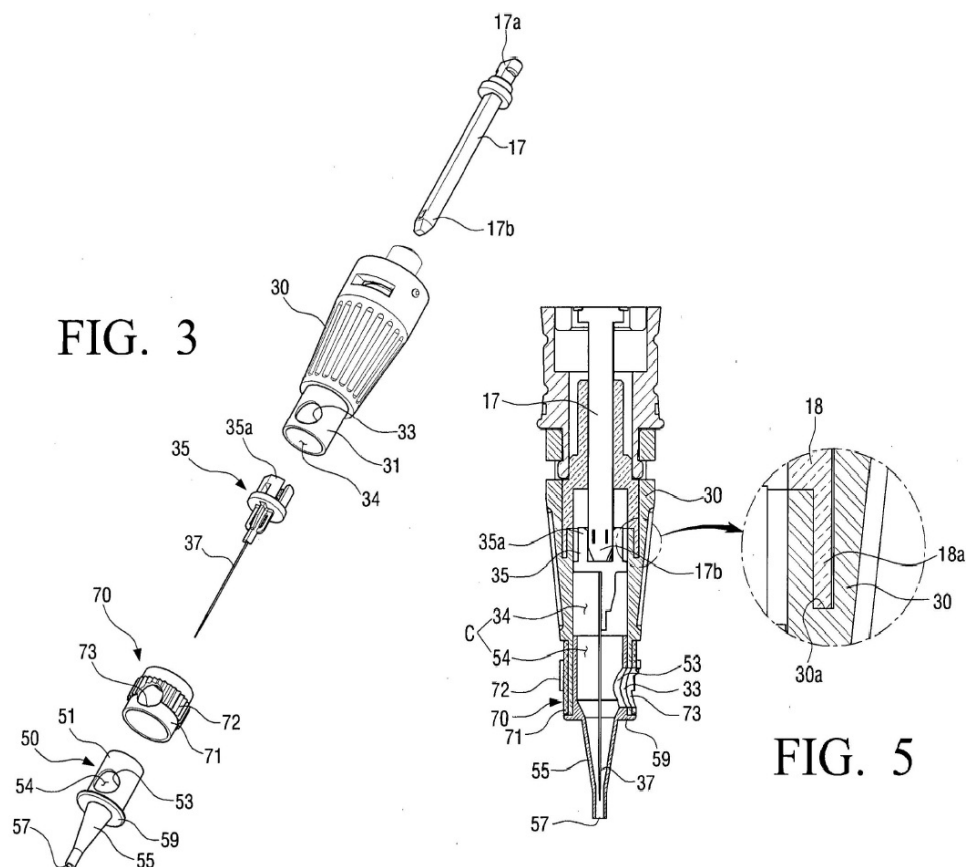
1. The subject-matter of the patent

1.1 The contested patent relates to a tattooing apparatus in which the flow of skin-staining solution discharged through the distal outlet can be conveniently adjusted. This enables tattoos with complex shadings and varying colour intensities (concentrations) to be easily produced (paragraphs [0004]-[0005]).

1.2 A tattooing apparatus according to claim 1 as granted is illustrated in Figures 3 and 5, reproduced below. It comprises, *inter alia*, a storing chamber (C, 34, 54) for storing a staining solution (paragraphs [0021] and [0028]) and a needle (37) adapted for penetrating the skin through a distal outlet (57). Due to the reciprocating motion of the needle (37) and needle support (35) within the storing chamber, the staining solution is forced to discharge through the outlet and to penetrate into the skin, thus creating the tattoo (paragraphs [0022]-[0024] and [0029]).

The staining solution becoming depleted in the storing chamber creates an underpressure within the storing chamber (paragraph [0036]), which causes air from outside to enter the storing chamber through an inlet (33, 53), via which the storing chamber communicates with the atmosphere. The amount of staining solution discharged from the outlet depends on the resulting

equilibrium pressure within the storing chamber (paragraphs [0038]-[0040]).

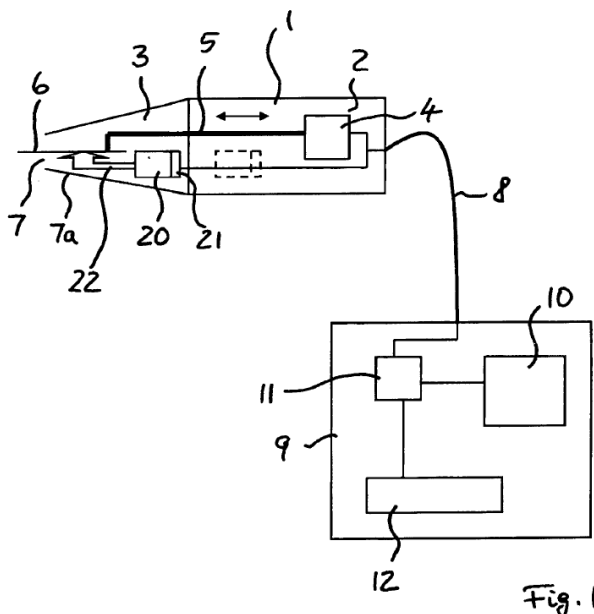


1.3 In the invention of the patent, this pressure, and therefore the flow of staining solution ultimately discharged from the outlet, can be conveniently adjusted by a chamber pressure adjusting member (70) controlling the degree of opening and closing of the inlet. In the illustrated embodiment, the chamber pressure adjusting member is rotatable and comprises an inlet (73) with a size substantially corresponding to that of the inlet of the storing chamber (paragraphs [0031]-[0033]). Rotating the chamber pressure adjusting member adjusts the overlap of the two inlets, and therefore the effective opening of the inlet (Figures 4 and 6; paragraphs [0038]-[0040]).

2. Main request (claim 1 as granted)

2.1 Novelty over D1

2.1.1 It is common ground that D1 discloses a tattooing apparatus (paragraph [0011]: "Tattoo-Handgerät"; see Figure 1 reproduced below) comprising a tattoo needle (6) movable back and forth (by an actuating unit 2, or "Antriebseinrichtung") to allow a staining solution for tattooing ("flüssige[r] Wirkstoff") contained in the apparatus (in a storing chamber 20, or "Reservoir") to penetrate into the skin and thus to create a tattoo.



Moreover, paragraph [0013] discloses that, in one embodiment, the storing chamber also comprises an inlet ("Öffnung") provided with a vent valve ("Lüftungsventil"). As in the contested patent, the inlet lets air from outside enter the storing chamber to compensate for depletion of the staining solution during the process of tattooing ("Öffnung zum Nachführen von Luft beim Ausbringen des flüssigen Wirkstoffs").

2.1.2 It is undisputed that the vent valve has a closed state and an open state.

However, according to the present claim 1, the chamber pressure adjusting member does not merely open and close the inlet, but is adapted to "adjust a degree of opening and closing" of the inlet. Taken literally (especially in view of the word "and"), this expression means that the adjustment must take place between configurations in which the inlet is at the same time "open and clos[ed]" (i.e. partly open and partly closed), albeit to different "degree[s]". The same interpretation is also derived from the context of the patent. In particular, it is in line with the technical problem addressed in the patent and the proposed solution, which is based on adjusting the pressure in the storing chamber via a specific chamber pressure adjusting member, which necessarily requires fine control of the inlet that goes beyond merely (fully) opening and (fully) closing the inlet (paragraphs [0038]-[0040]).

By contrast, it can only be derived from D1 that the vent valve either opens or closes the inlet of the storing chamber. This is not disputed by the parties.

As a result, contrary to the view held by the opponent and the Opposition Division (point II.I.1 of the appealed decision), D1 fails to disclose a chamber pressure adjusting member for adjusting a degree of opening and closing the inlet of the storing chamber, thus to adjust a pressure in the storing chamber.

The subject-matter of claim 1 as granted is therefore new over D1 (Article 54(1) and (2) EPC).

2.2 *Inventive step*

Some of the opponent's arguments on inventive step, although formally raised in respect of the fourth auxiliary request, equally apply to the main request. They have thus been taken into consideration when assessing the inventive step of the subject-matter of claim 1 as granted.

2.2.1 In allowing fine control of the pressure in the storing chamber, the chamber pressure adjusting member of the claimed apparatus enables the amount of staining solution discharged from the needle to be adjusted in a convenient way. This enables tattoos with varying concentrations to be produced easily (paragraphs [0038]-[0040]).

2.2.2 The Board notes that, contrary to the proprietor's assertion, the tattooing apparatus from D1 also allows the amount of staining solution discharged from the needle to be adjusted, hence implicitly allowing the creation of tattoos with varying concentrations (paragraph [0012]: "*Mit Hilfe der Pumpeinrichtung können sowohl die Menge als auch die Zeitpunkte für das Ausbringen von Teilvolumina des flüssigen Wirkstoffs für beliebige Anwendungen individuell bestimmt werden*").

However, in this apparatus, the controlled discharge of staining solution is achieved by means of a pump ("*Mit Hilfe der Pumpeinrichtung*") which conveys the staining solution under pressure to the needle (paragraph [0011]: "*um den (...) flüssigen Wirkstoff mittels Druckbeaufschlagung auszubringen*") in accordance with pump operating parameters set by the user via a control unit (paragraph [0030]: "*Über das Steuergerät ist es*

dem Benutzer (...) ermöglicht, die Anregung der Pumpeinrichtung Benutzereingaben entsprechend zu regeln").

The person skilled in the art understands that the function of the inlet and vent valve of the storing chamber in the apparatus from D1 is limited to allowing air from outside to enter the storing chamber in a sufficient quantity to compensate for the depletion in staining solution (paragraph [0013]), such that the staining solution can be appropriately pressurised by the pump in accordance with the parameters set by the user. D1 lacks any suggestion that the vent valve should be adjustable and should allow several "degrees of opening and closing" of the inlet so that the flow of air entering the storing chamber could be controlled and the pressure in the storing chamber could be adjusted.

2.2.3 Therefore, the person skilled in the art starting from D1 and seeking, as argued by the opponent, to implement a vent valve (for which D1 does not disclose any structural details) in practice would not have been motivated, without the benefit of hindsight, to select a valve configured to adjust a degree of opening and closing the inlet (this expression being interpreted as discussed in point 2.1.2 above), thus to adjust the pressure in the storing chamber.

2.2.4 The valves disclosed in D15 are merely examples of adjustable valves that the person skilled in the art, using common general knowledge or in view of this document, *could* have implemented in the apparatus of D1, but *would* not have implemented in the absence of any suggestion in D1 in that sense, as discussed above.

- 2.2.5 The fact that D11 discloses a shading pen in which the ink flow can be manually adjusted via a similar mechanism to the rotatable chamber pressure adjusting member from the contested patent does not contradict the conclusion above.

Firstly, in the Board's view, the mere fact that a tattooing apparatus may be called a "pen" (as the opponent argued, referring to D2) is not a sufficient reason for the person skilled in the art starting from D1 to consult D11. This document concerns a shading pen and as such belongs to a technical field remote from tattooing instruments.

Secondly, implementing the ink flow regulation mechanism disclosed in D11 in the apparatus from D1 would require significant non-obvious modifications, in particular removing one of the components at the core of the tattooing apparatus from D1, the pump - which would otherwise actively pressurise the staining solution at the pressure set by the user on the control unit, thereby preventing the flow regulation mechanism from D11 from functioning as intended. Therefore, even if the person skilled in the art had considered D11, they would still not have envisaged such modifications.

- 2.2.6 For these reasons, the Board concludes that the subject-matter of claim 1 as granted involves an inventive step (Article 56 EPC).

3. Reimbursement of the appeal fee

- 3.1 According to Rule 103(1)(a) EPC the appeal fee is reimbursed where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial *procedural* violation.

3.2 It is true that in the present case the Opposition Division's interpretation of the expression "to adjust a degree of opening and closing an inlet" has been found to be incorrect (point 2.1.2 above). However, a wrong assessment of the claimed invention is a *substantive* issue and is therefore not a *procedural* violation. Hence, there is no basis for the appeal fee to be reimbursed under Rule 103(1)(a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is maintained as granted.
3. The proprietor's request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



D. Hampe

M. Alvazzi Delfrate

Decision electronically authenticated