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**Datasheet for the decision
of 29 May 2008**

Case Number: T 0776/06 - 3.2.07

Application Number: 02003992.1

Publication Number: 1226904

IPC: B26B 21/22

Language of the proceedings: EN

Title of invention:

Shaving system

Patentee:

The Gillette Company

Opponent:

Eveready Battery Company, Inc.

Headword:

-

Relevant legal provisions:

EPC R. 76(2)(c), 99(2)

Relevant legal provisions (EPC 1973):

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Keyword:

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Decisions cited:

G 0009/91, T 0653/02

Catchword:

Reasons, point 2



Case Number: T 0776/06 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 29 May 2008

Appellant: Eveready Battery Company, Inc.
(Opponent) 533 Maryville University Drive
St Louis, Missouri 63141 (US)

Representative: Hilleringmann, Jochen
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Respondent: The Gillette Company
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Boston, Massachusetts 02190 (US)

Representative: Lerwill, John
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
20 March 2006 concerning maintenance of
European patent No. 1226904 in amended form.

Composition of the Board:

Chairman: H. Meinders
Members: H.-P. Felgenhauer
E. Dufrasne

Summary of Facts and Submissions

I. This decision concerns the appeal of the opponent (appellant) against the interlocutory decision of the Opposition Division according to which European patent No. 1 226 904 has been maintained in amended form.

II. Opposition was filed against claims 11 and 13 of the patent which, as granted, comprised claims 1 - 13.

Claim 11 as granted constituted an independent claim, claims 12 and 13 as granted were each dependent on claim 11. The patent as maintained comprised claims 1 - 10 as granted as well as independent claims 11, 12 and 13.

III. The notice of appeal dated 17 May 2006 comprises the following statement:

"It is requested that:

i) the decision is cancelled in its entirety to the extent that the appellant was adversely affected by it,

ii) the patent is revoked, and

iii) oral proceedings under Article 116 EPC are held in the event that the Board of Appeal intends not to allow the appeal."

IV. In the grounds of appeal filed with letter dated 25 July 2006 reasons were given with respect to claims 11 and 13 as maintained according to the decision under

appeal. No such reasons were given with respect to claim 12 as maintained, which was referred to in the grounds of appeal (cf. page 4, paragraph 3.3) by indicating that it has merely been rewritten as an independent claim and as being of the same scope as claim 12 as granted.

- V. In the reply of the respondent (proprietor) dated 19 December 2006 it has been requested as third auxiliary request the maintenance of the patent with claims 1 - 10 as granted and with claim 12 underlying the decision under appeal.
- VI. In the response of the appellant dated 28 April 2008 to the annex to the summons to oral proceedings sent by the Board with date of 26 February 2008 it is indicated "The Appellant would accept maintenance of the contested patent based on the third or fourth auxiliary request." (page 11, paragraph V).
- VII. In the course of the oral proceedings held 29 Mai 2008 the appellant filed new documents D7 (WO-A-94 08761), D8 (US-A-4 599 793) which were not admitted by the Board. Furthermore it filed the cover page of EP-B-0 619 771 and a handwritten sketch.

The appellant furthermore confirmed its declaration cited above in paragraph VI.

After the discussion of these requests the respondent withdrew its main, first and second auxiliary requests as formulated with letter dated 19 December 2006 and made its third auxiliary request (cf. section V. above) its main request.

Reasons for the decision

1. The competence of the Board to decide in these appeal proceedings is limited by the extent to which the patent has been opposed (Rule 76(2)(c) EPC, G 9/91, OJ EPO 1993, 408, reasons nos. 10, 11) and by the extent to which the impugned decision has been appealed (Rule 99(2) EPC).

In the present case the extent of the opposition was limited to claims 11 and 13 as granted, thus excluding claims 1 - 10 and claim 12 as granted. The decision under appeal maintained the patent with claims 1 - 10 as granted and three independent claims 11, 12 and 13.

As concerns the independent claims 11, 12 and 13, the Board establishes that the subject-matter of claim 11 results from a further limitation of claim 11 as granted, that claim 12 is identical to claim 12 as granted (i.e. the combined wording of claims 11 and 13 as granted) and that claim 13 is identical with claim 13 as granted (i.e. the combined wording of claims of claims 11 and 13 as granted).

- 1.1 The appellant is thus adversely affected only by the maintenance of the patent insofar as as claims 11 and 13 are concerned.

Correspondingly the appeal is limited in its extent to claims 11 and 13 as maintained by the impugned decision; cf. notice of appeal (section III., item i), above).

- 1.2 According to the present main request these two claims, objected to in the appeal, have been eliminated.

Claim 11 according to this request corresponds to claim 12 as maintained, i.e. the combined wording of claims 11 and 12 as granted (cf. section IV above).

2. As a consequence of the extent of the appeal being limited to claims 11 and 13 of the claims as maintained by the impugned decision and of the removal of these claims from the respondents main request, present claims 1 - 10 and claim 11 lie, as agreed upon by the parties at the oral proceedings, outside the extent of the appeal.

The extent of the appeal being limited in this manner has the effect that the Board has no competence to decide with respect to the part of the patent in suit which is not covered by the appeal (cf. T 0653/02 of 9 July 2004, not published in the OJ EPO, reasons, no. 2.). The Board thus has no power to decide with respect to claims 1 - 11 according to the main request. This finding of the Board pronounced at the oral proceedings was not challenged by the parties either.

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 on the basis of the following documents:
 - claims: 1 to 10 of the patent as granted, claim 11 as filed at the oral proceedings;
 - description: page 2 filed at the oral proceedings, pages 3 to 5 of the patent as granted;
 - figures: 1 to 22 of the patent as granted.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders