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D E C I S I O N
of 20 January 2005

Case Number: T 1124/02 - 3.2.6

Application Number: 96114328.6

Publication Number: 0768422

IPC: D06F 37/22

Language of the proceedings: EN

Title of invention:

A laundry washer with improved dynamic equilibration system

Patentee:

Electrolux Zanussi S.p.A.

Opponent:

Miele & Cie.KG

Headword:

-

Relevant legal provisions:

EPC Art. 83, 113(1), 114(1)

EPC R. 71a(2)

Keyword:

"Sufficiency of disclosure - main and auxiliary requests (no)"
"Permission to file further auxiliary requests at the oral
proceedings (denied)"

Decisions cited:

T 1105/98, T 0409/91, T 0014/82, T 0032/84, G 0009/91,
G 0010/91, T 0385/97, T 0086/94

Catchword:

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Case Number: T 1124/02 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 20 January 2005

Appellant: Miele & Cie.KG
(Opponent) Postfach
D-33332 Gütersloh (DE)

Representative: -

Respondent: Electrolux Zanussi S.p.A.
(Proprietor of the patent) Via Giardini Cattaneo, 3
I-33170 Pordenone (IT)

Representative: Grünecker, Kinkeldey,
Stockmair & Schwanhäusser
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
25 September 2002 concerning maintenance of the
European patent No. 0768422 in amended form.

Composition of the Board:

Chairman: H. Meinders
Members: G. C. Kadner
R. T. Menapace

Summary of Facts and Submissions

- I. The appeal is from the interlocutory decision of the Opposition Division of 25 September 2002 maintaining European Patent 0 768 422 in amended form.
- II. Against this decision the opponent filed an appeal on 12 November 2002, paying the appeal fee on that same date. The Appellant filed its statement of grounds of appeal on 20 January 2003.
- III. The Board invited the parties to oral proceedings with summons of 3 November 2004 and set out its preliminary opinion in a communication dated 16 December 2004, setting the parties a time limit of at the latest two weeks before the oral proceedings to file further submissions.

With letter of 7 January 2005 the Respondent reacted with an auxiliary request.

- IV. Oral proceedings were held on 20 January 2005.

The Appellant requested setting aside the decision under appeal and revocation of the patent.

The Respondent requested dismissal of the appeal and maintenance of the patent in amended form as upheld by the Opposition Division or on the basis of its auxiliary request. After having heard at the oral proceedings the Board's negative opinion following the discussion on the main and the auxiliary request in respect of the fulfilment of the requirements of

Article 83 EPC, it requested that it be given the opportunity to file further auxiliary requests.

V. Claim 1 of the main request reads as follows:

"A laundry washer, particularly for domestic use, comprising an outer housing, a laundering tub, a perforated drum of cylindrical shape mounted in said tub for rotation about its axis during the laundering and spin-drying phases, said drum being provided with a dynamic equilibration system comprising a plurality of annular hollow bodies of closed rectangular cross-sectional configuration each containing a plurality of movable bodies of cylindrical shape, free to move within said hollow bodies, with their respective axes parallel to said axis of rotation of said drum, and a fluid having lubricating properties, particularly oil, contained in said hollow bodies and adapted to distribute itself along the circumference of said hollow bodies and between said cylindrical bodies characterised in that the plurality of annular hollow bodies being arranged concentric to each other with their axes coinciding with the axis of rotation of said drum at both ends of said drum and said lubricant fluid has a viscosity between 40 and 130 mPa.s."

The precharacterising portion of claim 1 of the auxiliary request is identical to claim 1 of the main request, with the characterising portion as follows:

"characterised in that the plurality of annular hollow bodies being arranged concentric to each other with their axes coinciding with the axis of rotation of said drum at both ends of said drum and said lubricant fluid

has a viscosity between 40 and 130 mPa.s within the range of usual operating temperatures of the washer".

- VI. In the decision under appeal the Opposition Division rejected, among others, the objections raised by the Opponent in respect of sufficiency of disclosure (Article 83 EPC), more specifically having regard to the claimed range for the viscosity of the lubricating fluid.

In its statement of grounds of appeal the Appellant argued against this reasoning of the Opposition Division.

In its communication to the parties of 16 December 2004 in preparation for the oral proceedings, the Board expressed its doubts regarding the correctness of the reasoning of the Opposition Division. Referring to T 409/91 (OJ EPO 1994, 653) it noted, however, that the claimed viscosity range led to a related problem, namely whether the patent disclosed the invention over the whole ambit of claim 1.

- VII. In the oral proceedings the Appellant endorsed the above mentioned preliminary opinion of the Board. The ground for opposition pursuant to Article 100(b) EPC had been raised in the opposition proceedings, had been discussed in the decision under appeal and thus could be pursued by it on appeal, with the same or with different arguments, irrespective of who provided them. Claim 1 of both requests did not include any of the essential design parameters of the drum, which governed tests 6 and 7, the only tests in which the problem the patent claimed to solve was actually solved. These

essential parameters should be mentioned in the claim. Otherwise it covered an undefined number of possible design configurations of the equilibration means, for which the patent did not provide the skilled person with sufficient information (see T 409/91, *supra*). One example could suffice for the purposes of Article 83 EPC, however, only if the skilled person was enabled to extend the teaching provided by that example to all embodiments covered by the claim. That was not the case here.

VIII. The Respondent argued essentially as follows:

The legal and factual framework of the appeal was limited to the grounds invoked in opposition and the arguments raised by the Appellant in its appeal and its statement of grounds of appeal. The position the Board had taken in its preliminary opinion fell outside of this framework and therefore did not need to be addressed. In any case it did not understand the reasoning of the Board as the patent in suit did give at least one example (tests 6 and 7) which could be carried out and which solved the problem underlying the invention. It was not necessary to include in the claim further design parameters of the equilibration means, as the skilled person could find out, without the exercise of inventive skills, what these should be.

The Respondent, having heard the Board confirm its negative opinion after the deliberation at the oral proceedings, should at that moment be allowed to file further auxiliary requests. It was used to be asked whether it still had any such further requests, before a final decision was announced.

Reasons for the Decision

1. The appeal is admissible.
2. *Objections in respect of sufficiency of disclosure (Article 83 EPC) raised by the Board*
 - 2.1 The Respondent argued that the Appellant could not, in the oral proceedings, base its appeal on the objections raised by the Board in its preliminary opinion. As Respondent it needed to address only the issues raised in the appeal and the statement of grounds of appeal, not new facts or arguments brought up by the Board in preparation of the oral proceedings and only subscribed to by the Appellant as late as at the oral proceedings.
 - 2.2 The Board does not concur.
The ground of opposition pursuant to Article 100(b) EPC has been validly raised in the opposition proceedings, has been considered in the reasons for the decision under appeal and has been addressed by the Appellant in its statement of grounds of appeal. Under these circumstances questioning the compliance with Article 83 EPC, irrespective of whether by a party or by the Board, does not amount to introducing a fresh ground of opposition into the appeal proceedings (which would then need the proprietor's agreement - G 10/91, OJ EPO 1993, 420).
 - 2.3 The Board is not aware of any limitation on the *ex officio* introduction by a board of appeal of new facts and evidence in support of such a ground for opposition

forming part of the legal framework of the appeal. Rather, it endorses fully the position taken by Board of Appeal 3.3.2 in its decision T 385/97 (point 3.2 of the Reasons) that, if the opposition division and/or parties fail to take account of highly relevant matter and which relates to such a ground for opposition, the Board's competence extends to rectifying that position by consideration of that matter (provided, of course, the parties' procedural rights to fair and equal treatment are respected). This is not only consistent with the relevant decisions of the Enlarged Board of Appeal (G 9/91, OJ EPO 1993, 408 and G 10/91, *supra*), but incumbent on the Board as last instance in proceedings concerning the maintenance of European patents under opposition.

2.4 Article 114(1) EPC as the legal basis for the power of the Board referred to above covers also new arguments which, therefore, can be raised by the Board and, as a matter of principle, also be presented by the parties until in oral proceedings the debate is closed. In view of the latter and notwithstanding the requirement that an appeal must be substantiated, there exists no requirement that the statement of grounds of appeal also be exhaustive as regards its argumentation (see T 86/94, point 2.2 of the Reasons).

2.5 The issue of whether the requirements of Article 83 EPC were met over the whole ambit of the claim was brought up by the Board in its preliminary opinion, sent more than one month before the oral proceedings, setting a time limit of two weeks before the oral proceedings for filing any further submissions. The Respondent reacted in time, with its letter of 7 January 2005, filing,

however, only an auxiliary request specifying the temperature range for the viscosity of the liquid. No arguments relating to the objection raised by the Board were presented, no postponement of the oral proceedings for performing further tests or for preparing a rebuttal was requested.

At the oral proceedings the Board's preliminary opinion was explained once more and extensively discussed, after rejecting the Respondent's initial contention that it could not be the subject of the oral proceedings. Also at the oral proceedings no request was made to remit the case to the first instance for examining these points brought up by the Board, nor did the Respondent request an adjournment of the oral proceedings or a postponement of the decision, for preparing further material to refute the position taken by the Board.

2.6 In view of the above the Respondent's rights under Article 113(1) EPC, namely the opportunity to present its comments on the grounds of the decision to be taken by Board, have been fully respected.

3. *Sufficiency of disclosure (Article 83 EPC)*

3.1 The Board agrees with the Respondent that for the purposes of sufficiency of disclosure within the meaning of Article 83 EPC not only the claims, but also the description and the drawings of the patent should be taken into account (see e.g. T 14/82, OJ EPO 1984, 105).

The description of the patent as granted shows by means of the test results presented therein that for solving the problem the patent sets out to solve, namely noise reduction and proper distribution of the equilibration bodies, the following design parameters are essential:

- the dimensions of the cross-section of the annular rings,
- the nature of the walls of these rings (smooth or crenellated)
- the number of rollers, their size and their weight in correlation with the dimensions of the cross-section of the annular rings (gap size).

This is evident from the results of tests 6 and 7 and the test conditions as discussed in paragraphs 100 to 120 of the patent in suit.

3.2 However, apart from the specific design of the equilibration system employed for these tests, which involves:

- two discs of four annular rings, disposed on each end of the laundry drum,
- smooth ring walls measuring with a cross-section of 10,5 x 14,5 mm, with radii of these rings of 210, 194, 177 and 166 mm,
- 132 rollers with an occupation angle of 145° in the individual rings, with a diameter of 13,5 mm, a length of 9 mm and a weight of about 10 grams,

the patent does not disclose any other embodiments with other design parameters, which at the same time solve

the above mentioned problem, even only to a limited extent.

The disclosure of the patent itself therefore does not provide any information as to the limits which apply to the parameters described above as essential for solving the problem the invention sets out to solve.

- 3.3 According to the consistent case law of the Boards of Appeal (see T 409/91, *supra*, Reasons, point 3.5) the disclosure of a claimed invention in a patent is only sufficient if it enables the skilled person to obtain substantially all embodiments falling within the ambit of the claim.

As far as the design parameters of the claimed equilibration system are concerned, present claim 1 only requires that the lubricating fluid has a viscosity in the range of 40-130 mPa.s, that the hollow bodies on the drum should be annular, concentric and have a rectangular cross-section, and that the movable bodies should have a cylindrical shape and be free to move within the annular hollow bodies. None of the above mentioned essential design parameters are mentioned in claim 1, let alone are they subject to any limits.

The ambit of this claim thus encompasses unlimited ranges for these design parameters. In application of the above mentioned established practice of the Boards of Appeal, it has therefore to be examined whether the skilled person, on the basis of the information in the patent, is enabled to determine these limits, without undue burden.

3.4 The Respondent argued that one embodiment sufficed for the purpose of sufficiency of disclosure and that on the basis of the results of tests 6 and 7 in the patent in suit the skilled person could without difficulty try out other designs of the equilibration system, to determine whether they worked or not and in doing so, to determine the limits for these design parameters. The claim did not need to be limited to only the design parameters of the drum used in these two tests, as the latter presented only the "best" results. Acceptable results, still solving the problem, could be achieved with modified designs of the equilibration system.

3.5 However, this is true only where the skilled person is not confronted with an undue burden in determining the limits of the parameters involved. In the present case, however, there is a large number of different design parameters of the equilibration system which need to be varied in such further tests:

- the number of rings, their radii and the nature of their walls,
- the number of bodies and the angle they occupy,
- the weight and the dimensions of the bodies, the latter also in respect of:
- the cross-section dimensions of the rings.

In view of the large number of different design parameters concerned and the ensuing necessity to perform a large number of tests, so as to properly determine the scope of the invention as defined in present claim 1, the efforts necessary to this end constitute an undue burden for the skilled person, even

though the actual production of each individual design alternative might not require great technical skills.

- 3.6 The Respondent argued that these design parameters were not such essential parameters.

The Board does not share this view: from table C of the patent it is evident that not any kind and number of freely movable bodies provides a feasible alternative. For instance, as soon as the diameter of the equilibration rollers changes from 13 to 13,5 mm there is a marked effect (compare tests 5 and 6). However, it is not known whether this also counts for a number of rollers less than 132, less than four rings, larger or smaller gap sizes than the ones shown in figure 24 referred to in the description, or different roller sizes.

The tolerances used, e.g. the size of the gap between the rollers and the walls of the rings, are also an important design feature. This is evidenced by paragraph 120 of the patent in suit, referring to such tolerances "as defined in the attached claims". That statement may have been applicable to the application as filed; it is, however, not the case for the patent as granted, these design features (cylindrical rollers with a diameter between 10 and 18 mm, a tolerance with the walls of the rings of between 1 and 2 mm in the axial direction of the rollers and of 0.75 mm in the radial direction) having been deleted from claim 1 before grant of the patent.

- 3.7 The Respondent referred also to T 32/84 (OJ EPO 1986, 9) in support of its contention that the patent provided a sufficient disclosure.

This decision concerns a special case in which the skilled person was considered to be able to put the invention into practice by applying a principle disclosed in the description which showed as essential to the invention an element which did not appear in the figure illustrating the invention as claimed, but in another figure of the application.

That situation only applies to the present case in respect of figure 24, showing a roller with a length and a diameter of 13,5 mm and 9 mm respectively, the ring section having a width and height of 10,5 mm and 14,5 mm respectively. The first two dimensions have been used in tests 6 and 7 and have therefore already been acknowledged above (point 3.5) as providing feasible results. It may very well be that with the indicated dimensions of the ring section the invention will work with the other design parameters varying to a certain extent. However, this information still does not provide the skilled person with the actual limits of the ranges for these parameters as are presently encompassed by claim 1, nor for the other design parameters, for which there is no drawing providing any such further information, found in the patent.

- 3.8 For the above reasons it has to be concluded that the requirements of Article 83 EPC are not fulfilled for claim 1 of the main request.

Claim 1 of the auxiliary request only having been amended by specifying the temperature range for the liquid's viscosity, the above reasoning applies equally to that claim.

4. *Procedural questions - filing of further auxiliary requests at the oral proceedings*

- 4.1 Where the Board has communicated its preliminary opinion on an issue to the parties and has set a time limit for filing submissions in reply thereto, pursuant to Rule 71a(2) EPC the possibility to file auxiliary requests as late as at the oral proceedings is subject to the exercise of discretion of the Board (see e.g. T 1105/98).

In preparation of the oral proceedings the Respondent was notified of the Board's preliminary view that a specified ground related to Article 83 EPC might prejudice the maintenance of the patent, see points VI and 2.5 above. For further submissions a time limit expiring two weeks before the oral proceedings scheduled for 20 January was set. In its timely reply dated 7 January 2005 the Respondent filed its auxiliary request, modifying claim 1 only in respect of the temperature range for the liquid's viscosity.

Even with these amendments, however, these documents do not meet the Board's objections, and thus do not meet the requirements of the Convention.

Neither did the Respondent address elsewhere or comment on the issue in question. It also did not request

postponement of the proceedings in order to furnish test results to refute the Board's preliminary view.

4.2 At the start of the oral proceedings before the Board, as is usual, the requests on file were reviewed and the parties were asked whether these were still their requests. The Respondent did not react by proposing further auxiliary requests nor did it give an indication of an intention to do so at a later stage. Rather, in the course of the discussion on sufficiency of disclosure the Respondent put forward the contention that it only needed to reply to the arguments raised by the Appellant, not to new facts or arguments brought up by the Board in its preliminary opinion, even if they were subscribed to by the Appellant at the oral proceedings.

4.3 In the oral proceedings, the Board had reiterated its objections and once more explained its position on the question of sufficiency of disclosure. Only as late as after the deliberation of the Board on the issue of sufficiency of disclosure and after having heard the Board confirm its negative opinion on the matter, did the Respondent request that it be given the opportunity to file further auxiliary requests, pretending that he was used to being asked whether he had such requests, before a decision of the Board was announced.

4.4 Under these circumstances and considering that there is nothing in the EPC, its Implementing Regulations or in the Rules of Procedure of the Boards of Appeal which would oblige the Board to ask the patent proprietor repeatedly for its requests, the request for allowing

the filing of further auxiliary requests was not allowed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside
2. The patent is revoked.

The Registrar:

The Chairman:

M. Patin

H. Meinders