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# Datasheet for the decision of 12 October 2009

**Case Number:** T 0407/08 - 3.2.04

**Application Number:** 01104902.0

**Publication Number:** 1138221

**IPC:** A45D 29/04

**Language of the proceedings:** EN

**Title of invention:**
File, particularly nail file

**Patentee:**
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**Opponent:**
ARTDECO cosmetic GmbH
Dilwinder Kaur, Gill
Pavlica, Tomas

**Headword:**
-

**Relevant legal provisions:**
RPBA Art. 13(1)

**Relevant legal provisions (EPC 1973):**
EPC Art. 76(1), 100c)

**Keyword:**
"Main request, auxiliary requests 1-5, added subject-matter (yes)"
"Auxiliary request 6 - admissibility (no)"

**Decisions cited:**
T 0331/87

**Catchword:**
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

**Case Number:** T 0407/08 **-** 3.2.04

# D E C I S I O N
**of the Technical Board of Appeal 3.2.04**
**of 12 October 2009**

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**Decision under appeal:** **Decision of the Opposition Division of the European Patent Office posted 20 December 2007 revoking European patent No. 1138221 pursuant to Article 102(1) EPC.**

**Composition of the Board:**

**Chairman:** M. Ceyte
**Members:** C. Scheibling
T. Bokor

## Summary of Facts and Submissions

I. By its decision dated 20 December 2007 the Opposition Division revoked the European patent 1 138 221. On 20 February 2008 the Appellant (patentee) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 18 April 2008.

II. The patent was opposed on the grounds based on Article 100a), b) and c) EPC 1973. The Opposition division considered that claims 1 and 8 as granted did not comply with the requirements of Article 76(1) EPC 1973.

III. The following documents played a role in the present proceedings:
The parent application: WO-A-99/02064 and the expert's opinion of Professor Tönshoff dated May 2006, filed on 11 September 2009 by the Appellant.

IV. Oral proceedings took place on 12 October 2009 before the Board of Appeal.

The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims as granted (main request), in the alternative that the patent be maintained on the basis of the auxiliary request 1 filed with the grounds of appeal, auxiliary requests 2 to 5 filed with letter dated 11 September 2009 or auxiliary request 6 filed during the oral proceedings before the Board.

He mainly argued as follows:

The range of 10 µm to 100 µm mentioned at several places in the patent application as originally filed is not an essential feature of the invention. Roughening to a greater or smaller extent simply defines the possible various uses of the file, as set out in the last sentence on page 3 of the description "A file produced according to this invention with a low degree of roughness, that is to say the finest, can be used in polishing surfaces, for example, while the coarsest can be used for grinding"

This passage discloses an alternative way of defining the degree of roughness that the applicant decided to incorporate into claim 1 in place of the numerical range. This numerical range which is unimportant to the invention can be omitted from the claim.

Acid engraving and sanding are both disclosed over the full range of degrees of roughness. The passage on page 3 in the second paragraph that refers to acid engraving in connection with the smoothest finish is a specific example and does not have the effect of limiting the range over which acid engraving is disclosed.

The second paragraph of page 2 of the description is to be read in conjunction with the first paragraph of the "Summary of the invention" of page 1. This makes it clear that the full range of roughness can be obtained by acid engraving. In connection with sanding it is clear that in order to obtain a surface of high roughness by sanding, the roughening process must be continued until a surface of the desired roughness is produced. At earlier stages in the roughening process the surface will have a lower roughness. Thus, inherently any disclosure of roughening using sanding

for the coarsest end of the range must also be a disclosure of roughening for the fine end of the range.
The auxiliary request 6 submitted at the end of the oral proceedings has been prompted by the discussion of added subject-matter. This request is prima facie allowable and therefore cannot be rejected as late filed.

The Respondents I to III (opponents I to III) mainly submitted that glass files produced by acid engraving or sanding which can be used for polishing and respectively for grinding, may have a roughness less than 10 µm and of more than 100 µm. Therefore the functional definition of the range of roughness as in claim 1 as granted involves added subject-matter.
Moreover the roughness range of 10 µm to 100 µm is claimed in claim 1 of the parent application as originally filed and presented as essential in the description.
Nowhere in the parent application is it indicated that acid engraving or sanding can produce any degree of roughness within the range from 10 µm to 100 µm.
The auxiliary request 6 has been filed at the latest possible moment at the oral proceedings, is not prima facie allowable and thus has to be rejected as late filed.

The Respondents I to III requested that the appeal be dismissed.

V. Claims 1 as granted reads as follows:

"1. A file, particularly for nails, manufactured from glass by acid engraving or sanding sufficient to

achieve a roughness (4) on at least part of the surface (2) of the glass in the range which at its finest is suitable for polishing surfaces and at its coarsest is suitable for grinding, and a hardening process."

Claim 1 of auxiliary request 1 differs from claim 1 as granted in that the subject-matter claimed therein has further been limited to a "nail file".

Claim 1 of auxiliary request 2 reads as follows:

"1. A file, particularly for nails, manufactured from glass by acid engraving or sanding sufficient to achieve a roughness (4) on at least part of the surface (2) of the glass in the range 10 µm - 100 µm which at its finest is suitable for polishing surfaces and at its coarsest is suitable for grinding, and a hardening process."

Claim 1 of auxiliary request 3 reads as follows:

"1. A file, particularly for nails, manufactured from glass by acid engraving sufficient to achieve a roughness (4) on at least part of the surface (2) of the glass in the range which at its finest is suitable for polishing surfaces and at its coarsest is suitable for grinding, and a hardening process, wherein the file is roughened along the whole of one side at least, and has a V-shaped point (5) at the end."

Claim 1 of auxiliary request 4 reads as follows:

"1. A file, particularly for nails, manufactured from glass by acid engraving or sanding sufficient to

achieve a roughness (4) on at least part of the surface (2) of the glass in the range which at its finest is suitable for polishing surfaces and at its coarsest is suitable for grinding, followed by a hardening process."

Claim 1 of auxiliary request 5 reads as follows:

"1. A file, particularly for nails, manufactured from glass by acid engraving sufficient to achieve a roughness (4) on at least part of the surface (2) of the glass in the range 10 µm - 100 µm which at its finest is suitable for polishing surfaces and at its coarsest is suitable for grinding, and a hardening process, wherein the file is roughened along the whole of one side at least, and has a V-shaped point (5) at the end."

Claim 1 of auxiliary request 6 reads as follows:

"1. A file, particularly for nails, manufactured from glass by acid engraving or sanding sufficient to achieve a roughness (4) on at least part of the surface (2) of the glass in the range 10 µm to around 100 µm which at its finest is suitable for polishing surfaces and at its coarsest is suitable for grinding, and a hardening process, wherein the roughened is one of:
1) around 10 µm and produced by acid engraving with an HF solution and
2) around 100 µm and produced by sanding."

## Reasons for the Decision

1. The appeal is admissible.

2. *Main request - article 76(1) and 100 (c) EPC*

2.1 Claim 1 of the parent application comprises the feature "with a roughness varying from 10 µm to 100 µm".
On page 1 of the parent application it is further indicated in the "Summary of the invention" that "The above disadvantages are eliminated in the file according to the invention presented here, the basis of which lies in the fact that it is made from glass roughened on at least part of its surface with a roughness varying from 10 to 100 µm" and "It is important to note here the wide range of surface roughness that can be attained, varying from the smoothest finish with a roughness of 10 µm to a roughness of around 100 µm".

Thus, the roughness between 10 and 100 µm is clearly explained as essential in the disclosure of the parent application and therefore cannot be deleted from the claim (see Guidelines C-VI, 5.3.10 an T 331/87 OJ, EPO 1991, 022).

2.2 The amendment in claim 1 results from changing the numerical range of roughness from 10 and 100 µm to the general range of roughness "suitable for polishing" to "suitable for grinding".
The subject-matter generated by the amendments is not directly and unambiguously derivable from the parent application as originally filed, since the skilled person is presented with new information that the range

of roughness may exceed the numerical range of 10 to 100 µm or expressed differently, that the finest roughness of the range may be less that 10 µm if it is suitable for polishing and the coarsest roughness of the range may be more than 100 µm if it is suitable for grinding.

2.3 The Appellant referred to the last sentence on page 3 of the parent application which reads "A file produced according to this invention with a low degree of roughness, that is to say the finest, can be used in polishing surfaces, for example, while the coarsest can be used for grinding" and submitted that this passage provides a support for the generalised range of roughness "suitable for polishing" to "suitable for grinding". This point of view cannot be shared. The above quoted passage concerns a file "according to the invention" i.e. exhibiting a roughness from 10 to 100 µm.

2.4 It is further common general knowledge that a file exhibiting a roughness of less than 10 µm, for example 5 µm is still suitable for polishing, and that a file exhibiting a roughness of more than 100 µm for example 200 µm is suitable for grinding.

Therefore, the amendment in claim 1 which results from changing the numerical range of roughness from 10 and 100 µm to the range of roughness "suitable for polishing" to "suitable for grinding" constitutes a generalisation involving added subject-matter contrary to Article 76(1) and 100 c) EPC 1973. Consequently the main request must fail.

3. *Auxiliary requests 1, 3 and 4*

Claim 1 of auxiliary requests 1, 3 and 4 contains the same amendment as claim 1 of the main request. Accordingly, for the same reasons as indicated above, claim 1 of these requests contravenes the requirements of Article 76(1) and 100 c) EPC 1973 and thus, the auxiliary requests 1, 3 and 4 must fail too.

4. *Auxiliary requests 2 and 5*

4.1 An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed, if the skilled person is presented with information which is not directly and unambiguously derivable from the original application taking into account matter which is implicit to a skilled person (see Guidelines C-VI, 5.3.1).

4.2 According to the amendments made in claim 1 of the auxiliary requests 2 and 5, the full range of roughness of 10 µm to 100 µm can be achieved by acid engraving. This amendment is not directly and unambiguously derivable from the patent application as originally filed.

In the present case the sole passage of the parent application which refers to how roughness is produced reads: "The roughening 4 is produced by a wide variety of techniques, the choice depending upon the degree of roughness. To produce the smoothest finish, for example around 10 µm, a chemical process can be used, such as acid engraving with a hydrogen fluoride solution.

Greater roughness, of around 100 µm for instance, can be produced mechanically, by sanding for example."

This passage merely specifies that a roughness of around 10 µm can be obtained by acid engraving and that a roughness of around 100 µm can be obtained by sanding, but leaves open which technique should be used for obtaining a roughness in between the two limits.

The Appellant argued that this amendment finds support in the second paragraph of page 2 of the parent application that reads: "Another advantageous solution to be noted is the fact that the glass body of the file is roughened along one whole side at least, having a V-shaped point at the end. The advantages of such a file are apparent both during use of the file and during its manufacture, when roughening of the whole surface is carried out without the need, for instance, to mask part of the surface during the roughening process by use of acid engraving for example…" when read in conjunction with the first paragraph of the "Summary of the invention" of page 1 that states: "The above disadvantages are eliminated in the file according to the invention presented here, the basis of which lies in the fact that it is made from glass roughened on at least part of its surface with a roughness varying from 10 to 100 µm".

However, the quoted passage of the "Summary of the invention" defines the roughness range from 10 µm to 100 µm of a file according to the invention. The further quoted passage merely mentions the advantage of using acid engraving when roughening the whole surface of the file. The feature that any degree of roughness

within the range of 10 µm to 100 µm can be obtained by acid engraving cannot be derived from the two above quoted passages.

The Appellant has filed a copy of an Expert opinion of Professor Tönshoff which was ordered by a German Court in a patent litigation and concerns a file manufactured from glass inter alia by acid engraving. In this opinion page 15, fourth paragraph, it is stated that according to general experience only a roughness of some micrometers can be obtained by acid engraving and that in any case it is uncertain whether a roughness around 100 µm could be obtained by an acid engraving process.
Consequently, the fact that a roughness range from 10 µm to 100 µm can be obtained by acid engraving is not implicit for a skilled person.

The Appellant has presented a sample of a glass surface with a roughness of more than 100 µm obtained by acid engraving. However, this sample in itself cannot demonstrate that it was implicit for a skilled person that such degree of roughness could be obtained by acid engraving.

4.3 Accordingly, amended claim 1 of the auxiliary requests 2 and 5 does not fulfil the requirements of Articles 76(1) and 100c) EPC. Thus, the auxiliary requests 2 and 5 must fail.

5. *Auxiliary request 6 - admissibility*

5.1 This request has been filed at the end of the oral proceedings, after the Chairman of the Board has stated

the final requests of the parties, and announced that neither the main request nor the auxiliary requests 1 to 5 are allowable.

This request has been filed at the latest possible moment at the oral proceedings without any proper justification. The Board in exercising its discretion under Article 13(1) of the Rules of Procedures of the Boards of Appeal decided not to admit it into the appeal proceedings.

5.2 In this respect, it should be noted that this late filed request was clearly not allowable with respect to the requirements of Article 76(1) or 100c) EPC 1973. Claim 1 requires the roughness of a glass file manufactured inter alia by acid engraving to be within the range of 10 µm to 100 µm wherein the roughness is one of

1) around 10 µm and produced by acid engraving …
2) around 100 µm and produced by sanding.

In other words, according to the claimed invention a roughness in the range of 10 µm to around 100 µm can be obtained by acid engraving, a roughness of around 100 µm which is obtained by sanding being now excluded from the claimed range. As has been explained with respect to auxiliary requests 2 and 5, this feature is not directly and unambiguously derivable from the parent application as originally filed, contrary to the requirements of Article 76(1) and 100c) EPC 1973.

## Order

**For these reasons it is decided that:**

The appeal is dismissed

The registrar: The Chairman:

G. Magouliotis M. Ceyte