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**Datasheet for the decision  
of 16 June 2009**

**Case Number:** T 0582/08 - 3.2.06

**Application Number:** 99111796.1

**Publication Number:** 0957196

**IPC:** D06F 39/14

**Language of the proceedings:** EN

**Title of invention:**

Front loading laundry washing and/or drying machine, with improved means for the door opening

**Patentee:**

Indesit Company S.p.A.

**Opponent:**

Candy S.p.A.

**Headword:**

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**Relevant legal provisions:**

-

**Relevant legal provisions (EPC 1973):**

EPC Art. 100(c), 76(1), 111(1)

RPBA Art. 13(1)

**Keyword:**

"Inadmissible extension (intermediate generalisation) - main and first to fourth and sixth to ninth auxiliary requests"

"Unallowable broadening of the scope of the claim - second, third, seventh and eighth auxiliary requests"

"Late filed requests - not admitted because not clearly allowable - tenth to nineteenth auxiliary requests"

"Late filed request - not admitted - twentieth auxiliary request"

**Decisions cited:**

G 0001/93, G 0001/86, T 0112/06, T 0382/05, T 1408/04

**Catchword:**

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Case Number: T 0582/08 - 3.2.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.06  
of 16 June 2009

**Appellant:** Indesit Company S.p.A.  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 28 January 2008  
revoking European patent No. 0957196 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. Alting Van Geusau  
**Members:** G. Pricolo  
R. Menapace

## Summary of Facts and Submissions

- I. The appeal is from the decision of the Opposition Division posted on 28 January 2008 revoking European patent No. 0 957 196 which was granted in respect of European patent application No. 99 111 796.1, a divisional application to the earlier European patent application No. 96102265.4.

Claim 1 of the patent as granted reads as follows:

"1. Laundry washing and/or drying machine having a cabinet (1), in the front part of said cabinet being present an opening (4) for the loading/unloading of the laundry, a door (5) for closing said opening, a hinge (9) to pivot said door (5) to said cabinet (1), a door lock/release system (6, 7, 8), characterized in that said lock/release system comprises elements (6, 7) located in the upper half of said door (5) and in that said hinge (9) has at least a point being positioned on a centre-line of the door (5), while none of said elements (6, 7) has a point being positioned on said centre-line of the door (5)."

- II. In coming to its decision the Opposition Division held that claim 1 as granted embodied subject-matter extending beyond the content of the earlier application as filed (Article 76(1) EPC). The Opposition Division explained that at filing the earlier application had claims directed towards two aspects. The first aspect, which was covered by independent claim 1, related to a laundry washing and/or drying machine having a front loading door hinged to the cabinet by a hinge being so fastened to the cabinet that the rotation axis of the

door was inclined with respect to the vertical axis of the machine so to allow an opening motion of the door being at least partially autonomous. The second aspect, which was covered by independent claim 13, related to a laundry washing and/or drying machine having a front loading door hinged to the cabinet and having some elements of the lock/release system located in the upper half of said door. A single specific embodiment was represented in Figures 1-3 of the parent patent application, the embodiment providing an example of a laundry machine according to both independent claim 1 and independent claim 13. The feature that the lock/release system comprised some elements located in the upper half of the door was presented in the parent application either without any specific reference to the position of the hinge, as in originally filed claim 13, or in combination with the hinge being fastened to the cabinet in such a way that the rotation axis of the door was inclined with respect to the vertical axis of the machine, as in the embodiment represented in Figures 1-3. No other possible relative arrangement of the hinge and of the lock/release system was specifically disclosed in the parent application. The combination of features according to claim 1 was not limited to hinges being fastened to the cabinet in such a way that the rotation axis of the door was inclined with respect to the vertical axis of the machine so that an opening motion of the door being at least partially autonomous was obtained. In particular also a hinge mainly located in the upper half of the door or a hinge being symmetrical with respect to the door horizontal centre-line, which were clearly in contrast to the disclosure of the earlier patent

application, were encompassed by the wording of granted claim 1.

The Opposition Division considered that the same arguments also applied to claim 1 according to the first auxiliary request filed by the patentee, which only differed from claim 1 as granted in that it specified that the centre-line was horizontal.

Also the subject-matter of claim 1 according to the second to fourth auxiliary requests was considered to extend beyond the content of the earlier application as filed, for the following reasons.

Claim 1 according to the second auxiliary request was amended over claim 1 as granted by removing the feature: "said hinge has at least a point being positioned on a centre-line of the door, while none of said elements has a point being positioned on said centre-line of the door" and adding the feature: "the machine has a mutually non aligned hinge and lock release system". However, the added feature was disclosed in the context of the specific embodiment in combination with the feature that the rotation axis of the door was not perpendicular to the machine laying plane. The fact that the hinge and the lock/release system described with reference to the specific embodiment were mentioned as being mutually misaligned did not mean that a hinge and a lock/release system being mutually misaligned without the hinge providing for an inclined rotation axis of the door had been disclosed. The fact that the position of the hinge was irrelevant with respect to the fact that the lock/release system was located in the upper half of the door and that in fact

no specific position of the hinge was claimed in independent claims 1 and 3 of the parent patent application, did not mean that support existed for a specific combination of hinge and lock/release system in which the hinge did not provide for an inclined rotation axis of the door.

Claim 1 according to the third auxiliary request was amended over claim 1 as granted by replacing the feature "said hinge has at least a point being positioned on a centre-line of the door, while none of said elements has a point being positioned on said centre-line of the door" with the feature of granted claim 3 according to which "said door lock/release system comprises at least a first component located on said door and at least a second component located on said cabinet". Furthermore claim 1 was amended to specify that the lock release/system comprised elements located "only" in the upper half of said door. The Opposition Division took the view that the added feature according to which the lock/release system comprised, generally, at least a second component located on said cabinet, was not disclosed in the parent application, which exclusively disclosed, as said second component, a seat.

Claim 1 according to the fourth auxiliary request was amended over claim 1 as granted by adding the features of granted claims 2 and 4, according to which "said elements (6, 7) comprise a manual actuation device (7), which is located in the upper half of the door (5) in a position being ergonomically comfortable for its actuation, and wherein said elements (6, 7) are inclined by at least 30° in respect to said centre-line

of the door (5)". Since claim 1 included all the features of granted claim 1 but not the feature relating to the inclination of the rotation axis of the door, it likewise contained subject-matter extending beyond the content of the earlier application as filed for the same reasons as claim 1 as granted. As regards the amendment made to the description, consisting in adding the disclaiming statement

"No rights are claimed for the features

"... that said hinge has at least a point being positioned on a centre-line of the door, while none of said elements has a point being positioned on said centre-line of the door..." ,

the Opposition Division considered that it was not allowable in view of the decision G 1/93 of the Enlarged Board of Appeal, where it was stated that the EPC did not envisage or allow a statement to be introduced in the description of a particular patent, qualifying the rights which may be derived by a particular technical feature in a claim of that patent.

- III. The appellant (patent proprietor) filed an appeal against this decision on 18 March 2008. Payment of the appeal fee was recorded on the same day. With the statement setting out the grounds of appeal, received at the EPO on 27 May 2008, the appellant requested that the decision be set aside and the patent be maintained as granted or according to one of the first to fourth auxiliary requests considered by the opposition division in the decision under appeal, the fourth auxiliary request being modified by deleting the disclaiming statement added to the description, or according to the fifth or sixth auxiliary requests filed with the grounds of appeal.



IV. Claim 1 according to the fifth auxiliary request reads as follows:

"1. Laundry washing and/or drying machine having a cabinet (1), in the front part of said cabinet being present an opening (4) for the loading/unloading of the laundry, a door (5) for closing said opening, a hinge (9) to pivot said door (5) to said cabinet (1), a door lock/release system (6, 7, 8), characterized in that said lock/release system comprises elements (6, 7) located in the upper half of said door (5), and in that said door lock/release system comprises at least a first component (6, 7) located on said door (5) and a seat (8) located on said cabinet (1)".

Claim 1 according to the sixth auxiliary request reads as follows:

"Laundry washing and/or drying machine having a cabinet (1), in the front part of said cabinet being present an opening (4) for the loading/unloading of the laundry, a door (5) for closing said opening, a hinge (9) to pivot said door (5) to said cabinet (1), a door lock/release system (6, 7, 8), characterized in that said lock/release system comprises elements (6, 7) located in the upper half of said door (5), and wherein said elements (6, 7) comprise a manual actuation device (7) which is located in the upper half of said door (5) in a position being ergonomically comfortable for its actuation, said elements (6, 7) being inclined by at least 30 degrees in respect to the horizontal center-line of the door (5)."

V. In an annex to the summons for oral proceedings pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal, the Board expressed the preliminary opinion that the findings of the Opposition Division in respect of all requests on which was based the decision under appeal (main and first to fourth auxiliary requests) appeared correct. The Board further raised objections under Article 123(3) EPC in respect of the second, third, fifth and sixth auxiliary requests. In claim 1 according to these requests, the features according to which "said hinge has at least a point being positioned on a centre-line of the door and none of the elements has a point being positioned on said centre-line of the door" had been deleted from claim 1, thereby unduly broadening the scope of protection.

VI. With letter dated 15 May 2009 the appellant contested the Board's preliminary opinion and submitted that no inadmissible extensions had been made. However, for overcoming the objection under Article 123(3) EPC, the appellant filed two new auxiliary requests (seventh and eighth auxiliary requests).

VII. Claim 1 according to the 7th auxiliary request includes all the features of claim 1 as granted and additionally defines:

"whereby the machine has a mutually non aligned hinge (9) and lock/release system (6, 7, 8)."

In addition to the features of claim 1 according to the 7th auxiliary request, claim 1 according to the 8th auxiliary request includes the following feature:

"and said lock/release system comprises elements (6, 7) located in the upper half of said door (5) in a position being ergonomically comfortable for its actuation."

VIII. Oral proceedings, at the end of which the decision of this Board was announced, took place on 16 June 2009.

The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or on the basis of one of the auxiliary requests 1 to 9 (auxiliary request 9 filed during the oral proceedings) or on the basis of said requests each with the description as amended by the addition as filed during the oral proceedings, or on the basis of the 20th auxiliary request filed during the oral proceedings.

The respondent (opponent) requested that none of the late-filed requests be admitted into the proceedings and that the appeal be dismissed.

IX. Claim 1 according to the 9th auxiliary request reads as follows:

"1. Laundry washing and/or drying machine having a cabinet (1), in the front part of said cabinet being present an opening (4) for the loading/unloading of the laundry, a door (5) for closing said opening, a hinge (9) to pivot said door (5) to said cabinet (1), said hinge (9) having at least a point being positioned on horizontal center-line of the door (5), and a door lock/release system (6, 7, 8), characterized in that

said lock/release system (6, 7, 8) comprises elements (6, 7) located in the upper half of said door (5) such that none of said elements (6, 7) have a point being positioned on said center-line of the door (5), and that said hinge (9) is fastened to the cabinet (1) so that the rotation axis (S) of said door (5) is vertical or inclined with respect to the vertical axis (M) of the machine, whereby said inclination of the rotation axis (S) of said door (5) is suitable to allow an opening motion of the door being at least partially autonomous, after that the latter has been released through said lock/release system (6, 7, 8)."

The statement added to the description (after the final sentence on col. 4) in accordance with the 10th to 19th auxiliary requests (in which claim 1 is identical to claim 1 according to the main and first to 9th auxiliary requests, respectively) reads as follows: "No rights are asserted to the features "said hinge has at least a point being positioned on a centre-line of the door" and "none of said elements (6, 7) has a point being positioned on said centre-line of the door (5)".

Claim 1 according to the 20th auxiliary request differs from claim 1 according to the 10th auxiliary request only in that the term "vertical" has been deleted.

X. The arguments of the appellant in support of its requests can be summarized as follows:

As acknowledged in the patent in suit, it was generally known that the door of front loading laundry washing and/or drying machines was provided with a hinge whose axis was vertical and which was located in line with

the centre-line of the door. Claim 13 of the earlier application as filed did not specify the arrangement of the hinge and thus clearly was meant to cover the prior art hinge arrangement in addition to the particular arrangement according to the specific embodiment of the invention in which the axis of the hinge was inclined with respect to the vertical. Therefore, by not specifying that the axis of the hinge was inclined, claim 1 according to the main and first to eighth auxiliary requests did not introduce subject-matter extending beyond the content of the application as filed. Claim 1 according to the ninth auxiliary request explicitly recited that the hinge was fastened to the cabinet so that the rotation axis of the door was vertical, as in the generally known prior art.

The statement added to the description in accordance with the 10th to 19th auxiliary requests served the purpose of avoiding the inescapable trap caused by the conflicting requirements of Articles 123(2) and (3) EPC. With this statement, the patentee declared that it did not claim rights for those features recited in claim 1 which were considered to represent an inadmissible extension but could not be deleted in view of the provisions of Article 123(3) EPC.

By combining granted claims 1 and 8, claim 1 according to the 20th auxiliary request was restricted to a laundry washing and/or drying machine in which the hinge was fastened to the cabinet so that the rotation axis of the door was inclined with respect to the vertical axis of the machine. This amendment removed the cause of non-compliance with the requirements of Article 76(1) EPC. The 20th auxiliary request was filed

during the oral proceedings before the Board, after the previous requests had been discussed, because the appellant was convinced that its position was correct. The appellant made serious efforts for overcoming the objections under Article 76(1) EPC in that it filed several auxiliary requests. Only during the discussion at the oral proceedings it became clear to the appellant that the Board would not be convinced that it was not necessary to include the feature relating to the inclination of the hinge in claim 1. Accordingly, the filing of the 20th auxiliary request was a reaction to the course of events in the oral proceedings. Furthermore, although by admitting this request the Board would have to send the case back to the Opposition Division, it would have had to send it back anyway if any of the previous requests, filed in due time, had been considered to comply with Article 76(1) EPC, since the Opposition Division did not consider the issues of novelty and inventive step. Moreover, in deciding whether to admit or not the 20th auxiliary request, the Board should carefully weigh the interest of the parties. It was mainly the appellant who would be negatively affected by a remittal, as it did not have the patent maintained in the form it wished and had to continue to pay annual fees. Moreover, the auxiliary request was the last chance for the appellant to have its patent maintained. The respondent was in a better position, as it could still attack the patent before the national courts in case the patent was maintained. Accordingly, it would be unfair for the appellant not to admit the 20th auxiliary request because of its late filing.

XI. The arguments of the respondent can be summarized as follows:

There was no support in the earlier application as filed for leaving out the feature relating to the inclination of the axis of the hinge in claim 1 according to the main and first to eighth auxiliary requests. Nor was there support in the earlier application as filed for including the feature that the axis of the hinge was vertical, as recited by claim 1 according to the 9th auxiliary request. As regards the disclaimer in the description in accordance with the auxiliary requests 10 to 19, it did not overcome the objections in respect of claim 1 and moreover it was not allowable for the reasons given by the Opposition Division in respect of the fourth auxiliary request considered in the decision under appeal.

The 20th auxiliary request should not be admitted into the proceedings because its filing at a very late stage of the oral proceedings was not justified. In the written phase of the appeal proceedings and until the final phase of the oral proceedings the appellant chose not to file requests in which independent claim 1 included the feature relating to the inclination of the axis of the hinge. However, the objection based on the absence of this feature was known to the appellant since the very beginning of the opposition proceedings. The Opposition Division based its decision on this objection, and the Board issued a preliminary opinion confirming the view of the Opposition Division. The appellant was therefore well aware that the confirmation of the decision of the Opposition Division could be a possible outcome of the appeal proceedings.

The appellant however deliberately chose to contest this objection, rather than filing any request overcoming it, until the very last stage of the oral proceedings, after all previously filed requests were discussed and the Board pronounced a negative opinion. It was in the interest of the opponent and of legal certainty that the case be terminated quickly. Admitting the 20th auxiliary request would unduly delay a final decision, because it would raise a new issue of double patenting, as the independent claim of the patent granted on the earlier application was directed to the particular aspect of the axis of the hinge being inclined, and because the case would have to be remitted back to the Opposition Division.

## **Reasons for the Decision**

1. The appeal is admissible.
2. *Main request*
  - 2.1 The Board agrees with the reasoning of the Opposition Division (points 2.1.1 to points 2.1.3 of the decision under appeal; see point II of the present decision) for finding that there is no basis in the earlier application as filed (Article 100(c) and 76(1) EPC) for the combination of features recited in claim 1 in which no reference is made to the feature that the hinge is fastened to the cabinet in such a way that the rotation axis of the door is inclined with respect to the vertical axis of the machine so as to allow an opening motion of the door being at least partially autonomous, as in the single embodiment described in the earlier



application with reference to Figures 1-3. The Board's conclusion is based on this reasoning and further on the arguments set out hereinbelow.

- 2.1.1 The appellant's criticism of this reasoning is based on the facts that claim 13 of the earlier application as filed, on which is based claim 1 of the patent in suit, does not specify the arrangement of the hinge, and that it is well known in the art that the door hinges of front loading laundry washing and/or drying machines are generally located in line with the centre-line of the door and have a vertical axis of rotation.

Claim 1 of the patent in suit results from claim 13 of the earlier application as filed, amended by way of addition of the feature that the hinge has at least a point being positioned on a centre-line of the door, and the feature that none of said elements (i.e. the elements of the lock/release system located in the upper half of the door) has a point being positioned on said centre-line of the door. The combination of these features is disclosed only in the specific embodiment described in the earlier application (see the publication of the earlier application EP-A-728 861, col. 2, line 9 to col. 4, line 18 and Figs. 1 to 3). Though it is accepted that in conventional laundry washing and/or drying machines the door hinges are usually vertical and located in line with the centre-line of the door, in such conventional machines the elements of the lock/release system also normally have a point being positioned on the centre-line of the door (see par. [0004] of the patent in suit: "the handle and the hinge are always aligned ... in line with the centre-line of the door"). Accordingly, the prior art

cannot be regarded as a basis for introducing in claim 13 of the earlier application as filed the features added, and the only basis for this amendment is the particular embodiment disclosed. As stated in the annex to the summons to oral proceedings (points 2.3 and 2.4), in this particular embodiment a specific arrangement of the hinge is shown, namely an arrangement in which the hinge, and thus the rotation axis of the door, is inclined with respect to the vertical axis. By virtue of the absence of this particular arrangement of the hinge, an unallowable intermediate generalisation (see e.g. T 1408/04, point 1) is present in claim 1.

2.1.2 The appellant submitted that the issue of intermediate generalisation could be raised in cases where the features disclosed in combination in a specific embodiment were complexly interrelated, as might be the case in the chemical or pharmaceutical field, but not in the present case relating to a simple mechanical device, where the skilled person would understand that the features of the invention could be combined with features of the prior art.

However, the relevant question is not the complexity, but the degree of interrelationship between the features disclosed in combination. If it is clear for the skilled person that one feature is merely optional or at least not in close functional and structural relationship with the other features of a specific embodiment, then said feature may be extracted in isolation from the other features (see e.g. T 112/06, point 1.14). In the present case, however, it is clear that in the specific embodiment disclosed in the

earlier application as filed, the feature of the hinge having at least a point positioned on a centre-line of the door is in functional and structural relationship with the feature relating to the inclination of the hinge. Indeed both features contribute to the manner in which the door opens.

2.1.3 The appellant further submitted that it was clear that the feature according to which all the elements of the lock/release system were located in the upper half of the door constituted a technical teaching on its own, and the skilled person would associate it both with the conventional vertical hinge arrangement and the inclined hinge arrangement according to the specific embodiment. This submission is, however, at odds with the principles for assessing whether an amendment introduces subject-matter extending beyond the content of an (earlier) application as filed, which require a clear and unambiguous disclosure of the claimed subject-matter. Indeed, the association of the above-mentioned feature with the conventional vertical hinge arrangement is not disclosed as such and is also not necessarily implicit from the original disclosure. It might well be obvious, but then it is the result of the skilled person's own technical considerations.

2.2 The Board therefore sees no reason to deviate from the Opposition Division's conclusion in respect of the appellant's main request.

3. *First to fourth auxiliary request*

3.1 The Board also sees no reasons to deviate from the Opposition Division's conclusions in respect of the appellant's first to fourth auxiliary requests, according to which claim 1 of these requests contains added subject-matter over the earlier application as filed, contrary to the requirements of Article 76(1) EPC (see pages 6 to 10 of the decision under appeal, see point II of this decision).

3.2 As a matter of fact, claim 1 according to the first and fourth auxiliary requests includes the features of claim 1 as granted but still leaves out the feature relating to the inclination of the axis of the hinge.

3.3 In claim 1 according to the second and third auxiliary requests the feature according to which the hinge has at least a point being positioned on a centre-line of the door, while none of said elements has a point being positioned on said centre-line of the door, has been deleted.

In claim 1 according to the second auxiliary request it has been replaced by another feature, namely the feature that the machine has a mutually non aligned hinge and lock/release system, which has been extracted in isolation from the embodiment.

In claim 1 according to the third auxiliary request it has been replaced by the feature of granted claim 3, which however includes an inadmissible extension over the content of the application as filed due to the fact

that the earlier application as filed only discloses a "seat" as the "second component" mentioned in claim 1.

- 3.4 Furthermore, as already indicated in the annex to the summons for oral proceedings (points 3.1 and 3.2), the deletion of the above-mentioned feature in claim 1 according to the second and third auxiliary requests results in a broadening of the scope of protection, contrary to the requirements of Article 123(3) EPC.

4. *Fifth and sixth auxiliary requests*

As already indicated in the annex to the summons for oral proceedings (point 4), these requests fail to comply with the requirements of Article 123(3) EPC, because the deletion in claim 1 of the feature according to which the hinge has at least a point being positioned on a centre-line of the door, while none of said elements has a point being positioned on said centre-line of the door, results in a broadening of the scope of protection.

5. *Seventh and eighth auxiliary requests*

Claim 1 according to these requests includes the combination of features of granted claim 1 but still leaves out the feature relating to the inclination of the axis of the hinge. Accordingly, these requests fail to meet the requirements of Article 76(1) EPC for the same reasons as the main request.

6. *Ninth auxiliary request*

As explained above in respect of the main request, the features of claim 1 as granted are only disclosed, in the earlier application as filed, in combination with the feature that the axis of the hinge is inclined, i.e. that the rotation axis of the door is inclined. Since claim 1 according to the ninth auxiliary requests includes the feature that the rotation axis of the door is vertical, it contains subject-matter which extends beyond the content of the application as filed, contrary to the requirements of Article 76(1) EPC.

7. *Tenth to nineteenth auxiliary requests*

7.1 These requests were filed separately at a very late stage of the appeal proceedings, namely in the course of the debate during the oral proceedings after the Board expressed a negative opinion on the requests previously on file.

7.2 In considering the admissibility of these requests, the Board must apply the provisions of the Rules of Procedure of the Boards of Appeal ("RPBA"). Article 13(1) RPBA makes clear that the Board has a discretion to admit late-filed requests and that, in exercising that discretion, it must consider a range of factors including inter alia the need for procedural economy. In other words, late requests shall not be admitted if their admission would delay the proceedings. Such delay may, for example, be due to amendments which are not clearly allowable (see e.g. T 382/05, point 1.3 of the reasons).

7.3 In the present case, the auxiliary requests do not introduce further amendments of claim 1 as compared to the previous requests (claim 1 according to auxiliary requests 10 to 19 is identical to claim 1 according to the main and the first to ninth auxiliary requests, respectively) but only an amendment of the description. An amendment of the description is however not suitable for overcoming the above-mentioned objections in respect of claim 1. It is indeed the function of the claims to define the subject-matter which is to be protected in terms of its technical features (Article 84 and Rule 29(1) EPC). As stated in decision G 1/93 of the Enlarged Board of Appeal (see point 14 of the reasons), the EPC does not envisage or allow a statement to be included in the description of a particular patent, qualifying the rights which may be derived from the presence of a particular technical feature in a claim of that patent.

7.4 According to the appellant's submissions, the amendment consisting in introducing a disclaimer in the description was aimed at overcoming the inescapable trap caused by the conflicting requirements of Articles 123(2) and (3). As pointed out by the Enlarged Board of Appeal in decision G 1/93 (see point 4 of the reasons), an inescapable trap may arise in a situation where, before grant, there was added to a claim an undisclosed limiting, technically meaningful feature, which cannot be deleted or replaced by any other feature properly disclosed in the application as filed without extending the protection conferred by the patent as granted in contradiction to Article 123(3) EPC.

However, this situation does not arise in the present case. The features added to claim 1 before grant were disclosed in the earlier application as filed, however not in the general context of claim 1, but in the more specific context of the embodiment, in which the axis of the hinge is inclined. In order to overcome the objection under Article 76(1) EPC there is therefore no need to delete the added feature but rather to introduce further features in claim 1 for restricting its scope to match the original disclosure.

7.5 In view of the above negative conclusions regarding the criteria of allowability the Board decided not to admit into the proceedings the 10th to 19th auxiliary requests.

8. *Twentieth auxiliary request*

8.1 This request was filed separately at a further later stage of the oral proceedings, after discussing the 19th auxiliary request. Claim 1 of the 20th auxiliary request combines the features of claims 1 and 8 as granted. Claim 8 as granted includes the feature concerning the inclination of the rotation axis of the hinge, which absence in claim 1 was objected to in the opposition and opposition appeal proceedings in relation to the issue of Article 76(1) EPC.

8.2 In the written phase of the opposition and opposition appeal proceedings, the appellant had been given opportunities to file auxiliary requests overcoming this objection. With the annex to the summons to oral proceedings, posted on 22 January 2009, the Board issued a preliminary opinion specifically pointing out



to this objection. However, the appellant deliberately chose not to limit the claims to a machine in which the rotation axis of the door, or the axis of the hinge, was inclined. It filed, in reaction to the annex, further auxiliary requests (7th and 8th) in which claim 1 still was not so limited. During the oral proceedings before the Board, the appellant maintained this line by filing further auxiliary requests (auxiliary request 9, then auxiliary requests 10 to 19) addressing the same issue of Article 76(1) EPC, in which claim 1 was not limited to a machine in which the rotation axis of the door, or the axis of the hinge, was inclined (claim 1 according to auxiliary request 9 included the feature relating to the inclination of the axis of the door but was not restricted thereto as it also included the alternative that the axis was vertical). In fact, the appellant waited until it had heard the opinion of the Board in respect of all the previous requests before filing the auxiliary request 20 in which claim 1 was restricted to the feature relating to the inclination of the axis.

- 8.3 The appellant submitted that the late-filing of the request was justified by the fact that only during the discussion at the oral proceedings it became clear that the Board would not be convinced by its line of argument, according to which it was not necessary to include the feature relating to the inclination of the hinge in claim 1. However, at the latest on receipt of the annex containing the negative preliminary opinion of the Board, the appellant should have realized that it might possibly fail to convince the Board, and should have prepared a contingency position by filing an appropriate auxiliary request. In such case, it

would have been clear to the Board and to the respondent that it was the appellant's intention to depart from its previous line of argument if it would fail to convince the Board, so that the Board and the respondent could be prepared for the new situation.

- 8.4 The appellant further submitted that the filing of the 20th auxiliary request did not have any serious impact on the proceedings, in particular that no preparation in advance was required to deal with this request, because if the request would be admitted, then the Board would have to send the case back to the first instance, which it would have done anyway if it had accepted one of the previous requests, as the Opposition Division did not consider the other grounds of opposition of lack of novelty and inventive step.

However, pursuant to Article 111(1) EPC the decision to remit the case is a matter of discretion for the Board. In exercising its discretion, the Board must be in a position to assess whether it is appropriate or not to exercise any power within the competence of the Opposition Division. In the present case, although at the oral proceedings the Board could be expected to be in a position to assess whether it was appropriate or not to remit the case for considering novelty and/or inventive step of the request already on file, it could at least not be expected to be in a position to consider in its assessment the new issue of double-patenting raised by the respondent. In this respect it is noted that the appellant did not deny that claim 1 of the patent granted on the earlier application might be identical or at least substantially overlap claim 1 of the patent in suit.

8.5 Finally, the appellant submitted that the patentee was in a worse position as compared to the opponent, since the 20th auxiliary request was the last possibility of having the patent maintained, even if in a form which was not satisfactory for the patentee, whereas the opponent could still pursue an action for revocation before the national courts.

However, it cannot be objectively said that the appellant suddenly and/or surprisingly came in a situation in which the patent was at risk of being definitively revoked. In fact, the objection raised was well known to the appellant, and the latter actually had many opportunities for filing the 20th auxiliary request at an earlier stage of the proceedings but decided not to do so. In the view of the Board, a party to oral proceedings does not have a right to file an unlimited number of requests and particularly, the party should file any request at the earliest moment possible in the proceedings, i.e. not in a piecemeal fashion. In *inter partes* proceedings it is indeed necessary to balance the rights of the involved parties so that all of them are in equal position (see e.g. point 13 of the reasons of G 1/86). Generally, the admission of the patentee's late-filed new requests into the proceedings is in conflict with the right of the opponent to challenge the patent, where that party might not be prepared for this. In the present case, even though claim 1 results from the combination of granted claims which were attacked in the notice of opposition, the respondent could not be reasonably expected to deal with the 20th auxiliary request since the amendment of claim 1 went in a direction which the

appellant clearly showed never be willing to take during the appeal proceedings, but came up with for the first time at the very last phase of the oral proceedings.

8.6 For these reasons the Board exercised its discretion in accordance with Article 13(1) of the Rules of Procedure of the Boards of Appeal not to admit this late filed request.

9. Since none of the requests of the Appellant on file prevails, the decision under appeal cannot be set aside as requested by the Appellant.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau