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Anmeldenummer / Filing No / N^o de la demande : 84 113 449.7

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Bezeichnung der Erfindung: Flexible disk jacket

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : G11B 23/033

ENTSCHEIDUNG / DECISION

vom / of / du 25 April 1989

Anmelder / Applicant / Demandeur : Fuji Photo Film Co., Ltd.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Articles 52(1), (2), (3), 54,

Schlagwort / Keyword / Mot clé : Claim 1: "Aesthetic creation (yes)" -
Claim 2: "Novelty (no)"

Leitsatz / Headnote / Sommaire

Headnote follows

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Patentamt

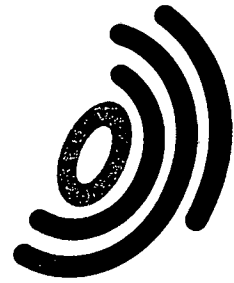
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Chambres de recours



Case Number : T 119/88 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 25 April 1989

Appellant : Fuji Photo Film Co., Ltd.
210 Nakahuma
Minamiashigara-shi
Kanagawa-ken
Japan

Representative : LOUIS, PÖHLAU, LOHRENTZ & SEGETH
Kesslerplatz 1
Postfach 3055
D-8500 Nürnberg

Decision under appeal : Decision of Examining Division 067
of the European Patent Office
dated 12 October 1987 refusing
European patent application
No. 84 113 449.7 pursuant to
Article 97(1) EPC

Composition of the Board :

Chairman : P.K.J. van den Berg
Members : W.B. Oettinger
F. Benussi

Summary of Facts and Submissions

- I. European patent application No. 84 113 449.7, filed on 7 November 1984 claiming a priority of 11 November 1983, and published under No. 144 783, was refused by a decision of Examining Division 2.2.08.067 dated 12 October 1987.
- II. The reason for the refusal was that the subject-matter of Claims 1 and 2, filed on 24 June 1987, did not involve an inventive step.

These claims read as follows:

"1. A flexible disk jacket for accommodating therein a magnetic flexible disk shaped recording medium formed by folding a plastic sheet into a bag-like shape characterised in that the plastic sheet contains a pigment having a colour other than black so that at least the outer surface of the plastic sheet is coloured in a colour having a Munsell value (V) not smaller than 3.

2. A flexible disk jacket for accommodating therein a magnetic flexible disk shaped recording medium formed by folding a plastic sheet into a bag-like shape characterised in that the plastic sheet comprises at least one coloured layer having a colour other than black, wherein said coloured layer is superposed on a surface of a plastic sheet so that at least the outer surface of the plastic sheet is coloured in a colour having a Munsell value (V) not smaller than 3."

More specifically, the Examining Division held that it is obvious to modify a known flexible disk jacket containing carbon as an antistatic agent and being therefore black, in such a way that its disadvantages mentioned in the

description are overcome. Some of these disadvantages are of an aesthetic nature and the problem of avoiding them is therefore an aesthetic problem. Others of these disadvantages are obvious and the claimed solution is also obvious.

- III. On 17 December 1987, the applicant lodged an appeal against that decision and requested that it be cancelled in its entirety. The appropriate fee was paid on the same day.

A statement of grounds of appeal was filed on 18 January 1988.

- IV. In a communication pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal, the Board also expressed some doubts in respect of the question of patentability at issue, possibly even as to novelty. In support of this, it drew the Appellant's attention to the following general knowledge or specific prior art respectively:

- office supplies using colours for classification purposes;
- the use of light coloured labels on disk jackets for similar purposes or for being marked with a writing tool;
- DE-A-2 634 501 disclosing the use of a paint containing silver particles, instead of carbon, as an antistatic agent, on the inner or outer surface of a disk jacket.

- V. The Appellant's arguments in support of patentability, as submitted in the statement of grounds and in oral proceedings, held on 25 April 1989, can, in essence, be summarised as follows:

The aim of the invention is to avoid disturbing visible fingerprints on objects touched by humans. Both the problem and solution are of a technical nature. The effect of fingerprints is a real phenomenon which can be detected by technical apparatus. In support of this, reference should be made to diagrams (handed over to the Board) showing rate of gloss, measured with a glossmeter, versus looking angle, viz (Figure 1) for a black disk jacket with and without fingerprints and (Figure 2) for a green disk jacket with and without fingerprints. Figure 1 shows a very much greater rate of gloss for the untouched jacket than for one which had been "fingerprinted" whereas Figure 2 shows no great difference.

The difference in the effect of fingerprints was further demonstrated by the Appellant's representative with models (handed over to the Board) of black disk jackets and of light coloured disk jackets.

This property of a disk jacket having the claimed features is unobvious. It is agreed that other properties are advantages which are obvious, but this is not relevant if an unobvious advantage is achieved. In this respect, reference is made to German jurisprudence.

The antistatic properties can be maintained by other measures, e.g. an inner layer having the necessary electrical conductivity in the case of Claim 1, or the plastic sheet having such property in the case of Claim 2.

There is no disclosure in DE-A-2 634 501 of the problem underlying the invention nor of the claimed solution. Even if it discloses the use of a paint containing silver

particles instead of carbon as the antistatic agent, this does not mean that the jacket shows a colour other than black, in particular with a Munsell value not smaller than 3.

- VI. The Appellant supplements his request in that the grant of a patent on the basis of the following application documents on file is requested:

Description pages 1-5 as published;
Claims 1 and 2 filed on 24 June 1987.

Reasons for the Decision

1. The appeal is admissible.
2. No formal problem arises from the amendments filed on 24 June 1987.
3. In essence, the subject-matter of the application is a flexible disk jacket made of a plastic sheet which presents, to the outside world, a surface which has a colour of a certain minimum light intensity, either by the plastic sheet itself containing a respective pigment (Claim 1) or by its having a respectively coloured layer (Claim 2).

3.1 Claim 1:

Prior art flexible disk jackets as defined in the precharacterising portion used to be black as a natural consequence of the fact that they were made of a material containing carbon black pigments for rendering it opaque (GB-A-2 097 988, page 1).

Another reason for adding carbon black to the material of which flexible disk jackets used to be made may have been that thereby the material is rendered electrically conductive, i.e. antistatic, as is generally well-known and, for instance, employed in an adhesive layer of disk jackets (GB-A-2 097 988, page 2) or in a paint coating on disk jackets (DE-A-2 634 501, page 19, lines 17-20).

It is not known, however, from any of the prior art documents mentioned in the Search Report to replace the carbon black content in the plastic sheet material itself by a pigment having a colour other than black.

So Claim 1 is distinguished over the prior art by the feature that the pigment contained in the plastic sheet material is of a range of colours other than black.

3.2 Claim 2:

As stated above, it is known to cover the surface of a disk jacket with an electrically conductive layer containing carbon black (DE-A-2 634 501, page 19, lines 17-20). Apparently, this measure replaces the carbon black content of the disk jacket material as it has the same effects (opacity and antistatic property).

As alternatives, DE-A-2 634 501 discloses the following equivalent layers (page 19, lines 25-31) also having these effects:

- a paint containing silver particles,
- a foil of copper, aluminium, gold or platinum,
- the surface of the jacket being metallised with aluminium.

Preferably the layer, i.e. the paint or foil or metallisation, should be applied to the inner surface of the jacket but the document explicitly mentions, as an alternative, the possibility of applying them on the outer surface (page 20).

The DE-document does not disclose explicitly anything as to the colour which the disk jacket should present to the viewer. But, it is clearly implicit in the document that, if carbon black is not used, the jacket is not necessarily black because the alternatives are not necessarily black, and the document does not teach any replacement measures for maintaining the disk jackets black, if carbon black is absent in the aforementioned alternatives.

It must further be considered to be an every day experience that, for instance, a paint containing silver particles may present a relatively light colour or that an aluminium metallisation or a foil of, for instance, aluminium or gold would present a relatively light colour.

In some of the alternatives proposed for the electrically conductive layer and in one of the two alternatives proposed for the surface on which the layer may be applied, the known disk jacket would therefore present, to the viewer, a relatively light colour.

As is well known, the light intensity of a colour can be expressed by the Munsell value, ranging from 0 to 10.

Accordingly, in the present case, the particular Munsell value (3), claimed as the limit value for the range of possible colours, has no other significance for the claimed disk jacket than to define a range of colours which is light enough, particularly for concealing

fingerprints, at least to some extent. The lighter the colour, the less clear the fingerprints. With a Munsell value smaller than 3, no significant difference from a black colour in respect of the appearance of fingerprints could be recognised. This follows, for instance, from the table on page 5.

Consequently, in some of its embodiments corresponding to the alternatives mentioned above, namely with a relatively light coloured outer paint or metallisation or foil, the known disk jackets would fall within the scope of Claim 2. Therefore, Claim 2 is not distinguished from the prior art as disclosed in DE-A-2 634 501.

3.3 Since, for these reasons, Claim 2 lacks novelty, it needs not to be considered any further; i.e. only Claim 1 will be considered in respect of other requirements for patentability.

4. Exclusion from patentability under Article 52(2) and (3) EPC.

4.1 The technical features in the prior art part of Claim 1 are known from DE-A-2 634 501, but also from GB 2 097 988. From the latter document it is furthermore known that the plastic sheet contains a pigment. Claim 1 is distinguished from this prior art only by the feature that the pigment is of a colour other than black within a specific range of light intensity.

Prima facie the feature of having a specific colour as such does not constitute a technical feature of an object or device being entirely or partly covered by that colour.

However, the Board does not exclude that this does not hold under all circumstances.

This feature taken by itself seems not to reveal any technical aspect. However, the technical or non-technical character of this feature may be decided by the effect it brings about after it has been added to an object which did not comprise this feature before.

In considering whether the subject-matter of a claim is excluded from patentability under Article 52(2) and (3) EPC, i.e. whether it is non-technical or not, that claim has to be considered in its entirety. This is in line with decisions T 38/86 and T 65/86 (both to be published). In these decisions, Article 52(3) EPC was interpreted so as to mean that the subject-matter of a claim is not excluded from patentability under Article 52(2)(c) EPC, if the said subject-matter contributes anything to the prior art in a field that is not excluded from patentability. In these cases this was only applied with regard to paragraph (2)(c) of Article 52.

However, once applied to paragraph (2)(c) it must hold for all the paragraphs of Article 52(2), since Article 52(3) refers to all the items summed up in Article 52(2).

It seems to the Board, therefore, that it has to be investigated whether the effects implied by the sole feature of possessing a specific colour, could render that feature into a feature not excluding from patentability the known object or device provided with that colour.

4.2 In this respect the following is noted:

The description (page 2, lines 6-10) states as "the primary object" of the invention "to provide a flexible disk jacket the outer surface of which is coloured in a colour other than black and is resistant to marking with fingerprints", referring, in this context, back to "the foregoing observations and description".

Clearly this involves two objects which are not identical.

- A. The object of having the disk jackets "coloured in a colour other than black" seems to refer back to the demand, mentioned on page 1, line 27 to page 2, line 2 for disk jackets which are "more attractive in appearance" because they are "coloured in various fresh chromatic colours".
- B. The object that they shall be "resistant to marking with fingerprints" has nothing to do with chroma but relates to the darkness of black disk jackets on which fingerprints are clearly visible as mentioned on page 1, lines 20-21.

The Appellant's submission that only the fingerprint problem should be regarded as the "primary" object of the claimed invention thus appears to be inconsistent with the wording of page 2, lines 6-10.

Apart from these "primary" objects, there are, according to the application, further aspects of a colour other than black.

These are indicated by statements to the effect that:

- C. variously coloured disk jackets "could be easily classified by colour" (page 2, line 2); and

- D. disk jackets in relatively light colours "can be directly marked with a writing tool" (page 2, line 25).

In the following, each of these alleged objects and/or advantages will be considered individually:

- A. There is no dispute over the fact that the attractiveness of a chromatic colour other than black is a mere aesthetic effect.

If the claimed invention were confined to achieving this effect it would have to be regarded as an aesthetic creation as such which is excluded from patentability by Article 52(2)(b) and (3) EPC.

- B. The resistance to marking with fingerprints has also an aesthetic effect. Fingerprints do not in any way degrade the technical function of a disk jacket as a protection for the disk. They are only undesirable for the viewer from an aesthetic point of view (cf. also GB-A-2 097 988, page 1, lines 8-9).

The Appellant agrees to this to some extent but submits that nevertheless the appearance of fingerprints is combined with, and based on, a technical effect, i.e. differences in rate of gloss, which can be detected by an apparatus, a glossmeter.

The Board has no doubts that this is true. However, in its opinion, this submission does not establish any technical character of the invention as claimed.

It is quite normal that an aesthetic effect is combined with, or based on, a physical effect and can thus be detected by an apparatus. For instance, this holds to

the use of chromatically different colours; they can spectrometrically be distinguished by an apparatus. Nevertheless, the purpose of their application is often only aesthetical and were the claimed invention confined to achieving this effect, it would again have to be regarded as an aesthetic creation, included under Article 52(2)(b) in combination with Article 52(3) EPC.

The Appellant has, in this respect, further submitted that the "resistance to marking with fingerprints" should not be regarded as being only a matter of appearance of the fingerprints but as a matter of their presence or absence after the disk jacket has been touched with greasy fingers.

The Board does not believe that such absence can be achieved by the features proposed in Claim 1.

Prima facie the physical adhesion of grease to the jacket is only a matter of the material of its surface and not of the colour of that surface; the less clear optical appearance of the result of such a fingerprint on a light coloured disk jacket should, however, prima facie, be attributed to its light reflecting properties, in particular to the fact that a lighter coloured object reflects more light diffusedly which will, at least partly, conceal the differences in rate of gloss caused by fingerprints.

The submission that there is a difference in adhesion of fingerprints between a black and a lighter coloured disk jacket has not been corroborated by verifiable facts. It appears unlikely that the kind of plastic sheet material used is of no importance for the alleged

effect, and neither the description nor the theories offered in the statement of grounds for this effect nor Figures 1 and 2 submitted at the oral proceedings mention any particular materials.

Consequently, the alleged effect, according to which there will not even be any fingerprints present on the disk jacket (as opposed to being present but not visible to the human eye) after it has been touched with greasy fingers, not having been established, its recurrence is denied.

It needs, therefore, no further investigation as to in how far this alleged effect would have been technical and by that would have contributed to the technical character of the present invention according to Claim 1. Therefore, the Board considers the alleged "resistance to marking with fingerprints" within the content of the present application as a purely aesthetic effect which contributes nothing technical to the invention concerned.

- C. The further advantage that variously coloured disk jackets can be easily classified by colour, represents again a non-technical effect because classifying disk jackets by colour means presenting an information, e.g. about the data stored on the disk, by way of a colour code.

Such presentation of information would, as such, be excluded from patentability by Article 52(2)(d) and (3) EPC.

- D. The Board does not deny that the alleged additional advantage, that light coloured disk jackets can be directly marked with a writing tool, seen as an object

of the claimed invention, might be considered as technical. However, the Board notes that this effect is not novel since it is immediately clear that also the prior art disk jackets can be directly marked with a (appropriate or adapted) writing tool.

This means that this alleged effect does not contribute anything to the prior art at all, and therefore it needs not to be considered whether any contribution lies in a field not excluded from patentability.

- 4.3 From the foregoing, it follows that the contribution to the prior art by the subject-matter of Claim 1, being the feature that the pigment contained in the plastic sheet material is of a specific range of colours other than black, in itself does not belong to a field not excluded from patentability, since the feature in itself is non-technical. It furthermore follows that the said feature in its effects does not make any contribution to such a field either, since each of the said effects A, B, C and D pertain to fields excluded as such or does not make any contribution at all.

Therefore, the invention as claimed in Claim 1 in no way contributes anything to a field not excluded by Article 52(2)(b), (d) and 52(3) EPC and is therefore not an invention within the meaning of Article 52(1) EPC.

5. Summarising, Claim 1 does not pertain to an invention within the meaning of Article 52(1) EPC and the subject-matter of Claim 2 is not novel.

Order

For these reasons, it is decided that: ..

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

P.K.J. van den Berg