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**Datasheet for the decision
of 24 November 2010**

Case Number: T 0689/09 - 3.2.04

Application Number: 01939305.7

Publication Number: 1313986

IPC: A47G 19/22

Language of the proceedings: EN

Title of invention:

Illuminatable beverage accessory device

Patentee:

Vanderschuit, Carl R.

Opponent:

Out of the Blue KG

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)(3), 100(c)

RPBA Art. 16(1)

EPC R. 99(1)(c)

Relevant legal provisions (EPC 1973):

EPC R. 64(b)

Keyword:

"Admissibility of the appeal - subject of the appeal (yes)"

"Amendments - added subject-matter (yes)"

"Amendments - extension of protection (yes)"

"Apportionment of costs (no)"

Decisions cited:

G 0009/92, G 0004/93, G 0001/99, T 0331/87, T 1108/08,

T 0358/08, T 0420/03, T 1382/08, J 0027/86, T 0407/02



Case Number: T 0689/09 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 24 November 2010

Appellant:
(Patent Proprietor)

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 29 January 2009
revoking European patent No. 1313986 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: A. de Vries
Members: M. Poock
T. Bokor

Summary of Facts and Submissions

I. On 25 March 2009 the Appellant (Proprietor) lodged an appeal against the Opposition Division's decision of 29 January 2009 to revoke European patent No. 1 313 986 and simultaneously paid the prescribed appeal fee. The grounds of appeal were filed on 29 May 2009.

Opposition was filed against the patent as a whole and based among others on the ground of added subject-matter.

The Opposition Division held that this ground prejudiced maintenance of the patent.

II. The notice of appeal against this decision was worded as follows:

"The Patent Proprietor ...hereby gives Notice of Appeal against the Decision of the Opposition Division dated 21 January 2009 revoking the European Patent EP-B-1323986.

A supporting Statement of Grounds of Appeal will be filed within the terms set out in Article 108EPC. [sic]"

III. The Appellant requests that the decision under appeal be set aside, and the patent be maintained on the basis of the main request filed with letter of 21 October 2010, or, in the alternative, on the basis of any of auxiliary requests 1 to 3 filed during the oral proceedings before the Board.

The Respondent requests that the appeal be rejected as inadmissible, and if it is admitted that it be

dismissed. He also requests apportionment of costs and that the case not be remitted to the first instance.

IV. Oral proceedings before the Board were duly held on 24 November 2010.

V. The wording of claim 1 of the requests is as follows:

Main request

"An illuminatable beverage accessory device (10) adapted to be placed into a beverage receptacle containing a liquid, comprising:

at least one light source (35);

a housing (11);

a cartridge (12) disposed within and fixedly sealed to the housing (11) so as to create a water-tight integrity, the cartridge defining thereunder a light-source chamber (25) and a power-source chamber (21), the light-source chamber receiving the light source (35) therein, the power-source chamber receiving a power source (41) therein;

a push button switching device (63) for switchably connecting the light source to the power source; and

a cavity within the housing and above the cartridge;

the light source, when connected to the power source, illuminating at least a portion of a liquid within a beverage receptacle when the illuminatable beverage accessory device is placed in the liquid."

Auxiliary Request 1

"An illuminatable beverage accessory device (10) adapted to be placed into a beverage receptacle containing a liquid, comprising:

at least one light source (35);

a housing (11);

a lid (14) secured to the housing so as to create a watertight integrity;

a cartridge (12) disposed within the housing, the cartridge having a light-source chamber (25) and a power-source chamber (21), the light-source chamber receiving the light source (35) therein, the power-source chamber receiving a power source (41) therein;

a push button switching device (63) for switchably connecting the light source to the power source; and

a cavity within the housing and above the cartridge;

the light source, when connected to the power source, illuminating at least a portion of a liquid within a beverage receptacle when the illuminatable beverage accessory device is placed in the liquid."

Auxiliary Request 2

"An illuminatable beverage accessory device (10) adapted to be placed into a beverage receptacle containing a liquid, comprising:

at least one light source (35);

a housing (11);

a cartridge (12) disposed within the housing, the cartridge having a light-source chamber (25) and a power-source chamber (21), the light-source chamber

receiving the light source (35) therein, the power-source chamber receiving a power source (41) therein;

a lid adjacent to said cartridge, said lid having a lid chamber mating with said power-source chamber to thereby contain said power-source therein; the housing, the lid and the cartridge being fixedly sealed to create a water-tight integrity;

a push button switching device (63) for switchably connecting the light source to the power source; and

a cavity within the housing and above the cartridge;

the light source, when connected to the power source, illuminating at least a portion of a liquid within a beverage receptacle when the illuminatable beverage accessory device is placed in the liquid."

Auxiliary Request 3

Claim 1 is as in auxiliary request 2 but for the features of the lid and the push button which have been replaced by the following feature:

"a lid adjacent to said cartridge, said lid having a lid chamber mating with said power-source chamber to thereby contain said power-source therein and further having a push button switching device for switchably connecting the light source to the power source, the housing, the lid and the cartridge being fixedly sealed to create a water-tight integrity;".

VI. The Appellant argued as follows:

An appeal filed against a decision to revoke based on only one ground can relate only to that single point. There can be no uncertainty for any party what aspects

of the decision are being challenged. The appeal is therefore admissible.

The invention merely requires some sort of closure to ensure water tightness. These need not be a lid. The originally filed description, see page 4, allows for embodiments without a separate lid, which is unitary with the cartridge. The cartridge could then itself form the closure element. In the light of the description the skilled person would recognize that a separate lid is not essential and would in fact read a lid as implicit in claim 1 (main request).

Nor is there any difference in scope between the formulation of a cartridge "defining thereunder" and "having" chambers. If anything the term "thereunder" is unclear, depending as it does on the orientation of the device in use, and cannot for this reason have a limiting effect. In any case, changing back to the original formulation with "having" (as in claim 1 of the auxiliary requests) does not result in a broadening of scope.

The appellant has not compromised procedural efficiency. Effectively, after the cancellation of his initial request for oral proceedings, the parties were in a situation as if the proprietor had never made the request, so the opponent did not suffer any inequitable disadvantage.

VII. The Respondent argued as follows:

The Appellant has failed to file a request defining the subject of the appeal within the relevant time limit. This initial request is an essential requirement as it determines the scope of the appeal and restricts the extent to which an appellant may alter requests in the course of the procedure. For this reason failure to state this initial request in the notice of appeal as required by Rule 99(1)(c) EPC should be strictly sanctioned as expressly provided for by Rule 101(1) EPC. Had the legislator desired less strict consequences, it would have had resorted to those by assigning Rule 99(1)(c) to Rule 101(2) EPC. Rule 99(1)(c) EPC cannot be emptied through an overly lax interpretation of its provisions. The existing case law, which in case of a notice of appeal being silent on this issue automatically assumes that the impugned decision is appealed as a whole, and thus recognises such appeals as admissible, is untenable. Such a practice treats a negligent party better than a diligent party which possibly have made some statements on the subject of the appeal and thus restricted its own procedural possibilities, not being able to challenge those legal issues which were decided on but not having been identified as the subject of the appeal, this latter fact being implied by the mentioning of some other legal issues as forming the subject of the appeal. It is also irrelevant if the appeal request becomes clear in light of the impugned decision, because the notice of appeal itself should define the subject of the appeal sufficiently completely.

The purpose of this rule is also illustrated by the present case. The exact subject of the appeal remains unclear also in the light of the appellant's requests filed with the grounds of appeal. On the one hand he requests maintenance of the patent, on the other however remittal, arguing only the one ground of added subject-matter, but not the other opposition grounds raised.

As to the substantive deficiencies of the claims, Claim 1 of the main request omits original features d) and e). Both the lid and the water tight sealing are however consistently presented as functionally essential in the filed application. The lid serves to seal the inside of the housing and the chambers defined between it and the adjacent cartridge. Together with the cartridge it forms a functional unit, defining the chamber which receives power and light sources. The application does not describe or suggest embodiments without such a lid.

The formulation cartridge "defining thereunder" chambers relaxes requirements with respect to the original cartridge "having" chambers. In all embodiments the design of the cartridge recognizably defines shape and function of the chambers. With the present formulation a simple, plate like cartridge need only define the upper limit of a chamber below it. Such an embodiment was never disclosed.

Nevertheless, the indication "thereunder" does introduce a limitation on the relative location of the chambers, and by inference, the lid within the device. By changing back to the original formulation of

"having", this requirement is lost, and the extent of protection broadened.

As to apportionment, the appellant's course of action unnecessarily prolonged the procedure, adding to cost and legal uncertainty. The appeal is merely being used by the appellant to make up for his failure to use the opportunities offered at first instance to address the various outstanding objections raised. The appellant ought to have been perfectly aware of the fact that none of his requests will succeed, after having learned that the Opposition Division cancelled the oral proceeding. This being a telltale sign of an imminent revocation of the patent, the appellant proprietor ought to have tried to file further auxiliary requests at that stage i.e. before the first instance, instead of only doing so in the present appeal proceedings.

Reasons for the Decision

1. *Admissibility of the Appeal*

- 1.1 According to Rule 99(1)(c) EPC 2000, which applies in the present case, the notice of appeal shall contain "a request defining the *subject* of the appeal" (emphasis added by the Board). This requirement pertains to one of the main functions of the notice of appeal in defining an appellant's initial request, see the explanatory remarks for Rule 99 in the Special Edition 5 of the Official Journal 2007: "Revision of the European Patent Convention (EPC 2000), Synoptic presentation EPC 1973/2000 - Part II: The Implementing Regulations": "[the] requirement of Rule 99(1)(c) EPC

2000 takes into account that the appellant's initial request - according to the case law of the Enlarged Board of Appeal (see G 9/92 and G 4/93, OJ EPO 1994, 875, and G 1/99, OJ EPO 2001, 381) - defines the subject of the appeal and thereby the framework of appeal proceedings."

- 1.2 Rule 99(1)(c) EPC 2000 revises corresponding Rule 64(b) EPC 1973, according to which the notice was required to include "a statement identifying ... the extent to which amendment or cancellation of the decision is requested" (emphasis added). The above-mentioned explanatory remarks state that that requirement has been moved to Rule 99(2) EPC 2000 which defines the statutory contents of the statement of the grounds of appeal. This revision makes allowance, as expressly stated in the explanatory remarks, for the case "where the appellant is the patent proprietor [and] the amended claims are ... filed with the statement of the grounds for appeal ... [I]t is only then that the precise nature of the requested amendment of the decision impugned becomes apparent".

That situation applies to the present case as is clear from the opening paragraph of the notice of appeal: It is the proprietor who gives notice against the decision to revoke his patent, see point II above. In view of the explanatory remarks to Rule 99(1)(c) and (2), the notice of appeal need not indicate the precise nature of the amendment of the decision to be included in the statement of the grounds of the appeal, i.e. it is sufficient that the claims now being pursued by the appellant proprietor are only put forward in the statement of the grounds of appeal, as indisputably

happened in the present case as well. Insofar the revised rules confirm the existing practice.

- 1.3 What then does Rule 99(1)(c) require the notice of appeal to state in the present case? The explanatory remarks give the following general guidance (in addition to that cited above in point 1.1): "As a rule, the notice of appeal should already clarify whether the decision under appeal is contested as a whole or only partially, and define the extent of the issues raised in the appeal proceedings".
- 1.4 The interpretation of "subject of the appeal" as used in Rule 99(1)(c) has been addressed by previous decisions. Decision T 1108/08 of 11 May 2009, without detailed reasoning, simply equates it with the requirement of identifying the extent to which cancellation of the [impugned] decision is requested (see point 1 of the Reasons). Given the wording of Rule 99(2) EPC referring to the "extent to which [the impugned decision] is to be amended", it has to be presumed that the deciding Board of T 1108/08 did perceive a difference between the "amendment" and the "cancellation" of a decision and realised that only the "extent of the amendment" requirement had been moved from Rule 64(b) EPC 1973 to Rule 99(2) EPC. It may have inferred from the explanatory notes, see point 1.3 above, that the "subject of the appeal" still encompasses the "extent of cancellation" requirement. This latter conjecture is somewhat tentative as the explanatory notes - apart from not being legal provisions themselves - use a different formulation, "extent of issues", which may refer to a separate, additional or alternative, requirement, but could be

synonymous with the "whole or partial" contesting of the impugned decision.

1.5 The question is further analysed in great detail by decision T 358/08 of 9 July 2009. There the deciding Board established that the Implementing Regulations themselves or the supplementary means of interpretation, such as the "Travaux Préparatoires" to Rule 99 EPC provides little information as to the exact meaning of the term "subject of the appeal", apart from the fact that no significant changes were intended by the legislator to the existing practice. On the contrary, the changes merely reflect and thus confirm the development of the case law, in particular the possibility to defer the filing of new claims forming the basis of the appeal to the grounds of appeal (see points 1-5 of the Reasons, in particular point 5: "the Board concludes that the change in the wording in the Implementing Regulations has not altered the previous law as to the requirements of either the notice of appeal or the statement of grounds of appeal as regards the nature of the appellant's requests."

1.6 This latter statement of the deciding Board of T 358/08, taken together with its finding that even the provisions of the previous Rule 64 EPC 1973 concerning the required extent of cancellation/amendment were "somewhat toothless" (see point 2.4 of the Reasons) results in the finding that an appeal statement worded "we hereby appeal against the decision of the Opposition Division...we ask that the decision ...be set aside and the patent maintained" is to be treated as a request defining "the subject of the appeal", see point 5.1 of the Reasons. Otherwise, the deciding Board

of T 358/08 declined to give a positive definition, stating that "it is not necessary for the Board to say precisely what it does mean", see point 4.12 of the Reasons. Nevertheless, the Board found that a possible interpretation of Rules 99(1)(c) and (2) EPC for the purposes of a practicable system should be made with an eye to the usual forms of orders made in appeal decisions, in the sense that the notice of appeal need only imply the *first* part of the order as desired by the Appellant, namely the setting aside of the impugned decision. The next part of the order that, in the Appellant's view, should replace the order of the first instance (here the form in which the patent is to be maintained) may then appear in the grounds at the latest.

- 1.7 The preparatory materials point to certain decisions of the Enlarged Board as explanation for the requirement of identifying the "subject of the appeal". These decisions base their *ratio decidendi* on the generally recognised procedural principle of party disposition (Antragsgrundsatz, *ne ultra petita*) governing the appeal proceedings under the EPC, see G 9/92, point 1 of the reasons. Taking the explanatory notes to the revised rules at their face value, it appears legitimate to consider Rule 99(1)(c) to be an expression of this principle. As such, it is not a requirement of form but of substance. It does not matter in what form the subject of the appeal is identified, as long as it is clear. The meaning of this principle is that the appeal can not extend to issues that the appellant himself did not wish to be a subject of the appeal, nor can the extent of the rights be decided beyond the extent requested. On this basis,

this Board interprets the "subject of the appeal" (Beschwerdegegenstand, l'objet du recours) to pertain to the substantive legal effects in general that are sought to be eliminated or achieved through the appeal (and essentially corresponding to the legal effects achieved by the impugned decision), keeping in mind that the "extent" of these legal effects need only be specified later. Thus the notice of appeal must assist in identifying those legal issues which may be treated and decided on during the appeal proceedings. In the Board's view it suffices if the Board and any other party can deduce in some way from the information in the notice of appeal what general legal effects are sought to be achieved by the appeal, including further by implication, if necessary, those legal effects which are necessary for achieving the desired legal effects.

1.8 This interpretation is also consistent with the possibility that an impugned decision is only partially contested or the extent of the issues raised in the appeal is limited when compared to the legal effects of the impugned decision, for example where the decision has several independent legal effects, see decisions J 27/86 and T 420/03. The board notes that it is also aware of case law, according to which the distinction between different legal effects of a decision also falls under the "extent to which the impugned decision is to be amended" pursuant to Rule 99(2) EPC, see T 1382/08 of 20 March 2009, point 8 of the Reasons. However, this approach leaves the notion of the "subject of the appeal" even more diffuse and elusive.

1.9 The general legal effect of the decision under appeal is to revoke the patent. The effect of revocation can

be inferred from Article 68 EPC: the application or patent is deemed not to have had - from the outset, *ab initio* - any of the rights conferred under Articles 64 and 67 (to the extent it has been revoked). The Board notes that even though Article 68 leaves room for the interpretation that the legal term "revocation" can also mean a partial loss of rights, i.e. encompass the maintenance in an amended form, in the overwhelming majority of the patent profession "revocation" is used exclusively to indicate full revocation, i.e. a complete loss of substantive patent rights. Thus the words "decision to revoke the patent" in the notice of appeal is also understood in this sense by the Board.

- 1.10 As noted above, the proprietor does not need to indicate in the notice of appeal the extent to which the impugned decision is to be amended, since this "extent" is to be defined through the scope of the claims being pursued on appeal. Thus the "subject" of the appeal need only relate to a more general legal effect than the specific legal effects of a grant of a patent, being specific in the sense that the specific scope of protection - i.e. its "extent" in the sense of Rule 99(2) EPC - is defined by the claims. This leaves us with the notion that the subject of an appeal may be the general legal effect of grant, or as its legal counterpart, a revocation. However, staying on this general level of legal effects, the only conceivable **general** relief sought against the single and indivisible legal effect of the revocation is that the deemed loss of rights does **not** take effect, i.e. all the substantive rights residing in the patent as granted do persist as if nothing had happened. From this follows that a statement of the proprietor that he

wishes rights to persist, that is cancellation of the decision and its legal effect, should suffice.

1.11 Nor need the proprietor expressly state that he seeks cancellation. This is implied in an appeal, given that cancellation is the *only* possible relief available to a proprietor appealing against a decision to revoke. Accordingly, in the present case, the mere statement that the "decision ... revoking ...the patent" is appealed is enough to make clear to the Board and any other party that the appeal concerns at least the cancellation of the revocation. This is clear from the notice of appeal, even without perusing the decision under appeal or other documents of the file. For this reason the Board concludes that the notice of appeal meets the requirements of Rule 99(1)(c) EPC 2000. See also T 407/02 of 12 November 2003, deciding that in case of revocation the declaration of appealing the impugned decision must be treated as a request for the cancellation of the decision in its entirety, see point 1.1 of the Reasons (on the basis of Rule 64(b) EPC 1973).

1.12 In light of the above, the Board is satisfied that the subject of the appeal has been properly identified, so that the appeal goes beyond an empty statement of appeal against some undefined legal effect. Insofar the Board need not address the possible consequences of the wording of Rule 99 on existing case law, nor the question whether it is permissible to identify the subject of the appeal for the purposes of Rule 101(1) EPC in light of the decision under appeal. That said, the Board concurs with the findings of T 358/08, i.e. that it is not apparent that the legislator would have

intended any significant change to the developed procedural requirements of appeal. Though the Board in principle agrees with the Respondent that in theory, a more strict practice could also be justified by the wording of the applicable rules, it does not see the need to depart from the established, admittedly appellant-friendly approach with respect to the admissibility of the appeals.

1.13 As all other requirements of Article 108 and Rule 99 are met the Board finds that the appeal is admissible.

2. *Main Request, Auxiliary Requests 1,2 : Added Subject-Matter*

2.1 The patent concerns a novelty item in the form of an illuminatable beverage accessory device, for example in the form of an ice cube, that can be placed in a drink and which comprises a light source powered by a switchable power source provided in respective chambers in a cartridge within a housing sealed by a lid.

2.2 Claim 1 as originally filed included the following features d) and e) defining the lid and sealing respectively:

"d. a lid adjacent to said cartridge, said lid having a lid chamber mating with said power-source chamber to thereby contain said power-source therein and further having a power-switching means for powering said at least one light source into and from on-light mode into and from an off-light mode; and

e. a housing covering said cartridge and said lid such that water-tight integrity is maintained therein."

- 2.3 Claim 1 of the *main request* includes no mention of a lid or associated features, while sealing integrity is mentioned only between cartridge and housing. These features have thus been omitted with respect to the filed claim 1.
- 2.3.1 According to established case law, see e.g. T 331/87 (OJ EPO 1991, 22) omission of features from an independent claim may be justified if the skilled person would directly and unambiguously recognise that an omitted feature was not explained as essential in the disclosure; that it was not, as such, indispensable for the function of the invention in the light of the technical problem; and that the replacement or removal required no real modification of other features to compensate for the change.
- 2.3.2 There is no suggestion anywhere in the application as filed that the lid can be dispensed with. The brief summary of the invention on page 2 of the filed description expressly recites the feature, see lines 25 to 29 : "a lid is secured to the housing in a water tight fashion ...". The immediately following paragraph on page 3 goes on to state that the "foregoing has outlined the more pertinent and important features of the present invention", thus emphasizing the significance of these features - including the lid - for the invention.

The two main embodiments detailed on pages 4 to 13 in reference to figures 1 to 5 and 6 to 10 both also include a lid, shown at 14 adjacent cartridge 12 and including a chamber 45 which, see figures 1 and 6,

mates with chamber 21 in cartridge 45 to accommodate a power source 41.

As filed description page 4, lines 20 to 29, does allow for a fixed and removable attachment of the lid and cartridge among others, in the context of a water-tight sealing between the various parts. However, the lid, whether fixed or not, remains present as a separate structural element in each of these variants.

2.3.3 That the lid is consistently mentioned in claims and description is because it performs important functions in the device. Firstly, it cooperates with the cartridge to define the chamber accommodating the power source, see claim 1, feature d). Moreover it provides a water-tight seal in cooperation with the housing and cartridge as detailed on page 4, lines 20 to 29, cited previously, and feature e). Clearly, the device will not function as foreseen without the lid unless the accommodation of the power source and the sealing is modified.

2.3.4 In the light of the above the Board concludes that the lid is not only consistently presented as essential to the invention, but it also plays an essential role in its successful performance, to the extent that its omission would require significant modifications. None of the criteria that might justify omission are thus met: omission of this feature thus adds subject-matter that extends beyond the original disclosure, Articles 100(c) and 123(2) EPC.

2.3.5 The Board adds that a reading of the lid feature as *implicit* in claim 1 would conflict with the central

role of the claims in defining the invention, Article 84 EPC. An independent claim such as claim 1 must do so by stating its essential features, Rule 43(3) EPC. Broadly speaking, "essential" may be taken to mean those features that are given special prominence over others because they capture the inventive idea. The lid feature was given such prominence originally. By its omission the skilled reader is presented with a new definition, and perforce a new invention, for which there is no basis in the original disclosure.

2.4 The *auxiliary requests 1 and 2* only incrementally reinstate the lid and associated features. Both now mention a lid, but claim 1 of *auxiliary request 1* for example fails to mention, as originally claimed, that the lid is adjacent the cartridge and has a lid chamber mating with the power-source chamber therein, or that the housing also covers the lid to maintain water-tight integrity.

These features are added to claim 1 of the *auxiliary request 2* but this version (in common with claim 1 of the main and first auxiliary request) still presents its push-button switch device as separate of the lid. In originally filed claim 1 this feature appeared (in modified form) as part of the lid ("said lid ... further having a power-switching means"). In both main embodiments, in particular that of figures 6 to 7 to which claim 1 is now limited, the switch 63 is provided in the lid adjacent the membrane like bottom 67 of the lid chamber 45, see also as filed description page 12, lines 4 to 8. That the switch might be located otherwise is not evident from the original disclosure.

The amendments to claim 1 of the auxiliary requests 1 and 2 thus also add subject-matter extending beyond the original disclosure, Articles 100(c) and 123(2) EPC.

2.5 Additionally, claim 1 of the *main request* has the cartridge "defining thereunder" light-source and power-source chambers. Original claim 1 used the formulation: "a cartridge *having* a light-source ... [and] a power source chamber" (emphasis added). The Board finds the two formulations not to be synonymous. The latter identifies the two chambers as definitive features of the cartridge, implying that the chambers are substantially contained within the cartridge. As the example of a cartridge as a wall-like partition separating the space within the housing into compartments on either side shows, the modified formulation partially relaxes and partially adds to the original requirement: the chambers need no longer be formed *within* and as part of the cartridge, but simply *underneath* it. Such embodiments are not apparent in the original application documents, so that this amendment also adds subject-matter extending beyond the original disclosure, Articles 100(c) and 123(2) EPC.

3. *Auxiliary Requests 1 to 3 : Extension of scope*

In claim 1 of each auxiliary requests 1 to 3 the original formulation "the cartridge having [chambers]" is reinstated to replace "the cartridge defining thereunder [chambers]", see section 2.5 above. Though this reintroduces the requirement of the originally filed claim 1 that the chambers be formed substantially within the cartridge, it now drops the requirement added to granted claim 1 as to the location of the

chambers *underneath* the cartridge. The Board can envisage technically feasible embodiments that were previously not covered by granted claim 1 but which now fall within the scope of claim 1 according to any of these requests. These include any configuration in which, say, the light chamber lies within the cartridge but not underneath it, that is because it is entirely contained in it or opens out upwardly towards the cavity above the housing. The Board adds that the term "underneath" does have technical meaning within the context of the claim, which implies a given order of housing, cartridge and lid. In context it refers to chambers opening out on the side of the cartridge towards the lid, opposite to the side directed towards the cavity "above" the cartridge. A notional "upper" and "lower" part of the claimed novelty device is also implied through its general purpose and construction. A skilled person (or even a layman) would not seriously consider using it upside down, because the switch would be visible and would destroy the desired aesthetic appearance of the device.

As amended claim 1 of auxiliary requests 1 to 3 now includes embodiments not previously covered by the granted claim the protection conferred by it has been extended contrary to Article 123(3) EPC.

4. *Conclusion*

As the amendments to claim 1 of the main and auxiliary requests 1 and 2 do not meet the requirements of Article 100(c) and 123(2) EPC, and those to claim 1 of auxiliary requests 1 to 3 do not meet the requirement of Article 123(3) these requests must fail. The Board

therefore confirms the appealed decision to revoke the patent.

5. *Apportionment of costs*

5.1 Under Article 16(1) of the Rules of Procedure of the Boards of Appeal of the EPO the Board is given discretion, subject to Article 104(1) EPC, to order a different apportionment of costs. The overriding consideration as expressed in Article 104(1) EPC is that such an apportionment should be for reasons of equity. This is generally understood as meaning that if a party does not show due care in its conduct and this gives rise to unnecessary costs for the other party, then the principle of fairness requires that the culpable party should bear those costs incurred by the other party, see for example the Case Law of the Boards of Appeal of the EPO, VII.C.7.2 and the decisions cited therein.

5.2 The Respondent claims that the Appellant, by withdrawing during opposition his request for oral proceedings, subsequently cancelled, did not avail himself of a first instance opportunity to address all issues and has so unnecessarily prolonged the procedure.

5.3 The Board is unable to see herein any culpable behaviour on the part of the Appellant. Firstly, his timely withdrawal of the request meant that costs incurred if opposition oral proceedings had taken place were avoided. Secondly, that the opposition division in its decision then considered only added subject-matter and not the other grounds raised can hardly be blamed on the Appellant. Though it is desirable for overall

procedural efficiency to decide a case comprehensively, the division is within its rights to revoke only on one ground as Article 101(2) EPC requires "at least one ground" for revocation.

- 5.4 Thirdly, exploiting the right to appeal can normally not be considered as an abuse of procedure. The fact that an appeal prolongs the procedure and causes additional costs to the opposing party is an unfortunate, but inevitable consequence, which cannot be considered as an undue burden and therefore must be accepted in the proceedings before the EPO. No party should be coerced through the threat of apportionment of costs into waiving its right to appeal, this being a fundamental right in the legal system of the EPC, just like in all contracting states. This is not changed by the fact that the proprietor in the present case could have known in advance that he will not prevail before the first instance. A proprietor can not be obliged to file amended claims so as to achieve an allowable claim set, simply because a theoretical possibility to file further requests may have existed. All the less so, because even if the proprietor may have known the outcome of the first instance proceedings, he could not have had known the exact reasons before receiving the written decision, and therefore could not have been expected to respond on these, neither with auxiliary requests nor with counterarguments.

5.5 The Board concludes that it is not equitable to order a different apportionment of costs.

6. As the Board confirms the appealed decision to revoke it need not consider the question of remittal.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for apportionment of costs is refused.

The Registrar

The Chairman

G. Magouliotis

A. de Vries