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**Datasheet for the decision
of 4 February 2009**

Case Number: T 1011/07 - 3.2.07

Application Number: 98947858.1

Publication Number: 0952088

IPC: B65D 43/16

Language of the proceedings: EN

Title of invention:
Freely openable container

Patent Proprietors:
UNI-CHARM CORPORATION and DAI NIPPON PRINTING CO., LTD.

Opponent:
The Procter & Gamble Company

Headword:

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Relevant legal provisions:
EPC Art. 100(c), 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:
"Amendments - all requests (not allowable)"

Decisions cited:
T 0191/93, T 0169/83

Catchword:

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Case Number: T 1011/07 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 4 February 2009

Appellants:

(Patent Proprietors)

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Respondent:

(Opponent)

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 16 April 2007
revoking European patent No. 0952088 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: K. Poalas
E. Dufrasne

Summary of Facts and Submissions

- I. The appellants (patent proprietors) lodged an appeal against the decision of the Opposition Division revoking European patent No. 0 952 088.

- II. Opposition had been filed against the patent as a whole based on Article 100(a) EPC on the grounds of lack of novelty (Article 54 EPC) and lack of inventive step (Article 56 EPC), on Article 100(b) EPC (insufficient disclosure) and on Article 100(c) EPC (unallowable amendments).

- III. The Opposition Division found that the claims of the main request (patent as granted) and the auxiliary requests III to VI did not fulfil the requirements of Article 123(2) EPC. The Opposition Division found further that the subject-matter of claim 1 of the remaining auxiliary requests I and II fulfilled the requirements of Article 123(2) EPC, but did not involve an inventive step (Article 56 EPC).

- IV. Oral proceedings before the Board of Appeal took place on 4 February 2009.
 - (a) The appellants requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request, filed with letter dated 10 August 2007 or, in the alternative, on the basis of one of the auxiliary requests I to V, filed on the same date, or on the basis of the auxiliary request VI, filed with letter dated 8 December 2008.

(b) The respondent (opponent) requested that the appeal be dismissed.

V. Independent claim 1 according to main request reads as follows (underlining added by the Board):

"A container (10) with a hinged lid (23) comprising: a container body (11) having an upper wall (27) provided with an opening (24) wherein the container body (11) has a round inclined wall extending between the upper wall (27) and a sidewall (13); a hinged lid (23), hinged on the side wall (13) of the container body (11), such that the lid (23) is attached to the vicinity of the opening (24) of the container body (11) and capable of tightly covers the opening (24); the hinged lid (23) is provided on its free end edge with a locking part (32), and the container body (11) is provided with a catching part (33) capable of catching the locking part (32), the container body (11) having an open lower end and the side wall (13) extending down in a diverging manner from the upper wall (27), wherein a bottom wall (12) tightly covering the open lower end of the side wall (13), wherein the container body (11) has a depressed part (58) in respect of the round inclined wall (31), an elastic biasing means (50) for biasing the hinged lid (23) in an opening direction is provided between the hinged lid (23) and the container body (11), an operating device (55) having a horizontal strip (55b) is formed on the depressed part (58), and the operating device is positioned near a free-edge part of the hinged lid, and the catching part (33) is formed on the operating device (55), and the horizontal strip (55b) is depressed with respect to the upper wall (27) and is

placed within the outer profile of the container body (1)".

The claims 1 according to each of the auxiliary requests I to VI, being a combination of claim 1 according to the main request with additional features, all include the following expression of claim 1 of the main request: "the horizontal strip (55b) is depressed with respect to the upper wall (27) and is placed within the outer profile of the container body (1)", as underlined by the Board.

VI. The appellants argued essentially as follows:

Claim 1 according to all requests: Amendments (Article 100(c) and 123(2) EPC)

The claims 1 according to all requests claim the following features, which are present in claim 1 as granted.

feature A: the horizontal strip is depressed with respect to the upper wall, and

feature B: the horizontal strip is placed within the outer profile of the container body.

Although no textual basis exists in the originally filed application for the features A and B, said features are derivable from the figures as originally filed.

The objections under Article 100(c) and Article 123(2) EPC therefore cannot hold.

VII. The respondent argued essentially as follows:

*Claim 1 according to all requests: Amendments
(Articles 100(c) and 123(2) EPC)*

Neither feature A nor feature B finds basis in the wording of the description or claims of the originally filed application. Furthermore, neither feature is derivable as a general or preferable feature of the invention from the originally filed application, because the first feature is not present in the first embodiment of the invention because of its modifications shown in figures 3, 6 and 11 (the horizontal strip is at the same level as the upper wall), and the second feature is not present in the second embodiment (see in particular figure 21 in which the horizontal strip protrudes outside the outer profile of the container body). Added feature A can only be distinguished in the figures 9, 10 and 15 representing modifications of the first embodiment and in figure 21 representing a modification of the second embodiment. Each of these figures not only shows said feature, but also numerous other features, which the skilled person would understand as no less important to the invention as the features A and B which the appellants have arbitrarily selected for claim 1 as granted.

Therefore, the objections under Articles 100(c) and 123(2) EPC against the patent in suit are well-founded.

Reasons for the Decision

1. *Claim 1 - main request: Amendments (Article 100(c) EPC)*

1.1 The features A and B stating that "the horizontal strip is depressed with respect to the upper wall", which is also "placed within the outer profile of the container body" are not mentioned *expressis verbis*, alone or in combination in the description, nor in the claims of the application as originally filed.

1.2 In principle it is possible - without infringing Article 123(2) EPC - that features which are originally disclosed only in the drawings can be used to further characterize the claimed invention, if these features are directly and unambiguously derivable, in respect of their structure as well as their function, from the drawings and as long as they do not contradict other parts of the disclosure (see e.g. T 169/83, OJ EPO 1985, 193, point 3.5 of the reasons).

This has not been disputed by the appellant. The appellant relies entirely on what it argues as being shown in the figures.

1.3 In this respect the Board notes that in the originally filed application a horizontal strip was illustrated only in the embodiments of figures 9, 11, 15 and 21. Of these, however, the embodiment of figure 11 does not show a horizontal strip which is depressed (in the sense as claimed of "lower than") with respect to the upper wall and the embodiment of figure 21 does not show a horizontal strip placed within the outer profile of the container body. Further, the embodiment of

figure 3 does not even show a horizontal strip. Thus there is, for the skilled person, not a consistent disclosure that a horizontal strip which is depressed relative to the upper wall and is placed within the outer profile of the container is actually part of the invention. In particular, there is no mention whatsoever in the originally filed application of advantages associated with these features or that they have any particular significance independently of the other features shown in the figures. This applies also to figures 9 and 15, which do show features A and B.

- 1.4 With respect to structure and function it is noted that no hint can be found in the application as originally filed that the advantages obtained (or problems solved) as presented in that application, insofar as related to the lid operating device of which the now claimed horizontal strip forms an essential part, are obtained (or solved) due to the features A and B, i.e. due to the relation of the location of the horizontal strip with respect to the upper wall ("depressed") or with respect to the container body ("within the outer profile"). The appellants did not put forward any technical problem(s) solved by said features A and B, nor did they present arguments concerning their technical relevance or any technical effect obtained because of them.

As a consequence, these two features, on their own, are to the skilled person not directly and unambiguously derivable from the figures, but are merely the expression of the draughtsman's artistic freedom.

Claim 1 of the main request, comprising these features already in its form as granted, has thus been amended during the examination proceedings such that it extends beyond the content of the application as originally filed (Article 123(2) EPC); the objection under Article 100(c) EPC is therefore successful against the main request.

*Claim 1 - auxiliary requests I to VI: Amendments
(Article 123(2) EPC)*

No hint can be found in the application as originally filed that any technical advantages are obtained or technical problems are solved due to the combination of the features A and B of claim 1 of the main request with the additional features of the respective claims 1 of the auxiliary requests I to VI. Furthermore, the appellants presented no arguments in support of any technical advantages obtained or technical problems solved by the possible combinations of said features, so as to show that they can be directly and unambiguously derived from the originally filed application.

The arbitrary selection and isolation of those features from the other features shown in the figures with a relation to features A and B is thus also objectionable under Article 123(2) EPC, see in this respect T 191/93, not published in OJ EPO, point 2.1 of the reasons.

The auxiliary requests I to VI are therefore not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders