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D E C I S I O N
of 21 December 2005

Case Number: T 0475/03 - 3.2.07

Application Number: 96910481.9

Publication Number: 0760734

IPC: B26B 21/22

Language of the proceedings: EN

Title of invention:

Safety razors

Patentee:

The Gillette Company

Opponent:

Warner Lambert Company

Headword:

-

Relevant legal provisions:

EPC Art. 54, 56, 83, 84, 123(2)

Keyword:

"Late filed documents - admitted"
"Late filed requests - not admitted"
"Lack of conciseness - no"
"Lack of clarity - no"
"Insufficiency - no"
"Added subject-matter - no"
"Novelty - yes"
"Inventive step - yes"

Decisions cited:

-

Catchword:

-



Case Number: T 0475/03 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 21 December 2005

Appellant: The Gillette Company
(Proprietor of the patent) Prudential Tower Building
Boston
Massachusetts 02199 (US)

Representative: Lerwill, John
A.A. Thornton & Co.
235 High Holborn
London WC1V 7LE (GB)

Respondent: Warner Lambert Company
(Opponent) 201 Tabor Road
Morris Plains
N.J. 07950 (US)

Representative: Powell, Timothy John
Eric Potter Clarkson
Park View House
58 The Ropewalk
Nottingham NG1 5DD (GB)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 20 March 2003
revoking European patent No. 0760734 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: H. Felgenhauer
Members: P. O'Reilly
E. Lachacinski

Summary of Facts and Submissions

I. Opposition was filed against European Patent No. 0 760 734 as a whole and based on Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(b) EPC (insufficiency) and Article 100(c) EPC (added subject-matter).

The Opposition Division decided to revoke the patent.

II. The appellant (proprietor) filed an appeal against the decision.

III. The appellant requests that the decision under appeal be set aside and a patent be granted on the basis of the main request filed during the oral proceedings before the Board.

The respondent (opponent) requests that the appeal be dismissed.

IV. Oral proceedings were held before the Board on 20 and 21 December 2005.

V. The independent claims of the main request read as follows (amendments compared to the patent as granted are shown in bold or struck through):

"1. A safety razor blade unit comprising a guard (2), a cap (3), and first (11), second (12) and third (13) blades with parallel sharpened edges located in succession between the guard and cap, at least one element selected from the three blades, guard and cap being movable from a non-shaving position **occupied when**

the blade unit is at rest and not in use to modify a blade exposure dimension of the blade unit and attain a modified blade geometry wherein the exposure of the first blade (11) is not greater than zero and the exposure of the third blade (13) is not less than zero, at least one of the first and third blades having a different exposure when the at least one movable element is in the non-shaving position."

"12. A safety razor blade unit comprising a guard (2), a cap (3) and ~~a plurality of~~ **first, second and third** blades (11, 12, 13) with parallel sharpened edges located in succession between the guard and cap, ~~at least one~~ **each** of the guard and cap being movable against a **respective** spring force from a non-shaving position to a predetermined operable position in which a modified blade geometry is obtained, **and returnable to the non-shaving position by the spring force**, in the non-shaving position the blade edges being disposed below a plane tangential to the skin contacting surfaces of the guard and cap, **and in the modified blade geometry the exposure of the first blade being not greater than zero and the exposure of the third blade being not less than zero.**"

"23. A shaving cartridge comprising a housing having connecting structure for making a removable connection to a handle, a guard (2) at the front of the cartridge, a cap (3) at the back of the cartridge, and first (11), second (12) and third (13) blades with parallel sharpened edges located in succession on said housing between said guard and cap and independently mounted for spring-biased movement with respect to said housing, **when the cartridge is pressed against the skin**

surface to bring all the blades into shaving contact said blades being movable **against the spring bias** from non-shaving positions to shaving positions in which the **spring bias** force on the first blade (11) is less than the **spring bias** force on the third blade (13), **and wherein the third blade has at least one of (i) a higher spring constant and (ii) a higher preload than the first blade."**

"29. A shaving razor comprising a handle, a housing connected to said handle, a guard (2) at the front of the housing, a cap (3) at the back of the housing, and first (11), second (12) and third (13) blades with parallel sharpened edges located in succession on said housing between said guard and cap and independently mounted for spring-biased movement with respect to said housing, **when the guard, the cap and the blades are pressed against the skin surface to bring all the blades into shaving contact** said blades being movable **against the spring bias** from non-shaving positions to shaving positions in which the **spring bias** force on the first blade (11) is less than the **spring bias** force on the third blade (13), **and wherein the third blade has at least one of (i) a higher spring constant and (ii) a higher preload than the first blade."**

"45. A shaving cartridge comprising a housing having connecting structure for making a removable connection to a handle, a guard (2) at the front of the cartridge, a cap (3) at the back of cartridge, and first (11), second (12) and third (13) blades with parallel sharpened edges located in succession on said housing between said guard and cap and independently mounted for spring-biased movement with respect to said

housing, said blades being movable **against the spring bias** from non-shaving positions **occupied when the cartridge is at rest and not in use** to shaving positions in which the exposure on the first blade (11) is less than the exposure on the third blade (13)."

VI. The documents cited in the present decision are the following:

D1: WO-A-95/09071

D22: WO-A-92/05923

D24: US-A-4 488 357

VII. The arguments of the appellant may be summarised as follows:

- (i) The new main request submitted at the start of the oral proceedings should be admitted into the proceedings. The amendments limit claim 1 to the embodiment of figures 6 and 7. The amendments arose from discussions with the client and would facilitate the discussion during the oral proceedings since claim 1 of the present main request covers several embodiments of the invention. Also, if the new main request is accepted then the appellant would not argue the question of priority regarding claims 23 and 29.
- (ii) The amendments made to the existing main request in the course of the oral proceedings should be admitted. The amendments are either based on features already contained in the auxiliary

requests which were proposed for each claim with the submission of the appellant dated 21 November 2005 filed one month before the oral proceedings or are clearer definitions which in part have been agreed with the respondent.

- (iii) The amendment to claim 1 complies with Rule 57a EPC since the Opposition Division considered that it made the claim novel. The feature introduced by the amendment is technical because it defines the non-shaving position. The amendment complies with Article 123(2) EPC because it is derived from column 3, lines 39 to 43 of the patent specification as well as the application as filed.
- (iv) The subject-matter of claim 1 is novel over D1. It is clear from page 2, lines 33 to 36 of D1 that the geometry disclosed in the document is the geometry in the rest position. This is not the geometry attained during use of the device according to D1, which will be different.
- (v) The subject-matter of claim 1 involves an inventive step as already decided by the Opposition Division.
- (vi) Claim 12 complies with the formal requirements of the Convention. Since this is an amended version of claim 12 present in the patent as granted the amendment thereto cannot give rise to a lack of conciseness. The claim is also clear since the arrangements indicated by the respondent are ones

which cannot perform a shaving function and hence are not within the scope of the claim.

- (vii) Claim 23 complies with the formal requirements of the Convention and its subject-matter is novel and inventive.
- (viii) Claim 29 complies with the formal requirements of the Convention and its subject-matter is novel and inventive.
- (ix) Claim 45 complies with the requirements of the Convention. Although the claim refers to a cartridge the parts of the description that refer to a blade unit also apply to a cartridge so that the amendment to the claim complies with Article 123(2) EPC. The direction of movement of the blades is clear and is visible in figures 4 and 5. The direction is from the non-shaving position to the shaving position so that the subject-matter is sufficiently disclosed.
- (x) The subject-matter of claim 45 is novel over D1. It is clear from page 2, lines 33 to 36 of D1 that the geometry disclosed in the document is the geometry in the rest position. This is not the geometry to which the blades are moved during use of the device according to D1, which will be different.
- (xi) The subject-matter of claim 45 involves an inventive step.

VIII. The arguments of the respondent may be summarised as follows:

- (i) The new main request submitted at the start of the oral proceeding should not be admitted into the proceedings. The appellant has had ample opportunity to make amendments before the oral proceedings. Moreover, the amendment to claim 1 does not solve existing problems. There is no link between the question of admitting the request and the priority question.

- (ii) The amendments to the main request filed during the course of the oral proceedings and contained in the final form of the request submitted at the end of the oral proceeding should not be admitted, apart from some amendments to which the respondent has consented. The appellant filed a large number of auxiliary requests with his submission one month before the oral proceedings. The large number of requests and the further request that combinations of these requests may be made, created a situation in which it was impossible for the respondent to prepare properly for the oral proceedings. By allowing amendments to the main request which are derived from these auxiliary requests the respondent is being put in the same position as if the auxiliary requests had been admitted into the proceedings. The appellant should have filed an appropriate number of proper auxiliary requests before the oral proceedings and been limited to such requests. Some of the amendments, however, have the agreement of the respondent.

- (iii) The amendment to claim 1 does not fulfil the requirements of the Convention. The feature introduced by the amendment is not technical and does not comply with Article 84 EPC. The amendment refers to "at rest and not in use" but those conditions are broken as soon as the razor is picked up, even before being applied to the skin. Since the amendment is not technical it cannot solve the novelty problem and hence should not be allowed in view of Rule 57a EPC.

- (iv) The subject-matter of claim 1 is not novel in view of D1. The start geometry for the blades of D1 complies with the geometry set out in the claim. In use the geometry of D1 will change. As soon as a small change occurs the geometry of the blades of D1 will be within the definition of the blade geometry of claim 1.

- (v) In view of the interpretation of claim 1 by the Board during the examination of novelty, no arguments are offered with respect to inventive step.

- (vi) Claim 12 does not comply with the formal requirements of the convention. The claims as a whole are no longer concise in the sense of Article 84 EPC since claim 12 is an embodiment of claim 1. There are possible arrangements of the blades which are within the scope of the claim but which would not work, i.e. shaving would not be effective.

- (vii) In view of the amendments made to claim 23 during the oral proceedings no further objections are made. However, in the view of the respondent the expression "when the cartridge is pressed against the skin" must be understood as meaning "at the time when the cartridge is pressed against the skin".
- (viii) In view of the amendments made to claim 29 during the oral proceedings no further objections are made. However, in the view of the respondent the expression "when the razor is pressed against the skin" must be understood as meaning "at the time when the razor is pressed against the skin".
- (ix) The amendments to claim 45 do not fulfil the requirements of the Convention for the same reasons as set out with respect to claim 1. There is no disclosure in the application as filed of a cartridge that is "at rest and not in use". The references in the description to this feature concern only a blade unit and not a cartridge. Furthermore, the addition of the expression "against the spring bias" does not comply with Article 83 EPC and Article 123(2) EPC. The amendment is broad and the specific direction of the bias is not given. It is not explained anywhere in the application as filed where independently spring-biased blades can be subject to a single force, i.e. "**the** spring bias" (emphasis added).

- (x) The subject-matter of claim 45 is not novel in view of D1. The start geometry for the blades of D1 complies with the geometry set out in the claim. In use the geometry of D1 will change. As soon as a small change occurs the geometry of the blades of D1 will be within the definition of the blade geometry of claim 45.

- (xi) In view of the interpretation of claim 45 by the Board during the examination of novelty no arguments are offered with respect to inventive step.

Reasons for the Decision

- 1. *Admissibility of late filed requests*

- 1.1 At the start of the oral proceedings before the Board the appellant presented a new main request in which claim 1 was amended by incorporating the subject-matter of dependent claims 7 and 9. These claims are directed to a feature which was not discussed previously during either the opposition or appeal proceedings. In the view of the Board the appellant had already had ample opportunity to file such an amendment earlier in the proceedings. Also, the respondent could not be expected to prepare a response to the same level as would be the case if he had advanced knowledge of the amendment. It is correct that the subject-matter was contained in dependent claims. However, the claims of the main request on file before the oral proceedings include five independent claims and forty one dependent claims. Moreover, the appellant had already filed sixteen

amendment proposals indicated as auxiliary requests one month before the oral proceedings. The respondent could not reasonably be expected to be prepared to deal with every dependent claim in addition to the five independent claims and the auxiliary requests. The offer of the appellant not to argue the priority of claims 23 and 29 is irrelevant since such a conditional offer is not admissible. In this situation the Board considers that it is unreasonable to admit this new main request.

The request was therefore not admitted into the proceedings.

- 1.2 During the course of the oral proceedings before the Board the appellant modified several times the independent claims of the main request. The amendments comprised either features which were contained in the above mentioned amendment proposals filed one month before the oral proceedings, or small wording changes to deal with matters which arose during the oral proceedings. None of the amendments gave rise to matters which had not already been in the discussion. The Board therefore admitted the amendments to the main request made during the oral proceedings and hence the main request in its final form as presented by the end of the debate during the oral proceedings.

2. *Admissibility of late filed documents*

- 2.1 D22 was filed by the respondent with his response to the appeal. The appellant did not object to the introduction of the document. The document was filed as early as possible in the appeal proceedings and was a

response to the positive findings of the Opposition Division concerning the novelty and inventive step of some of the independent claims. In view of this the Board admitted the document.

- 2.2 Reference was made by the respondent in his submission of 7 December 2005 to D24, though no copy of the document was supplied. According to the respondent this was an oversight and a copy was filed during the oral proceedings before the Board. The appellant did not object to the introduction of the document which the respondent stated was filed in response to the amendments submitted by the appellant one month before the oral proceedings. In view of this situation the Board admitted the document into the proceedings.

Claim 1

3. *Compliance of the amendment with the formal requirements*

- 3.1 The amendment to the claim whereby the shaving position is defined as occupied when the blade unit is at rest and not in use complies with Rule 57a EPC. In the proceedings before the Opposition Division the claim without the amendment was considered to lack novelty, whereas with the amendment the subject-matter of the claim was considered to be novel and inventive. It is therefore clear that the amendment was occasioned by a ground of opposition.

- 3.2 The feature introduced by the amendment is clear and of a technical character. Hence it complies with Article 84 EPC. The feature is technical since it

defines how the non-shaving position is attained, i.e. when there are no constraints on the device as occurs when the device is at rest and not in use. The feature is also clear since the indication of being at rest and not in use is a clear and evident definition of an unconstrained position of the blade unit concerned.

3.3 The claim as amended complies with Article 123(2) EPC. A basis for the amendment may be found on page 5, lines 10 to 14 of the application as originally filed, which refers to the geometry of the blade unit being different when the blade is at rest and out of use, which inherently implies a non-shaving position.

4. *Novelty*

4.1 The respondent considered that D1 took away the novelty of this claim. According to the arguments of the respondent when the blade unit disclosed in this document is at rest its blade geometry is within the geometry specified in claim 1. As soon as a small movement of one or more of the blades occurs during shaving with the blade unit of D1 then this new geometry must also be within the scope of claim 1 even if the blades thereafter move to a geometry outside the scope of the specified geometry.

4.2 The Board cannot agree with the respondent in this respect. The claim specifies that the blades move from a non-shaving position and "attain a modified blade geometry" which has the specified blade geometry. In the view of the Board a movement to attain a geometry cannot occur if the desired geometry is already present at the start of the movement. The word "attain" means

that the desired geometry is not present at the start of the movement and must be achieved. In the case of D1 the positions of the blades when at rest and not in use are already in the desired shaving geometry defined in claim 1.

4.3 Therefore, the subject-matter of claim 1 is novel in the sense of Article 54 EPC.

5. *Inventive step*

5.1 The respondent offered no arguments with respect to inventive step in view of the reasons given with respect to the interpretation of claim 1 which lead to the subject-matter of the claim being considered to be novel. The Opposition Division in their decision had already come to the conclusion that the subject-matter of claim 1 involves an inventive step. The Board sees no reason to deviate from this finding.

Claim 12

6. *Compliance of the amendment with the formal requirements*

6.1 The amendments to the claim comply with Rule 57a EPC. The amendments limit the scope of the claims in several aspects which contribute to establishing novelty and inventive step.

6.2 Since the number of independent claims has not changed a lack of conciseness does not arise out of the amendment to this claim as was argued by the respondent.

The respondent during the oral proceedings before the Board also showed some arrangements of blades which he considered would comply with the definition of the shaving positions defined in the claim but would not work. However, the claim specifies that the positions are shaving positions. Since the arrangements mentioned by the respondent were clearly not shaving positions they are not within the scope of the claim. The amendments comply with Article 84 EPC.

6.3 Claim 12 as amended complies with Article 123(2) EPC. A basis for the amendment may be found on page 6, lines 4 to 12, page 1, lines 24 to 27 and page 2, lines 8 to 11 of the application as originally filed.

7. *Novelty and inventive step*

7.1 In view of the amendments made to claim 12 during the oral proceedings the respondent presented no arguments against the claim in these respects. The Opposition Division considered that claim 12 already in its unamended form to be novel and inventive. The Board has no reason itself to deviate from the opinion of the Opposition Division.

Claim 23

8. *Compliance of the amendment with the formal requirements*

8.1 The respondent has not raised any grounds concerning the compliance of the amendment with the Convention and the Board has convinced itself that the amendments satisfy the formal requirements of the Convention.

9. *Novelty and inventive step*

9.1 In view of the amendments made to claim 23 the respondent presented no arguments against the claim in these respects. The Board has no reason to deviate from the findings of the Opposition Division (cf. decision grounds, section 4.6) that the subject-matter of the claim is novel and involves an inventive step.

Claim 29

10. *Compliance of the amendment with the formal requirements*

10.1 The respondent has not raised any grounds concerning the compliance of the amendment with the Convention and the Board has convinced itself that the amendments satisfy the formal requirements of the Convention.

11. *Novelty and inventive step*

11.1 In view of the amendments made to claim 29 the respondent presented no arguments against the claim in these respects. The Board has no reason to deviate from the findings of the Opposition Division (cf. decision grounds, section 4.6) that the subject-matter of the claim is novel and involves an inventive step.

Claim 45

12. *Compliance of the amendment with the formal requirements*
- 12.1 The amendments to the claim whereby the shaving position is defined as occupied when the blade unit is at rest and not in use comply with Rule 57a EPC. In the proceedings before the Opposition Division the claim without the amendments was considered to lack novelty. It is therefore clear that the amendment was occasioned by a ground of opposition.
- 12.2 The amendment is clear and of a technical character and hence complies with Article 84 EPC. The feature is technical since it defines how the non-shaving position is attained, i.e. when there are no constraints on the device as occurs when the device is at rest and not in use. The feature is also clear since, as indicated, being at rest and not in use is a clear and evident indication of an unconstrained position of a shaving cartridge.
- 12.3 The claim as amended complies with Article 83 EPC and Article 123(2) EPC. A basis for the amendment may be found on page 5, lines 10 to 14 of the application as originally filed, which refers to the geometry of the blade unit being different when the blade is at rest and out of use which inherently implies a non-shaving position. Claim 45 is directed to a cartridge. It may be noted however that the above mentioned passage states that it applies to all embodiments unless otherwise stated, i.e. also to the cartridge embodiments. Page 1, lines 7 to 16 of the application

as originally filed makes it clear that the invention is applicable to razors which have both permanently attached blade units and removable blade units. Cartridge is in fact the term generally applied to removable blade units, cf. D1 (which was referred to in the application as filed), page 5, lines 30 to 34. There is therefore no reason why the said passage on page 1 should not apply to embodiments directed to a cartridge.

The expression "against the spring bias" can be understood by the skilled person as meaning against whichever spring force is biasing the blades, which also defines the direction of the movement with respect to the bias. Hence the teaching of claim 45 can also be carried out by the skilled person

13. *Novelty*

13.1 The respondent considered that D1 took away the novelty of this claim. According to the arguments of the respondent when the blade unit disclosed in this document is at rest its blade geometry is within the geometry specified in claim 1. As soon as a small movement of one or more of the blades occurs during shaving with the blade unit of D1 then this new geometry must also be within the scope of claim 1 even if the blades thereafter move to a geometry outside the scope of the specified geometry.

13.2 The Board cannot agree with the respondent in this respect. The claim specifies that the blades move from non-shaving positions to shaving positions which have the specified blade geometry. In the view of the Board

a movement to a specified geometry cannot occur if the desired geometry is already present at the start of the movement. The word "to" means, in the context, that the desired geometry is not present at the start of the movement and must be achieved by the movement. In the case of D1 the positions of the blades when at rest and not in use are already in the desired shaving geometry defined in claim 45.

13.3 Therefore, the subject-matter of claim 45 is novel in the sense of Article 54 EPC.

14. *Inventive step*

14.1 The respondent offered no arguments with respect to inventive step in claim 45 in view of the interpretation of the Board of the wording of the claim which lead the Board to consider that the subject-matter of the claim was novel. The Opposition Division did not examine this claim for inventive step since they found that the claim contained added subject-matter. The definition of the geometry of the blades is not so precise as for claim 1 so that the views of the Opposition Division with regard to claim 1 cannot be assumed to apply to claim 45. Nevertheless, the Board sees also in view of lack of arguments by the respondent no reason to consider that claim 45 lacks 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 department of first instance with the order to maintain the patent in the following version:

claims: 1 to 46 as filed during the oral proceedings;

description: pages 2 and 5 as filed during the oral proceedings;
pages 3 and 4 as granted;

drawings: figures 1 to 11 as granted.

The Registrar:

The Chairman:

G. Nachtigall

H.-P. Felgenhauer