

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

D E C I S I O N
of 9 July 2003

Case Number: T 0001/02 - 3.2.2

Application Number: 95934140.5

Publication Number: 0800381

IPC: A61J 17/00

Language of the proceedings: EN

Title of invention:
Pacifier

Applicant:
Alanen, Pentti, et al

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 54, 56, 123

Keyword:
"Sufficient disclosure (yes)"
"Novelty, inventive step (yes,after amendments)"

Decisions cited:
-

Catchword:
-



Case Number: T 0001/02 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 9 July 2003

Appellant:

Alanen, Pentti
Papinkatu 18
FI-32200 Loimaa (FI)

and

Varrela, Juha
498 Glenlake Avenue
Toronto
Ontario M6P 1H1 (CA)

Representative:

Furlong, Christopher Heinrich
Hoffmann Eitle,
Patent- und Rechtsanwälte
Arabellastrasse 4
D-81925 München (DE)

Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted 31 May 2001
refusing European patent application
No. 95 934 140.5 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: W. D. Weiß
Members: D. Valle
R. T. Menapace

Summary of Facts and Submissions

I. The appellants (applicants) filed an appeal against the decision of the examining division to refuse the application.

II. The grounds for the refusal were that the submitted amendments contained subject-matter beyond the application as filed and lack of novelty having regard to document:

D1: GB-A-2 278 549.

III. The further following documents have been cited in the search report:

D2: US-A-5 035 340

D3: US-A-4 993 568.

IV. Following a telephone conversation with the rapporteur in the case, held on 4 April 2003, the appellants filed with letter dated the same day a modified page 7 of the description.

V. The appellants requested that the decision under appeal be set aside and a patent be granted on the basis of a main request consisting on the following version of the application:

- claims 1 to 10 as filed with letter of 10 October 2001;
- description, pages 1 to 6 and 8 to 11 as originally filed;
- description, page 7 as filed with letter of 4 April 2003;
- description, page 12, as filed with letter of 10 October 2001;
- Figures 1 to 3 as filed with letter of 11 August 2000;
- Figures 4 to 6 as filed with letter of 10 October 2001.

The appellants further requested the grant of a patent on the basis of an auxiliary request and, provisionally, oral proceedings.

VI. Claim 1 of the main request as filed with letter of 10 October 2001 reads as follows:

"Baby pacifier comprising a nipple part (20) and a shield, the nipple part (20) comprising a piece made of elastic or resilient material to be held in the baby's mouth, between the middle section of the palate (11) and the tongue (15), on which piece the baby exerts suction by the movements of the jaws and the tongue (15), the nipple part (20) comprising an upper surface (21') facing the baby's palate (11) when the pacifier is positioned inside the baby's mouth, the nipple part (20) having an elongated first cross-sectional profile

(21) comprising protrusions (26, 28) directed from a middle part (23) of said cross-sectional profile (21) to both sides thereof, said protrusions (26, 28) being arranged so that they extend to the lateral parts (12, 14) of the alveolar ridge and/or to the teeth (16, 18) of the baby's upper jaw when the pacifier is positioned in the baby's mouth, characterized in that said upper surface (21') of the nipple part (20) is concave or straight."

VII. The appellants argued that the subject-matter of the main and auxiliary requests did not go beyond the original disclosure.

Regarding the novelty of the subject-matter of claim 1 of the main request, document D1 did not disclose the characterizing part of the claim, that is that the upper surface of the nipple part was concave or straight. It was hardly possible to insert the pacifier according to document D1 into the baby's mouth with the concave surface facing upwards because the rather sharp edges of the wings of the pacifier would tend to hurt the baby's palate.

The subject-matter of claim 1 of the main request involved also an inventive step. Taking document D1 as a starting point, the problem to be solved by the invention was to prevent the lateral growth of the upper jaw from being hindered by the pacifier, while still being acceptable to babies of all ages. The solution provided by the invention that the upper surface facing the baby's palate was concave or straight, assured that no pressure was exerted on the middle section of the palate, but principally laterally outwardly on the inside of the lateral parts of the

alveolar ridge and deciduous teeth. Therefore the lateral growth of the upper jaw was not hindered by the baby pacifier according to the invention. Document D1 offered no solution to the problem of the invention. Being the upper surface of the nipple part of the pacifier according to document D1 convex, document D1 taught away from the invention.

Reasons for the Decision

1. The appeal is admissible.
2. *Formal matters*

There are no reasons to challenge the clarity of the claims.

Claim 1 is supported by the following passages of the original disclosure:

The introductory part of the claim describing the nipple part comprising a piece to be held in the mouth and on which suction is exerted is derived from the original claim 1, introductory part. The feature describing the upper surface of the nipple part is derived from Figure 2 and the corresponding paragraph at page 10 of the description. The elongated first cross-sectional profile comprising protrusions is disclosed at page 6 of the description, last paragraph. The feature that the protrusions extend to the lateral

parts of the alveolar ridge and/or the teeth is originally disclosed in claim 1. the characterizing part of claim 1 is disclosed originally at page 7, from line 22, and page 10, from line 14, of the description.

The dependent claims 2 to 10 are derived from the corresponding original dependent claims.

In the new page 12 of the description, the last sentence of the full paragraph is cancelled.

In the amended Figures 4 to 6 the reference numbers have been corrected.

3. *Novelty*

Document D1, cited in the application, page 4, corresponds to the preamble of claim 1 of the main request.

Claim 1 contains the additional feature forming the characterizing part of the claim that the upper surface of the nipple part is concave or straight.

Documents D2 and D3 disclose a nipple system for bottle-feeding babies and are farther away from the claimed invention.

Accordingly the subject-matter of claim 1 of the main request is novel.

4. *Inventive step*

Document D1, which is acknowledged in the description of the application, represents the closest state of the art because it discloses all the features of the preamble of claim 1 of the main request and because both the pacifier according to claim 1 and that disclosed in document D1 aim at improving the breadthwise growth of the upper jaw by directing the pressure generated by sucking towards the lateral teeth and alveolar ridges thereby avoiding harmful pressure on the growth zone of the middle section of the palate. Compare page 5, from line 33; page 6 and page 7, from line 18 of the application with page 3, from line 10, of document D1.

The means to solve this problem are, however, different.

The pacifier according to document D1 comprises a nipple (3) consisting of three distinct parts: a support member (7), having an upper surface essentially convex, designed to contact the tip of the tongue and the front part of the alveolar ridge, and two wings (8) attached to the support member, extending backwards and outwards from the supporting member and designed to contact the lateral internal mouth walls. Therefore, the pacifier according to document D1 directs mainly the tip of the tongue to exert pressure on the supporting member in a up-and-forward direction, thereby pressing the front part of the alveolar ridge from the inside. The known pacifier may cause protrusion of the front part of the dental arch, see description of the application, page 5, from line 27, and/or hinder the lateral growth of the upper jaw.

Starting from document D1, the problem to be solved by the invention is therefore to avoid pressure on the front part of the alveolar ridge and on the upper jaw.

The problem is solved by the characterizing part of the claim, that is by providing a nipple having an upper concave or straight surface.

This feature results in directing the pressure generated by sucking to the lateral teeth and alveolar ridge thereby relieving the upper jaw and the front part of the alveolar ridge.

No hints are contained in document D1 which can lead to the invention in an obvious way. Documents D2 and D3 do not contain any hints in the sense of the invention either.

Accordingly the subject matter of claim 1 of the main request involves an inventive step.

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 grant a patent on the basis of the following document
 - claims 1 to 10 as filed with letter of 10 October 2001;
 - description, pages 1 to 6 and 8 to 11 as originally filed;
 - description, page 7 as filed with letter of 4 April 2003;
 - description, page 12, as filed with letter of 10 October 2001;
 - Figures 1 to 3 as filed with letter of 11 August 2000;
 - Figures 4 to 6 as filed with letter of 10 October 2001.

The Registrar:

The Chairman:

V. Commare

W. D. Weiß