BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

A		B		C	X

File Number: T 579/91 - 3.4.2

Application No.: 83 306 380.3

Publication No.: 0 109 208

Title of invention: Microscope slides with a marking surface

Classification: G02B 21/34

D E C I S I O N
of 14 December 1992

Applicant: ERIE SCIENTIFIC COMPANY (a Delaware Corporation)

Opponent: Waldemar Knittel Glasbearbeitungs GmbH & CO, KG

Headword:

EPC Articles 54, 56

Keyword: After amendments: main request (novelty: yes; inventive step: no); auxiliary request (novelty: yes; inventive step: yes)

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number : T 579/91 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 14 December 1992

Appellant : (Opponent)
Waldemar Knittel Glasbearbeitungs GmbH & CO, KG
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Representative :
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Respondent : (Proprietor of the patent)
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Decision under appeal :
Decision of the Opposition Division of the European Patent Office dated 7 May 1991, posted on 6 August 1991 rejecting the opposition filed against European patent No. 0 109 208 pursuant to Article 102(2) EPC.

Composition of the Board :

Chairman : E. Turrini
Members : M. Chomentowski
C.V. Payraudeau
C. Black
L.C. Mancini

Summary of Facts and Submissions

I. The Respondent is proprietor of the European patent No. 0 109 208, which was granted on the basis of European patent application No. 83 306 380.3.

II. The Appellant (Opponent) filed an opposition against the European patent on the grounds that the subject-matter of the claims of the opposed patent lacked novelty having regard to a prior public use based on a plurality of testimonies attesting that microscope slides with a raised surface had been put on the market by the Appellant before the claimed priority date, or did not involve an inventive step because it was trivial and obvious for a skilled person.

III. The opposition was rejected. The Opposition Division considered that the prior public use could not be proven and that, moreover, the claimed subject-matter was not trivial and obvious for a skilled person.

IV. The Appellant lodged an appeal against this decision. He requested that the decision under appeal be set aside and the patent be revoked on the grounds that the subject-matter of the claims in dispute lacked novelty or an inventive step having regard to the testimonies already provided and to further testimonies concerning prior public use, in particular

D11: declaration of Mr.Christopher Hendley, (with a slide leaflet, two certificates of registration for value added tax, issued on 23 March 1978 and 20 December 1979, respectively, two sample slides, for clients MELOY and ZS, an envelope, letter and photograph of a client, a business card of MELOY),

and to documents, in particular

D13: Annals of New York Academy of Sciences, Vol. 177, 21 June 1971, first page, first page of contents, pages 134, 135, 446 and 447,
D14: Generalkatalog 1964 der Firma Rudolf Brand (page 174), front page and page 174,
D15: Katalog Nr. 66 "SCHOTT Glas für Laboratorien", pages 22 to 25,
D16: letter of Firma SCHOTT of 26 August 1991, concerning the "Katalog Nr. 66",
D17: letter of Firma SCHOTT of 7 November 1991, also concerning the "Katalog Nr. 66",
D18: Walter Wittemberger Chemische Laboratoriumstechnik", 7. Auflage, 1973 (pages 48 to 51),
D19: Meyers Lexikon der Technik und der exakten Naturwissenschaften" 1970, pages 1704 to 1705,
D20: Kunststoff- Lexikon (Carl Hanser Verlag München Wien 1981), pages 160 to 163,
D21: leaflet of Wiederhold Siebdruckfarben,
D22: letter of Wiederhold Siebdruckfarben dated 15 October 1991.

Moreover, the Appellant requested oral proceedings.

V. The Respondent filed new testimonies in addition to those already provided by him, requested that the appeal be dismissed, that the patent be maintained in the form as granted and that oral proceedings take place.

VI. In a communication, the Board expressed the opinion that the subject-matter of Claim 1 in dispute as granted did not appear to be novel because the documents D11 and D13 disclosed a microscope slide with a raised surface, the feature that the raised surface is a marking surface

depending only on the marking instrument and being thus not a distinguishing feature.

Moreover, the subject-matter of said Claim 1 did not appear to involve an inventive step having regard to the disclosure in

D24: GB-A-10 701 (A.D.1915) and
D25: US-A-4 188 246,

both cited in the European search report, whereby the microscope slide of D24 could be made in an obvious way by using the technique for providing a raised surface of transparent material as known from D25 in the same field.

VII. During the oral proceedings, the Respondent filed new texts of the patent and requested that the appeal be dismissed and that the patent be maintained on the basis of the set of Claims 1 to 4 of the main request and the correspondingly amended description or on the basis of the set of Claims 1 to 3 and the correspondingly amended description of the auxiliary request, both with the drawings of the patent as granted.

VIII. Main request

Claim 1 reads as follows:

"1. A microscope slide comprising a glass plate having at least one marking surface only on one end portion thereof, characterized in that the marking surface is a raised surface and also provides a clearance space between successive slides in a stack thereof, thereby avoiding contact of the surface of one slide with that of another and preventing the slides from sticking to one another said marking surface being formed by applying a coating of

a fluid material to the glass plate and allowing the coating to dry or otherwise become solid said fluid material includes a granular medium which imparts porosity to the solidified coating layer and a pigment which provides a visual contrast to the marking surface, to enhance the visibility of markings made thereon."

Claims 2 to 4 are dependent claims.

Auxiliary request

Claim 1 reads as follows:

"1. A microscope slide comprising a glass plate having at least one marking surface only on one end portion thereof, in which the marking surface is a raised surface and also provides a clearance space between successive slides in a stack thereof, thereby avoiding contact of the surface of one slide with that of another and preventing the slides from sticking to one another said marking surface being formed by applying a coating of a fluid material to the glass plate and allowing the coating to dry or otherwise become solid said fluid material is a resinous material which also includes a granular medium which imparts porosity to the solidified coating layer and a pigment which provides a visual contrast to the marking surface, to enhance the visibility of markings made thereon."

Claims 2 and 3 are dependent claims.

IX. The Appellant submitted the following arguments in support of his requests:

The patent in suit claims a microscope slide having two separate features i.e. the use of a raised marking surface on one end of the microscope glass slide and the use of a

fluid material comprising a granular medium and a pigment which is allowed to solidify for forming a porous coating layer. However, a slide having on one end thereof a piece of paper or the like for separating it from other slides, said piece being affixed to the surface of the slide for instance by using an adhesive medium and being also for marking purposes, is known from D24. Moreover, it is known from D11 and D13 to provide a portion of the surface of a microscope slide with a coating formed by applying a dispersion of PTFE and allowing it to dry or otherwise become solid; the coating of PTFE is either white or black and thus contains a pigment which provides a visual contrast to the raised surface; since the PTFE layer is formed by using an aerosol preparation of this material, it does not differ from the raised surface of the slide in dispute, which has an unspecified resulting porosity and which may consist of the particles of the PTFE preparation, of the pigments or of an additional adhesive material; the raised surface of the slide of D11 and D13 is not mentioned as being a marking surface, but this cannot be a distinguishing feature because it depends primarily from the marking instrument, which is not specified in the claim.

There is therefore no invention to be seen in using as marking surface for the slide disclosed in D24 a layer obtained by solidifying a coating formed of a fluid material so chosen that the surface will be appropriate to be marked with any given marking instrument.

The skilled person could also arrive at this result by transposing to a slide the teaching of D15 to D22 for writing on the surface of laboratory glass articles such as bottles, which pertain to the same technical field as microscope slides.

Therefore, for any of these reasons, the skilled person can arrive to the slide in dispute, for both requests, in an obvious way.

X. The Respondent submitted the following arguments in support of his requests:

The microscope slide of D11 or D13 comprises a raised surface formed by applying on a standard glass plate a coating of PTFE; however, this coating is used for defining test windows on the slide and not for forming a marking surface. It is not restricted to an end portion of the slide, but covers substantially the whole surface thereof except for the test windows. The fluid material (PTFE) used for forming the coating does not include a granular medium which imparts porosity to the solidified coating layer. There is no reason why the skilled person should envisage rendering it porous since this coating is not intended to be used as a marking surface but must be water-repellent to isolate the test surfaces, and this prevents it from accepting marking made with the commonly used marking instruments.

None of the relevant prior art documents discloses or suggests the precise manner according to which the raised surface of the slide of the invention is rendered porous. The substitution of a raised surface for the glued label disclosed in D24 cannot be considered as obvious since although this document was published in 1917 and the drawbacks of such solution are recognised, no proposal for avoiding these drawbacks has been made except for the use of a ground marking surface on the glass plate, solution which leads away from the present invention and presents the drawback that superposed slides, not being separated by a raised surface, may stick together.

Having regard to the technique of D15 to D22 for forming raised marking surfaces on bottles, it cannot be transposed in an obvious way to microscope slides, which do not pertain to the same technical field. Therefore, it is only by hindsight that the skilled person could arrive in an obvious way at the slide of the main request or at the slide of the auxiliary request, which specifies further the fluid material, by starting from D11, D13, D24 or D15 to D22.

Reasons for the Decision

1. The appeal is admissible.

2. Main request

2.1 Novelty

2.1.1 Since none of the documents of the prior art discloses a microscope slide having all the features of Claim 1 in dispute, its subject-matter is novel in the sense of Article 54 EPC.

2.2 Inventive step

2.2.1 A microscope slide is known from the leaflet of D11 and the corresponding publication D13 (see page 446, the two first paragraphs; Figure 1) which are therefore to be considered in combination. The slide comprises a glass plate having a raised surface formed by applying on it a fluid material comprised of an aerosol preparation of PTFE and allowing the coating to dry or otherwise become solid.

The PTFE coating of the aerosol is in some given granular form and, since there is no indication in Claim 1 in dispute that the granular medium does not consist of the particles of the fluid material and, moreover, since there is no definition in the patent in suit of the porosity of the raised surface, these features of the claim cannot be considered as differentiating the subject-matter of Claim 1 in dispute from the prior art as represented by the documents D11 and D13.

The coating of the prior art slide of D11, D13 is either white or black and, thus, it must necessarily contain a pigment which provides a visual contrast to the raised surface. Therefore, this feature cannot distinguish the subject-matter of Claim 1 in dispute over the prior art of D11, D13.

Since the raised surface provides necessarily a clearance space between successive slides in a stack thereof, this feature also cannot be considered as a distinguishing feature.

Moreover, since the nature of the writing instrument which may be used for marking the surface is not specified in Claim 1 in dispute and since it is possible to write on PTFE surfaces with at least some writing instruments, the feature that the raised surface is a "marking" surface cannot distinguish the slide of Claim 1 in dispute from the known slide of D11, D13.

Thus, the only new feature of Claim 1 in respect of the prior art of D11 and D13 is that the raised surface is provided only on one end of the slide in dispute. However, it should be noted that this feature of a raised surface, and in particular of a "marking" surface, provided only on one end of a slide, is per se well known in the art (see

for instance D24, Figure 2) and is not in itself sufficient to justify an inventive step.

2.2.2 Therefore, the subject-matter of Claim 1 in dispute does not involve an inventive step in the sense of Article 56 EPC.

2.3 Therefore, the main request is not allowable (Article 52(1) EPC).

3. Auxiliary request

3.1 Novelty

3.1.1 The subject-matter of Claim 1 in dispute is not known from the prior art and is thus novel (Article 54 EPC).

3.2 Inventive step

3.2.1 In contrast with Claim 1 of the main request, Claim 1 of the auxiliary request is further limited by the addition of the feature that the fluid material "is a resinous material" which "also" includes a granular medium which imparts porosity to the solidified coating layer. This limitation means that the granular material cannot be the main component of the fluid material for forming the coating but is added to a special purpose, i.e. to confer to the coated layer a given porosity over the normal porosity of the resin for increasing the marking properties of its surface. This means that the slide disclosed in D11, D13 which comprises a coating of PTFE for delimiting test areas and which only contains a pigment as additive and does not address the problem of the marking or labelling of the slide cannot be considered as the nearest state of the art.

The nearest state of the art to the subject-matter of Claim 1 of the auxiliary request is therefore the disclosure of D24 (see page 2, lines 22 to 26 and 33 to 36; page 3, lines 10 to 14; Figure 2), which shows a microscope slide comprising a glass plate on one end portion of which is glued a separating piece of paper used for marking purposes. According to the patent in suit (see column 2, lines 35 to 40), the common practice of attaching adhesive-backed paper labels to slides such as disclosed in D24 does not provide permanent labelling because such paper labels are liable to fall off, peel off or wash off when contacted by solvents or the like.

3.2.2 The solution proposed by the invention to use for the marking surface a coating formed from a resin which also includes a granular medium which increases its porosity is neither disclosed nor suggested in any of the cited documents.

3.2.3 The person skilled in the art trying to solve the problem raised by the slide of D24 would not be incited to look at D11, D13 since these documents do not concern the problem of labelling the slides but the formation on a slide of a series of isolated test areas. Moreover, the coating of the slide of these documents is made of PTFE without any suggestion that the coating should be given more porosity to increase its "marking" properties.

The person skilled in the art would not either find the solution claimed in Claim 1 according to the auxiliary request by looking at D25. This document (see column 1, lines 38 to 50; column 1, line 66 to column 2, line 8; column 2, line 34 to column 3, line 17; Figures 1 and 2) discloses a slide having a raised surface formed of a transparent coating of plastics material. However, this raised surface is provided for protecting the specimen on

the glass plate and in particular for eliminating a costly cover glass. There is no suggestion that this coating could be used as a marking surface nor that it has any feature for this purpose. Moreover, there is no indication that the coating should contain an added granular medium to enhance its marking properties.

3.2.4 The Appellant has submitted that it is known from D15 to D22 to write on the surface of laboratory glass articles such as bottles and that, since such articles, as well as microscope slides, pertain to the same technical field, it would have been obvious for the skilled person to use the known materials for forming marking coatings on microscope slides as an alternative to the known techniques of grinding or labelling, thereby arriving at the microscope slides in dispute with its raised marking surface. However, the Board is of the opinion that, since these documents disclose raising marking surfaces to be applied on the external surfaces of glass bottles or the like, they do not pertain to the same technical field as the patent in suit, which concerns a microscope slide whereby the raised marking surface, in normal use, during microscope observation, should be on the same side of the slide as the specimen to be observed; in particular, forming a marking surface on a glass plate upon which a specimen to be observed and analysed is to be provided, thereby possibly coming into contact with said raised surface, addresses problems which are different from those relating to the formation of a marking surface on the external surface of a bottle.

3.2.5 Therefore, the subject-matter of Claim 1 in dispute involves an inventive step in the sense of Article 56 EPC.

3.3 Therefore, Claim 1 is allowable and the patent can be maintained in amended form (Article 52(1) and 102(3) EPC).

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance with the order to maintain the patent on the basis of the auxiliary request of the Respondent, consisting of:

Description: column 1 and 2, filed during the oral proceedings,

Claims: 1 to 3, filed during the oral proceedings, and

Drawings: the only sheet (Figures 1 to 3) as granted.

The Registrar: The Chairman:

P. Martorana E. Turrini

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