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**Datasheet for the decision  
of 10 July 2012**

**Case Number:** T 1781/08 - 3.4.01  
**Application Number:** 99118160.3  
**Publication Number:** 962884  
**IPC:** G06K 19/077, H05K 5/02,  
B29C 65/08  
**Language of the proceedings:** EN

**Title of invention:**  
PCMCIA Standard memory card package

**Patentees:**  
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Dorf, Ken  
Weibezahn, Brandt  
Fajardo, Iggoni

**Opponent:**  
Dr. Joachim Hock

**Headword:**  
-

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

**Keyword:**  
"Added subject-matter (yes)"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 1781/08 - 3.4.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.01  
of 10 July 2012

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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
11 April 2008 concerning maintenance of  
European patent No. 962884 in amended form.

**Composition of the Board:**

**Chairman:** G. Assi  
**Members:** P. Fontenay  
M. J. Vogel

## **Summary of Facts and Submissions**

I. The appeal lies from the interlocutory decision of the opposition division to maintain European patent No. EP-B-0 962 884 in amended form according to an auxiliary request with claim 1 as filed by the patentees during the oral proceedings before the opposition division on 30 January 2008. The decision was announced during the oral proceedings and dispatched on 11 April 2008.

II. When deciding on the maintenance of the patent on the basis of the auxiliary request then pending, the opposition division held, contrary to the opponent's view, that claim 1 did not define added subject-matter (Article 123(2) EPC) and that its subject-matter was both new and inventive (Articles 54, 56 EPC 1973).

III. The appellant (opponent) filed an appeal against said decision by letter received on 27 May 2008. The prescribed appeal fee was paid on the following day.

In the statement setting out the grounds of appeal, filed on 14 August 2008, the appellant contested the findings of the opposition division with regard to the auxiliary request considered allowable and reiterated his objections under Articles 100(c) and 100(a) EPC that the subject-matter of claim 1 as maintained defined added subject-matter, was not new in view of document D1, or at least did not define an inventive contribution to the prior art. New documents in support of the appellant's view were filed. The appellant further contended that the subject-matter of claim 1 as maintained was not clearly defined (Article 84 EPC

1973) since essential features required for the definition of the invention were missing.

- IV. In their reply dated 21 January 2009, the respondents (patentees) requested that the appeal be rejected as inadmissible since, in their view, the appellant merely repeated arguments previously made without overcoming or challenging the validity of the decision under appeal. They further requested that the patent be maintained on the basis of the patent "*as amended*" during the opposition proceedings or, alternatively, on the basis of an auxiliary request enclosed to said letter of 21 January 2009. The respondents further objected to the introduction of the new documents into the appeal proceedings.
- V. With letters of 18 September 2009 and 7 February 2011 the appellant filed further new documents in reaction to the new auxiliary request filed by the respondents and presented arguments as to why, in his view, the subject-matter of claim 1 according to the auxiliary request was not inventive.
- VI. In a communication pursuant to Rule 84(1) EPC dated 24 February 2012, the Board informed the parties that it had become aware of the fact that the patent had lapsed in all the designated contracting states (GB, IT, FR, DE and NL) and that the appeal proceedings would be discontinued unless a request for continuation was filed within a delay of two months from notification of the communication.

By letter of 13 March 2012, the appellant requested continuation of the appeal proceedings.

VII. In a communication dated 10 April 2012 pursuant to Article 15(1) RPBA, the Board expressed its provisional opinion with regard to the requests on file. Concerning, more specifically, the ground of added subject-matter, the Board underlined that it was not convinced by the conclusion reached by the opposition division in section 7.1 of the "Reasons" of its decision according to which the feature of the extended fingers having free ends being embedded in the plastic frame elements was disclosed in the original application documents. It was observed, in this respect, that the passage of the original description referred to by the respondents (page 6, lines 23-26) did not establish that the free ends of the fingers constituted the sole parts of the fingers actually embedded in the plastic material. In the absence of any such indication, it was questionable whether a sufficient basis existed in the original disclosure for the added feature, as recited in claim 1 of both the main request and auxiliary request. With regard to the issues of novelty and inventive step, the Board raised some questions concerning the arguments put forward by the appellant.

VIII. Oral proceedings before the Board took place on 10 July 2012 in the sole presence of the appellant's representative. As had been previously announced in a letter of 11 April 2012, the respondents were not present and were also not represented.

IX. Claim 1 of the main request reads:

"1. A peripheral device package comprising:  
first and second plastic frame elements (16, 18) which  
are arranged to be joined together at their margins,  
each frame element having a respective metal cover (12,  
14) fixedly secured thereto, the frame elements forming  
respective integral units with the respective covers  
(12, 14), the covers (12, 14) being secured to their  
respective frame elements (16, 18) by extended fingers  
(26), the major outer surface of the metal cover (12,  
14) defining a plane of the metal cover, each plastic  
frame element (16, 18) extending beyond the plane of  
its respective metal cover (12, 14) so that a plastic  
perimeter surface is exposed, thereby facilitating the  
bonding of the two covers;

characterised in that the metal covers (12, 14)  
are stamped, in that the plastic frame elements (16,  
18) are injection moulded around a periphery of a  
respective metal cover (12, 14), and in that the free  
ends of the fingers (26) are embedded in the plastic  
frame elements (16, 18)."

Claims 2 to 11 of the main request are dependent on  
claim 1.

Claim 1 of the auxiliary request reads:

"1. A peripheral device package comprising:  
first and second plastic frame elements (16, 18) which  
are arranged to be joined together at their margins,  
each frame element having a respective metal cover (12,  
14) fixedly secured thereto, the frame elements forming  
respective integral units with the respective covers  
(12, 14), the covers (12, 14) being secured to their  
respective frame elements (16, 18) by extended fingers

*(26), the major outer surface of the metal cover (12, 14) defining a plane of the metal cover, each plastic frame element (16, 18) extending beyond the plane of its respective metal cover (12, 14) so that a plastic perimeter surface is exposed, thereby facilitating the bonding of the two covers;*

*characterised in that the metal covers (12, 14) are stamped, in that the plastic frame elements (16, 18) are injection moulded around a periphery of a respective metal cover (12, 14), in that the free ends of the fingers (26) are embedded in the plastic frame elements (16, 18), and in that the integral units are joined only by bonding plastic to plastic."*

Claims 2 to 9 of the auxiliary request are dependent claims.

## **Reasons for the Decision**

### *1. Applicable law*

This decision is issued after the entry into force of the EPC 2000 on 13 December 2007 whereas the application was filed before this date. Reference is thus made to the relevant transitional provisions for the amended and new provisions of the EPC, from which it may be derived which Articles and Rules of the EPC 1973 are still applicable to the present application and which Articles and Rules of the EPC 2000 are to apply. When Articles or Rules of the former version of the EPC are cited, their citations are followed by the indication "1973" (cf. EPC, Citation practice).



2. *Admissibility of the appeal*

The respondents requested that the appeal be rejected as being inadmissible.

Firstly, the Board notes that the argument according to which the appellant merely repeated arguments previously made does not reflect the actual facts of the case since, at least insofar as the issue of inventive step is concerned, new objections were raised. The fact that these new objections relied on new evidence filed with the statement of grounds does not affect this finding.

Secondly, contrary to the assumption made by the respondents, there is no absolute need for an appellant in appeal proceedings to change the argumentation previously put forward before the examining or opposition division. This approach may well be justified in cases where the appellant would consider, for example, that the flaws in the decision in suit are solely due to a wrong appreciation of the facts underlying the issues which had to be decided. In such cases, the appellant could merely seek, when filing an appeal, to have the relevant facts reassessed by the Board, while maintaining its initial appreciation of the situation.

The present notice of appeal and the corresponding statement of grounds therefore comply with the requirements of Articles 106 to 108 EPC and Rule 99 EPC. The appeal is thus admissible.

3. *Added subject-matter*

In this section, references to the original disclosure or original claims refer to the original version of the present application as filed on 13 September 1999. This application was later published under the publication number 0 962 884.

3.1 *Main request*

In the Board's judgement the feature according to which "*the free ends of the fingers (26) are embedded in the plastic frame elements (16, 18)*" is not disclosed in the original application in violation of the requirements of Article 123(2) EPC.

As put forward by the appellant, the original disclosure consistently refers to the fingers being embedded (cf. page 6, lines 20-22; page 7, lines 3-6; page 7, line 25 to page 8, line 2) without any emphasis put on any specific part of said fingers. Actually, the sole reference to "*the free ends of the fingers*" is to be found on page 6, lines 23-26, of the original application. The corresponding statement reads: "*The free ends of the fingers 26 may be provided with a non-linear shape to cause them to be more securely embedded in the plastic frame elements 16 & 18*". The Board, however, rejects the respondents' view according to which this statement would constitute a sufficient basis for the introduced feature in claim 1 of the main request. In this respect, it is observed, firstly, that this statement has to be construed in the light of the whole application and, more specifically, in the light of the whole paragraph to which it belongs, i.e. also

in view of the indication on page 6, lines 20-22, that "*The metal fingers 26 curl inward, and are encased in the plastic frame elements 16 & 18 during the molding process*". The teaching conveyed by the statement relied upon by the respondents appears thus to be limited to the fact that the embedding of the fingers in the frame elements might be further improved by providing the free ends with a non-linear shape. It does in no way imply that the sole aspect really essential when embedding the fingers in the frame element is to have said free ends embedded in the plastic frame elements independently of whether or not other finger portions are also embedded. For these reasons, the Board fails to identify any basis which could justify dissociating this specific aspect regarding the free ends of the fingers from the general teaching conveyed by the application as a whole according to which the fingers are embedded in the plastic frame elements.

Therefore, claim 1 of the main request contravenes Article 123(2) EPC.

### 3.2 *Auxiliary request*

Claim 1 of the auxiliary request essentially differs from claim 1 of the main request in that it contains at the end of the claim the additional feature according to which "*the integral units are joined only by bonding plastic to plastic*". This amendment does not affect the analysis made above under section 3.1 with regard to the main request, which therefore applies also to the subject-matter of claim 1 of the auxiliary request.

Claim 1 according to the auxiliary request thus contains subject-matter extending beyond the content of the original application contrary to Article 123(2) EPC.

4. In conclusion, the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent. Under these circumstances, there is no need to assess the other ground under Article 100(a) EPC invoked by the appellant.

## **Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

R. Schumacher

G. Assi