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D E C I S I O N
of 13 January 2004

Case Number: T 0394/02 - 3.2.1

Application Number: 93907810.1

Publication Number: WO 93/17953

IPC: B67B 7/18, 7/20

Language of the proceedings: EN

Title of invention:

Tool for breaking a vacuum in a preserving jar closed with a screw cap

Applicant:

BRIX-HANSEN, Helge

Opponent:

-

Headword:

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Relevant legal provisions:

EPC Art. 56, 84, 111(1)

Keyword:

"Clarity of an independent claim for a hand tool which is in part defined by reference to the screw cap to be removed with the aid of said tool"

"Inventive step (yes)"

"Remittal to the first instance for further examination (no)"

Decisions cited:

T 0455/92

Catchword:

-



Case Number: T 0394/02 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 13 January 2004

Appellant: BRIX-HANSEN, Helge
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Representative: Nielsen, Leif
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 October 2001
refusing European application No. 93907810.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. Crane
Members: M. Ceyte
H. Preglau

Summary of Facts and Submissions

- I. European patent application No. 93 907 810.1 (PCT/DK 93/00089) published under international publication No. WO 93/17953, was refused by a decision of the Examining Division posted 17 October 2001.
- II. In its decision, the Examining Division held that amended claim 1 then under consideration
- was not clear as required by Article 84 EPC, since it used imprecise terms and tried to define a tool in terms of its physical relationship to a screw cap which does not form part of the tool, and
 - contained added matter contrary to Article 123(2) EPC.
- III. On 14 December 2001, the appellant (applicant) lodged an appeal against the decision and paid the prescribed appeal fee on 18 December 2001.
- The statement of grounds of appeal was filed on 14 February 2002.
- IV. Following two communications from the Board, the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the following documents:
- Claims: 1 to 3 filed with letter dated 3 July 2003.

Description: pages 1 to 3 filed with letter dated
1 December 2003.
page 4 as published.

Drawings: sheet 1/1 as published.

Claim 1 reads as follows:

"1. A tool for breaking a vacuum in a preserving jar (8) closed with a screw cap (7), said jar having quadropole or sextopole threads (9) in the neck of the jar, each thread extending only over a comparatively small part of the circumference of the neck, said tool comprising

- an oblong handle (1),
- a mouth portion formed at one end of this handle (1) for engaging the periphery part of the cap (7),
- the mouth portion facing away from the handle (1) and comprising a jaw (2) for engaging under the lower edge of the cap (7) and a top portion adapted to bear on the upper surface of the screw cap,

c h a r a c t e r i s e d in that

the top portion of the mouth portion has a lower plane surface (5) in the shape of a circle segment able to span over two thread sections of the screw cap (7),

- guide means in the shape of a slot forming a concave circular arc is provided between the top portion of the mouth portion and the jaw (2),
- the free end (3) of the jaw (2) forms a concave arc of a circle."

V. The following prior art documents have been considered in the appeal proceedings:

D1: DE-C-818 740

D2: FR-A-1 156 967

D3: DE-A-3 822 145

D4: DE-C-3 410 333

D1, D2 and D4 are cited in the search report, D3 in the patent application as published.

Reasons for the Decision

1. The appeal is admissible.
2. *Formal matters*
 - 2.1 The reason given for the refusal that claim 1 then under consideration contained added subject-matter in violation of Article 123(2) EPC no longer applies with the present claim 1.

Present claim 1 is for a tool which contains in its characterising part the feature that the lower plane surface (5) of the tool is in the shape of a circle segment "able to span over two thread sections of the screw cap". The fact that the shape of the claimed tool is in part defined by reference to the screw cap to be removed with the aid of said tool, was objected to by the Examining Division as lacking clarity under Article 84 EPC.

The Board is unable to follow such reasoning in view of the revised unambiguous wording of the Guidelines for examination in the EPO C-III, 4.8a and the case law of the Board of Appeal (T 455/92 not published) cited therein.

The Guidelines C-III, 4.8a state that:

"It may also be allowable to define the dimensions and/or shape of a first entity in an independent claim (here: a tool for breaking a vacuum in a preservative jar closed with a screw cap) by general reference to the dimensions and/or corresponding shape of a second entity (here: the screw cap) which is not part of the claimed first entity but is related to it through use" (the claimed tool is adapted to engage the edge of the screw cap and deform it elastically and thus break the vacuum in the jar).

It is true that the dimensions of screw caps are not standardized. However as stated in the Guidelines "references to second identities which cannot be seen as subject to a standardisation may also be sufficiently clear in cases where the skilled person would have little difficulty in inferring the resultant restriction of the scope of protection for the first entity... . **It is neither necessary for such claims to contain the exact dimensions of the second entity, nor do they have to refer to a combination of the first and second entities. Specifying the length width and/or height of the first entity without reference to the second would lead to an unwarranted restriction of the scope of protection.**" (Emphasis added)

Accordingly, in the Board's judgement, claim 1 satisfies the requirement of clarity under Article 84 EPC.

- 2.2 The Examining Division issued a decision exclusively based upon lack of clarity (Article 84 EPC) and added matter (Article 123(2) EPC) and left the issue of patentability undecided. In such cases the matter is normally remitted to the first instance for consideration of the undecided issue. However in view of the fact that the present European patent application was filed 10 years ago (10 March 1993) and that the appeal was likely to be successful, the remittal to the first instance would only prolong the proceedings unduly. Therefore, in the course of the appeal proceedings the Board, in exercising its discretion under Article 111(1), considered it appropriate to deal finally with the case itself.

3. *Inventive step*

- 3.1 Document D1 which represents the closest prior art, is acknowledged and evaluated in the introductory part of the amended description. This citation discloses a tool of the kind stated in the pre-characterising part of claim 1.

According to the appellant's submissions, the tool disclosed in D1 suffers from the disadvantage that when breaking the vacuum in the jar, the rim of the screw cap becomes permanently deformed.

Therefore the technical problem to be solved by the present invention is to provide a tool which overcomes the above disadvantage, ie which allows a suitable

elastic deformation of the rim of the screw cap for breaking the vacuum in the closed jar and thus prevents mutilation of the screw cap.

This problem is in essence solved by the following features stated in the characterising part of claim 1:

- (i) the free end of the jaw forms a concave arc of a circle;
- (ii) the portion of the tool which engages the upper surface of the cap has a lower plane surface in the shape of a circle segment which is able to span over two thread sections of the screw cap.

3.2 D2 discloses in essence a bottle opener for removing crown corks, that is metal bottle caps with a crimped edge, not a tool for breaking a vacuum in a preservative jar closed with a screw cap, such tool being designed for elastically deforming the rim of the screw cap without deteriorating it.

In D3 which is also acknowledged and evaluated in the introductory part of the description there is no disclosure of the above features (i) and (ii). When breaking the vacuum in the jar, the rim of the screw cap becomes permanently deformed (see Figure 3).

D4 has nothing to do with the claimed invention since it discloses multi-purpose pincers ("Mehrzweckzange").

There is thus no disclosure or suggestion in these citations or in the other documents cited in the search report of the claimed solution above which allows a

suitable elastic deformation of the rim of the screw cap for breaking the vacuum in the closed preservative jar, without deteriorating the screw cap.

- 3.3 Accordingly, in the Board's judgement, the subject-matter of claim 1 cannot be derived in an obvious manner from the available prior art and consequently involves an inventive step (Article 56 EPC).
4. Dependent claims 2 and 3 concern particular embodiments of the invention claimed in claim 1 and are likewise allowable.

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 documents indicated in point IV above.

The Registrar:

The Chairman:

S. Fabiani

S. Crane