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Datasheet for the decision of 3 April 2013

Case Number: T 1395/09 - 3.2.07

Application Number: 04712604.0

Publication Number: 1597030

IPC: B26B 21/40, B26B 19/38

Language of the proceedings: EN

Title of invention:
Safety razors

Patent Proprietor:
The Gillette Company

Opponent:
Eveready Battery Company, Inc.

Headword:
-

Relevant legal provisions:
EPC Art. 56, 83, 84

Keyword:
"Admissibility of amendments made in claim 1 of the main request: clarity - no"
"Admissibility of claim 1 of the first auxiliary request - yes"
"Inventive step - yes"

Decisions cited:
G 0009/91, G 0001/99, T 0227/88, T 0472/88, T 0922/94

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1395/09 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 3 April 2013

Appellant: (Opponent)
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Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office posted 20 April 2009 concerning maintenance of the European patent No. 1597030 in amended form.

Composition of the Board:

Chairman: H. Meinders
Members: H. Hahn
E. Kossonakou

Summary of Facts and Submissions

I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division to maintain the European patent 1 597 030 in amended form on the basis of auxiliary request 3 filed at the oral proceedings of 1 April 2009.

II. Claim 1 as maintained - now corresponding to the main request - reads as follows (amendments as compared to claim 1 as granted are in bold with deletions in brackets, emphasis added by the Board):

"1. A safety razor comprising a blade unit (2) having at least one blade (4) with a sharp cutting edge, a handle (1) on which the blade unit is carried, an electrical device (24,26), and a control device (16) for controlling operation of the electrical device, **[characterized in that]** the control device (16) **[is]** being responsive to a water detecting arrangement whereby the electrical device is actuated **for cleaning the blade unit** when a person using the razor immerses the blade unit (2) into a body of water **[for cleaning the blade unit], the water detecting arrangement comprising a pair of electrodes, at least one of which is provided on the blade unit, characterized in that the electrodes are spaced apart from each other so that, in normal use of the razor, the electrodes will not be bridged by shaving foam collected on the blade unit in the course of shaving.**"

III. The following documents cited in the impugned decision are relevant for the present decision:

D12 = DE-U-90 05 626
D13 = FR-A-2 726 925
D17 = US-A-2 256 871.

IV. An opposition had been filed against the patent in its entirety under Article 100(a) EPC, for lack of novelty and inventive step, and under Article 100(b) EPC, that the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by the person skilled in the art. During the course of the opposition procedure also objections under Article 100(c) EPC were raised for extending beyond the content of the application as originally filed.

The Opposition Division held that the patent as granted according to the main request complies with Articles 100(b) and 83 EPC but that the subject-matter of claim 1 lacks novelty over the disclosure of D12. The same conclusion of lack of novelty with respect to D12 held true with respect to claim 1 of the auxiliary requests 1 and 2. Claim 1 of auxiliary request 3 filed at the oral proceedings before the Opposition Division was considered to meet the requirements of Articles 123(2) and (3) EPC and of Articles 100(b) and 83 EPC. The Opposition Division further considered that the subject-matter of this claim 1 is novel with respect to the prior art and involves inventive step over the closest prior art D12 even when combined with the teaching of D13, or when combined the other way round. Consequently, the patent was maintained in that amended form.

V. With a communication annexed to the summons to oral proceedings the Board presented its preliminary opinion

with respect to claims 1-22 of the patent as maintained, (now according to the main request in appeal), claims 1-20 of the first auxiliary request, claims 1-19 of the second auxiliary request and claims 1-19 of the third auxiliary request, all as filed with letter of 12 January 2010, in response to the statement of grounds of appeal.

The Board remarked amongst others with respect to Article 84 EPC that - since the feature of claim 1 of the main request concerning the spacing of the pair of electrodes etc. was taken from the description of the patent in suit - the issue of clarity of the wording of claim 1 of the patent as maintained has to be examined. The Board then concluded that this claim appeared **not** to comply with Article 84 EPC but appeared to comply with Articles 123(2) and (3) EPC.

The Board further remarked that, as the respondent (patent proprietor) itself had not filed an appeal, the question first arose whether the principle of avoiding *reformatio in peius* for the appellant goes against the amendments now carried out in the claims 1 of the auxiliary requests. In all these claims the characterising portion of claim 1 as maintained (main request) was missing. This appeared to lead to *reformatio in peius* for the appellant. The question whether the clarity problem may be resolved by the auxiliary requests was to be examined following the principles of G 1/99 (OJ EPO 2001, 381).

The Board further remarked that the claims 1 of all requests appeared to comply with Article 83 EPC.

With respect to the issue of inventive step the Board remarked amongst other that the respondent's arguments with respect to inventive step and the cited documents appeared to be more convincing than the arguments of the appellant, which appeared to be based on an *ex-post facto* analysis.

The issue of inventive step would be dealt with by taking into consideration the problem-solution approach. Starting from the uncontested closest prior art D12 and taking account of the problem to be solved - which would be based on the technical effect of the distinguishing features - it should be discussed whether or not the cited prior art D13 or D17 renders the subject-matter claimed obvious.

VI. With letter dated 4 February 2013 submitted by fax on the same date the respondent submitted, as a response to the summons to oral proceedings, amended second and third auxiliary requests in combination with arguments concerning the amendments made therein and the admissibility of the auxiliary requests with respect to *reformatio in peius*.

VII. Oral proceedings before the Board were held on 3 April 2013. The main request was discussed regarding the fulfilment of the requirements of Articles 83 and 84 EPC. The first auxiliary request was then discussed regarding the fulfilment of the requirements of Articles 84 and 123(2) and (3) EPC, the latter in the light of decision G 1/99 (*supra*). Thereafter the first auxiliary request was discussed with respect to inventive step in the light of documents D12 and D17.

The objection pursuant to Article 83 EPC was withdrawn by the appellant.

(a) The appellant requested that the decision under appeal be set aside and that the patent be revoked.

(b) The respondent requested as main request that the appeal be dismissed and subsidiarily that the patent be maintained in accordance with the first auxiliary request. Both requests were filed with letter dated 12 January 2010.

At the end of the oral proceedings the Board announced its decision.

VIII. Independent claim 1 of the first auxiliary request reads as follows (amendments as compared to claim 1 as granted are in bold with deletions in brackets, emphasis added by the Board):

"1. A safety razor comprising a blade unit (2) having at least one blade (4) with a sharp cutting edge, a handle (1) on which the blade unit is carried, an electrical device (24,26), and a control device (16) for controlling operation of the electrical device, **[characterized in that]** the control device (16) **[is]** being responsive to a water detecting arrangement whereby the electrical device is actuated **for cleaning the blade unit** when a person using the razor immerses the blade unit (2) into a body of water **[for cleaning the blade unit], the water detecting arrangement comprising a pair of electrodes, one of which is provided on the blade unit, characterized in that the**

second electrode of said pair is carried by the handle."

IX. The appellant argued, insofar as relevant for the present decision, essentially as follows:

The lack of clarity objection can be raised during the entire procedure if a claim as granted has been amended. The issue of clarity has been discussed at the oral proceedings before the Opposition Division but this fact is not reflected by its minutes.

There exist no standards concerning the "normal use" as mentioned in claim 1 of the main request. The same holds true concerning the collection of foam on the blades. Therefore the scope of the functional definition of claim 1 is totally unclear since it is not known which values apply to the claimed spacing. Actually it is possible to define the subject-matter of claim 1 with more concrete features of the blade unit and the electrodes as done in the auxiliary requests 1-3 so that there exists no need for the functional definition.

Since claim 1 of the first auxiliary request does not contain the feature that the electrodes will "not be bridged by shaving foam collected on the blade unit in the course of shaving" it has been broadened compared to claim 1 of the patent as maintained. It is necessary and also possible to maintain these features in the claim since a deletion of features from the claim is not mentioned in the second alternative of the decision G 1/99 (*supra*). It is not clear where the handle starts (for the position of the second electrode) and with a

pivotable blade unit the distance between the two electrodes changes; it is not a fixed distance. Furthermore, claim 1 only defined that the blade has to be immersed in water but actually it has to be such that the second electrode on the handle is also immersed. This clarity problem has to be addressed even though it results from a combination of the claims 1 and 9 as granted since this feature is now comprised in the independent claim 1 and represents a distinguishing feature.

There are no further objections under Article 123(2) EPC.

The closest prior art document is D12 which discloses safety razors having a vibrating mechanism, whose blades can be rinsed with water. This razor does not have the second electrode on the razor handle. Shifting the location of the second electrode to the handle simplifies the manufacturing process. This is shown by D17 where the electrode is on the handle (see page 2, left hand column, lines 24 to 28).

The patent in suit discloses an embodiment where the actuator of the vibrating mechanism is used during the shaving, therefore not only during the rinsing between the shaving strokes (see patent, column 6, line 47 to column 7, line 4). The preamble of claim 1 corresponds to the disclosure of D12.

D12 discloses an alternative where the vibrating is started through the sensor 11 by gripping the handle 5 (see page 4, lines 32 to 35) and it is not correct that

one sensor is replaced by another since figure 1 shows both electrodes/sensors 11 and 11'.

To place the second electrode onto the handle is the second of two obvious possibilities (the first one is the location in the blade unit which is known from D12). The effect of placing it on the handle is not known but the initiation of the vibrating is known from D12 (see page 7, lines 32 to 35).

With respect to the adapted description it appears that according to paragraph [0009] the casing need not be carried by the handle which would be inconsistent with the subject-matter of claim 1 of the auxiliary request (Article 84 EPC).

X. The respondent argued, insofar as relevant for the present decision, essentially as follows:

It is not appropriate to discuss the amendment of claim 1 as maintained under Article 84 EPC in view of Article 12(2) RPBA since this issue was not contained in the appellant's statement of grounds of appeal. The feature in question was added to claim 1 during the opposition proceedings and has not been objected to by the appellant under Article 84 EPC in the entire proceedings, only by the Board.

According to decision G 9/91 (OJ EPO 1993, 408; see point 18 of the reasons) the purpose of the appeal procedure inter partes is mainly to give the losing party a possibility to challenge the decision of the Opposition Division on its merits. It is not in conformity with this purpose for the Board to consider

grounds for opposition on which the decision of the Opposition Division has not been based. Furthermore, in contrast to the merely administrative character of the opposition procedure, the appeal procedure is to be considered as a judicial procedure which by its very nature is less investigative than an administrative procedure.

It is not for the Board to do the appellant's job. The situation would be different if amended claims are filed during the appeal proceedings. In such a case the Board is entitled to check for clarity but here the situation is different. According to G 9/91 (*supra*) the Board is not completely free to apply Article 114(1) EPC.

Article 84 EPC represents no ground of opposition and is open to the opponent or the Opposition Division only in the opposition proceedings. The opponent/appellant is not allowed to raise this objection now for the first time in the appeal proceedings.

The feature "normal use …" was discussed at the first instance under Article 83 EPC and not under Article 84 EPC.

According to the Guidelines for Examination in the European Patent Office (see C-III, 4.10) a functional language of a result to be achieved is allowable under certain conditions, namely if it either can only be defined in such terms or cannot otherwise be defined more precisely without unduly restricting the scope of the claim and if the result is one which can be

directly and positively verified without undue experimentation.

In this context it is remarked that the emphasis is on "shaving foam **collected on the blade unit**" so that it is relevant only whether the foam is on the electrodes and not on the hand of the user. According to claim 1 of the patent as maintained the foam should not bridge the two electrodes which are spaced apart. In any case, a foam covered hand does not represent a "normal use" of the razor.

With respect to the auxiliary requests and "*reformatio in peius*" the question is whether or not the appellant would be in a worse situation after the amendment. It is literally impossible to draft something which falls into the scope of claim 1 of the main request and not into the scope of claim 1 of the first auxiliary request. How can two electrodes be bridged on the blade if the second one is placed on the handle of the razor? Claim 1 of the first auxiliary request has a narrower scope than claim 1 of the main request. In particular, it is not apparent as to how the features of the shaving foam and the normal use of the razor - which were considered to render claim 1 of the main request unclear - now could clarify or restrict claim 1 of the first auxiliary request. Consequently, striking out language of a claim which is not acceptable should be permitted since it is in any case not restricting the scope of claim 1. Therefore claim 1 of the first auxiliary request complies with the second alternative of G 1/99 (*supra*).

Claim 1 of the first auxiliary request does not cover additional subject-matter but even if it does the second electrode will not be placed so close to the first one that it would be bridged by shaving foam. Therefore the likelihood that the situation of the appellant is worsened is very small.

The wording of immersing "the blade unit (2) into a body of water" was already comprised in claim 1 of the patent as granted so that this clarity objection cannot be raised at the appeal stage; the amendment carried out does not give rise to this clarity objection either. This clarity issue was always present in the combination of claims 1 and 9 of the patent as granted and was only raised under Article 83 EPC in the grounds of appeal.

The teaching of D12 is to actuate the blades during shaving and the moisture sensor 11' (see figure 1) is responsible for this actuation.

The appellant's arguments that the skilled person is seeking to simplify the manufacturing of the razor in view of D17 (which originates from 1939) cannot hold. D17 does not show any external electrode at all, let alone on the handle. Putting the second electrode of D12 on the handle rather than on the blade would deprive it from its function. Thus these arguments are based on hindsight.

According to claim 1 the electrical (vibrating) device is only actuated **after** or **between** normal shaving but **not during** normal shaving strokes. The effect of the second electrode is that no vibrating is induced during

the normal use of the razor but only when the control device with the water detecting arrangement comprising a pair of electrodes detects water during the rinsing of any foam and debris collected on the blade unit.

The appellant argued that the skilled person would be motivated to place the second sensor on the handle because there is an embodiment in paragraph [0020] of the patent in suit. This is irrelevant since there is no suggestion about that in D12.

The sensor 11 according to D12 is no moisture sensor but an infrared or pressure sensor which each represents an alternative to the moisture sensor 11' (see D12, page 3, line 26 to page 4, line 7).

The subject-matter of claim 1 of the first auxiliary request is thus not obvious over any combination of D12 with another prior art teaching and therefore complies with Article 56 EPC.

In case that the second electrode is formed by the casing it is still carried by the handle so that no problem under Article 84 EPC can be seen to exist with respect to paragraph [0009] of the adapted description.

Reasons for the Decision

1. *Admissibility of the amendments made in claim 1 of the main request (Articles 83 and 84 EPC)*

Claim 1 of the main request (i.e. claim 1 of the patent as maintained by the Opposition Division; see point II

above) comprises the functional definition of the spacing of the pair of electrodes: "the electrodes are spaced apart from each other so that, **in normal use of the razor, the electrodes will not be bridged by shaving foam** collected on the blade unit in the course of shaving". This defines a result to be achieved.

1.1 In its communication annexed to the summons to oral proceedings the Board remarked that, since this feature, which had been introduced during the opposition proceedings into claim 1, was taken from the description of the patent in suit, the issue of clarity of the wording of claim 1 as maintained has to be examined (see point V above).

1.2 The respondent argued at the oral proceedings that the Board, particularly in the light of point 18 of the reasons of the decision G 9/91 (*supra*), would not be entitled to examine ex-officio this amendment since the appellant did not raise any corresponding clarity objection in the entire proceedings, let alone in its statement of grounds of appeal.

These arguments cannot hold for the following reasons.

1.3 First of all, the quoted decision G 9/91 (*supra*) concerns the extent and power of examination in opposition cases by the Opposition Division and the Boards of Appeal and the principle of examination by the EPO of its own motion as laid down in Article 114(1) EPC with respect to **grounds** of opposition. This is clear from the quoted point 18 of its reasons which states "Although Article 114(1) EPC formally covers also the appeal procedure; it is therefore justified to

apply this provision generally in a more restrictive manner in such procedure than in opposition procedure. In particular with regard to **fresh grounds for opposition**, for the above reasons the Enlarged Board considers that such grounds may in principle not be introduced at the appeal stage" (emphasis added by the Board).

1.3.1 As admitted by the respondent at the oral proceedings clarity does **not** represent **a ground of opposition** as specified in Articles 100(a) to 100(c) EPC. Nonetheless as soon as amendments are made in the claims or the specification during the opposition and/or appeal proceedings the verification that all requirements of the EPC are met has to be carried out.

This view is supported by G 9/91 (*supra*, see point 19 of the reasons) wherein it is further stated that "In order to avoid any misunderstanding, it should finally be confirmed that **in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC** (e.g. with regard to the provisions of Article 123(2) and (3) EPC)" (emphasis added by the Board).

This conclusion is fully in line with the longstanding case law (see Case Law of the Boards of Appeal of the European Patent Office, 6th edition 2010, section VII.D.4.2; see e.g. T 227/88, OJ EPO 1990, 292; T 472/88 and T 922/94 both not published in OJ EPO). Where the Opposition Division, in the impugned

decision, has not even discussed the issue of clarity, it is up to the Board to do so.

1.3.2 The respondent argued also on the basis of the statement of the EBA in G 9/91 that the appeal procedure is more a judicial procedure for principally reviewing the decisions of the first instance and by its nature less investigative on the part of the Board. As the opponent had not objected to the clarity of this claim in the opposition proceedings, nor in the statement of grounds of appeal, the Board overstepped its competence in itself raising the issue.

However, in the present case the appellant raised objections under Article 83 EPC in its statement of grounds of appeal (see page 10, point c)) in that the patent did not define what is meant by the term "normal use of the razor" (one of the amended features objected to by the Board) nor what is "the amount of shaving foam collected on the blade unit in the course of shaving" (the other amended feature objected to by the Board). These objections had already been raised during the opposition proceedings with letter dated 17 September 2008 (see page 5, third paragraph to page 6, first paragraph) and have been discussed at the oral proceedings.

Since the issue is in the proceedings and is related to amended features in the claim, the Board considers it perfectly in order for it to address it on its own motion as an issue of clarity of claim 1 of the patent as maintained, even on the premise advanced by the respondent. In this respect it does not matter whether the issue was raised under Article 83 or 84 EPC.

1.4 As far as the amendments are concerned, the Board remains of the opinion that claim 1 as maintained does **not** comply with Article 84 EPC, for defining a result to be achieved "… the electrodes are spaced apart from each other so that, in normal use of the razor, the electrodes will not be bridged …". This result is influenced by the unspecified shaving foam, its amount, the hardness of the water used for shaving, etc. Further, it includes the vague and unspecified term "in **normal use** of the razor"; it is not clear what that feature means in practice and what limitations are implied by "a normal use".

1.5 The respondent's arguments to the contrary cannot hold for the following reasons.

In the present case, as convincingly argued by the appellant, it is actually possible to more precisely define the subject-matter claimed (see e.g. claim 1 of the first auxiliary request) without unduly restricting the claim. Further, it is considered to be impossible to determine the distance between the pair of electrodes by experimentation without undue burden for the person skilled in the art. This is due to the fact that the result of such experiments, i.e. whether or not the electrodes are bridged when varying the distance between them, is primarily dependent on the electrical conductivity of the used, but unspecified shaving foam and its unspecified components as well as the amount thereof and the hardness of the water used. The patent in suit is absolutely silent in this respect and gives no guidance at all. Hence the quoted

conditions for allowing this functional definition are considered **not** to be met in the present case.

1.6 The Board therefore considers that claim 1 of the main request contravenes Article 84 EPC. The main request is therefore not allowable.

2. *Admissibility of claim 1 of the first auxiliary request (Articles 84 and 123(2) and (3) EPC)*

In the present case the opponent is the sole appellant and the patent as maintained in amended form would have to be revoked as a direct consequence of this inadmissible amendment (see point 1 above) held allowable by the Opposition Division. Consequently, for this special case with respect to the prohibition of *reformatio in peius* the relevant decision G 1/99 (OJ EPO 2001, 381) which allows for exceptions to this principle (see Case Law of the Boards of Appeal of the European Patent Office, 6th edition 2010, section VII.E.6.1 and G 1/99, order of the decision) has to be applied.

2.1 According to the order of G 1/99 (*supra*), in order to overcome the deficiency in such circumstances, the patent proprietor/respondent may be allowed to file requests, as follows:

- in the first place, for an amendment introducing one or more originally disclosed features which limit the scope of the patent as maintained;

- if such a limitation is not possible, for an amendment introducing one or more originally disclosed

features which extend the scope of the patent as maintained, but within the limits of Article 123(3) EPC;

- finally, if such amendments are not possible, for deletion of the inadmissible amendment, but within the limits of Article 123(3) EPC.

2.2 The Board considers that claim 1 of the first auxiliary request - which is based on claim 1 as originally filed taken together with the disclosure at page 4, lines 1 to 5 of the application as originally filed (corresponding to the published WO-A-2004/073940) - corresponds to the second alternative mentioned in G 1/99 (*supra*).

The first alternative would mean that the objected phrase would remain in the claim, however that with further features the unclarity could be solved. This is not an option here; the addition of further features would not "overcome the deficiency".

The second alternative is a feasible solution, even on the premise that the unclear features did have a limiting effect on the scope of the claim. This is due to the fact that claim 1 of the first auxiliary request, when compared with claim 1 of the main request, has been restricted to the second of the available two alternatives: the first electrode is on the blade unit and the second electrode is on the handle (see point VIII above). Claim 1 of the patent as maintained (main request) covered two alternatives, i.e. one with both electrodes on the blade unit and one

with them separate from each other (see point II above).

Additionally, it has to be considered that the range for the distance between the two electrodes according to the - now - deleted functional definition of claim 1 of the main request was unclear (see points 1.4 and 1.5 above) since it was not known what the minimum or the maximum distance actually could be. In contrast to that, the present definition of claim 1 implies a certain distance between the electrodes.

2.3 The appellant's arguments to the contrary cannot hold for the following reasons.

2.3.1 The argument that the "deletion of features" is not mentioned in the second alternative cannot hold since the entire decision G 1/99 (*supra*), in the context of *reformatio in peius*, deals with the special case that a feature incorporated during the opposition procedure into the claims as granted cannot be maintained in the amended claims, for example for contravening Article 123(2) EPC, and as a consequence has to be removed from the claims.

2.3.2 In principle the deletion of a feature will result in a broadening of the scope of a claim. However, if said omitted feature of the distance between the electrodes is that unclear that in fact it is not known where the range of values for this distance started and where it ended, then the replacement of this feature by a clearer definition will result in a limitation of the resulting claim when compared to the claim comprising said unclear feature. It would seem that the present

solution lies between the first and second alternative of G 1/99 (*supra*).

2.3.3 Taking account of the unclarity of claim 1 of the main request it is difficult to establish what the "position of the appellant" was, when establishing whether for claim 1 of the auxiliary request this position has worsened. One thing is, however, clear: the possibility of having both electrodes on the blade unit is now excluded for the respondent. This embodiment was feasible under the wording of claim 1 of the main request; the foam would in that case be prevented from bridging the two electrodes by appropriate placing and/or shielding of one or both electrodes.

2.4 The appellant's arguments concerning an objection under Article 84 EPC based on the wording of claim 1 that "a person using the razor immerses the blade unit (2) into a body of water" and that claim 1 does not specify that the person has to immerse also the second electrode which is on the handle, cannot be accepted.

If at all a question of clarity, this deficiency was already present in the combination of the features of claims 1 and 9 as granted and for that reason not open to an objection under Article 84 EPC. Further, as the two electrodes are there to actuate the electrical device when they are bridged, it is implicit that both electrodes make contact with the water, either by immersing into a body of water or by holding under a flow of water for rinsing.

2.5 When asked by the Board at the oral proceedings the appellant stated that it has no further formal

objections concerning the claims of the first auxiliary request under Articles 123(2) and (3) EPC.

2.6 Taking account of the above, the Board reaches the conclusion that claim 1 of the first auxiliary request complies with the conditions of G 1/99 (*supra*) as well as the requirements of Articles 84 and 123(2) and (3) EPC.

3. *Inventive step (Article 56 EPC)*

Document D12 was considered by both parties as the closest prior art for the safety razor of claim 1 of the first auxiliary request.

3.1 D12 discloses a safety razor in which the cutting effect of the blade during the shaving is enhanced by causing the blade to vibrate. The handling of the razor can be improved by providing a sensor on the razor handle, so that the blade is made to vibrate only when the razor is picked up (see page 3, lines 27 to 30), which can be achieved by providing an infrared sensor or a pressure sensor either in the grip or in the blade area, the latter embodiment having the advantage of further saving energy since the sensor is only activated when the blade contacts the skin (see page 3, line 30 to page 4, line 2). Alternatively, a moisture sensor on the razor head is also feasible and actuates the vibrating mechanism when the razor head (carrying the two electrodes of the moisture sensor) is brought into contact with wet skin during shaving (see page 4, lines 4 to 7 and page 7, lines 29 to 35; figure 1; claims 1, 13 und 18).

3.2 The safety razor of claim 1 of the first auxiliary request thus differs from the razor of D12 having the moisture sensor on the razor head (the latter corresponding to the blade unit) in that the second electrode of the water detecting arrangement (corresponding to the moisture sensor) is located on the razor handle. The preamble of claim 1 thus corresponds to the disclosure of D12.

3.3 The effect of this distinguishing feature is that the electrical device (e.g. for vibrating the blade unit) is only automatically actuated when the two electrodes of the water detecting arrangement are either immersed into a body of water or rinsed under a flow of water in order to aid removing of shaving debris and shaving foam or soap from the blade unit.

3.4 The objective technical problem is therefore defined as the provision or improvement of the cleaning capability of the safety razor of D12, in which the electrical device is only actuated for cleaning purposes but not during shaving (compare patent in suit, paragraphs [0004] to [0007]).

3.5 This technical problem is solved by the subject-matter of claim 1 of the first auxiliary request.

3.6 Contrary to the appellant's arguments this solution is not rendered obvious by a combination of the teachings of D12 and D17 for the following reasons.

3.6.1 First of all, D12 does **not** mention the problem underlying the patent in suit but aims to solve a totally different problem, namely improving the

shaving/cutting effect of a wet razor (according to a preferred embodiment to make the handling of the razor more pleasant) by providing a razor comprising a replaceable razor blade which is excitable to oscillations by either a piezo actuator or an electromagnetic drive (see page 2, lines 5 to 24, page 3, lines 1 to 12; figures 1 and 2; and claim 1).

Hence according to the general teaching of D12 the razor blade is vibrated during the shaving and the electrical device (i.e. the piezo actuator or the electromagnetic drive) is automatically actuated by **either** a moisture sensor 11' **or** alternatively an infrared sensor 11 or a pressure sensor 11. The appellant's arguments that the razor may comprise both sensors 11 and 11' (the latter as shown in figure 1) cannot hold since it is absolutely clear from the description of D12 that these sensors represent **alternatives** only (see page 4, line 32 to page 5, line 9; page 7, lines 11 to 17 and lines 29 to 32).

3.6.2 Second, the person skilled in the art, when starting from the teaching of D12, would have to change the essential features of its teaching, which includes the vibrating of the blade unit **during** the shaving which either starts when gripping the handle (i.e. the infrared sensor or the pressure sensor 11) or when contacting the wet skin (i.e. the moisture sensor 11'). The Board cannot see a reason for the person skilled in the art to do so.

3.6.3 Insofar it is questionable whether D12 - which requires vibrating during the shaving - is actually the closest prior art document for the subject-matter of claim 1.

Furthermore, even if the person skilled in the art by chance would realize that the razor with the moisture sensor on the blade unit can be held under a flow of water in order to rinse the latter - which, as long as water bridges the two electrodes, would cause vibrating of the blade unit - he has no reason to relocate one of the two electrodes of said moisture sensor to the handle; it works as it is.

3.6.4 The appellant further holds the argument that relocating the second electrode to the handle would simplify the manufacturing process and that this would be shown by D17. This cannot hold either.

D17 is absolutely silent with respect to any simplification of a process for manufacturing a safety razor.

D17 relates to a razor which makes use of an electric current for **increased shaving efficiency** (see page 1, left hand column, lines 1 to 4 and line 48 to right hand column, line 8). The metallic handle portion 15 forms one electrode while the blade 13 and optionally the base member 11 and the blade cap 10 form the second electrode which are connected with the positive pole and the negative pole of the conventional dry cell 23, respectively (see page 1, right hand column, line 14 to page 2, left hand column, line 23). The open circuit formed by the safety razor of D17 is closed by contact between the handle and the blade which is realised through the body of the user via the handle being held in the hand of the user and the blade being in contact with the moisture-laden lather on the face of the user

(see page 2, left hand column, line 24 to right hand column, line 4). D17 therefore relates also to a completely different technical problem than the problem solved in the patent in suit and is silent with respect to any cleaning of the blade unit.

The teaching of D17 thus cannot change the situation since it is not concerned with providing a vibrating mechanism in a safety razor for any purpose, let alone to facilitate cleaning. With its pair of electrodes which are spaced from each other it aims, likewise as D12, to enhance the shaving effect but using a totally different arrangement.

Therefore the Board considers that the teaching of D17 is incompatible with the aims of D12 and without an ex-post facto analysis it is therefore not logical to combine the teachings of D12 and D17.

3.6.5 The appellant's further arguments cannot hold either. They are likewise considered to be based on hindsight, since the documents in question do **not** contain any suggestions relating to the cleaning of safety razors, let alone in the light of their disclosed specific examples, which would allow to arrive at a safety razor as defined in claim 1 of the first auxiliary request.

The fact that the patent in suit discloses an embodiment where the actuator of the vibrating mechanism is used during the shaving and not only during the rinsing between the shaving steps (see patent, column 6, line 47 to column 7, line 4) is not relevant since there exists no reason for the person

skilled in the art to relocate one electrode to the razor handle.

The same conclusion holds true with respect to the argument that placing the second electrode onto the handle is the second of only two possibilities (the first one is the location in the blade unit which is known from D12) since there is no suggestion at all concerning the cleaning of the razor.

As admitted by the appellant at the oral proceedings the effect of placing the second electrode on the handle is not known from D12, let alone for the intended purpose, so that it is not particularly relevant whether or not the initiation of the vibrating is known from D12.

3.6.6 The appellant did not argue on obviousness starting from the razor of D12 and application of general technical knowledge by the skilled person. The Board has no reason in this particular case to see this differently.

3.7 Taking account of the above the Board considers that the subject-matter of claim 1 of the first auxiliary request involves inventive step.

3.8 Taking account of the amendments to the description as filed at the oral proceedings, which has been adapted to claim 1 of the first auxiliary request the Board considers that also the specification of the patent in suit according to the first auxiliary request complies with the EPC.

The objection raised by the appellant under Article 84 EPC with respect to paragraph [0009] cannot hold since it is clear from the description that in case that the second electrode is formed by a casing of the handle, such as mentioned in that paragraph, then also this casing is carried by the handle.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance with the order to maintain the patent with the following documents:

- description:
  columns 1-4 filed in the oral proceedings
  columns 5-10 of the patent specification

- claims:
  1-20 filed as first auxiliary request with letter dated 12 January 2012

- figures:
  1-9 of the patent specification.

The Registrar: The Chairman:

G. Nachtigall H. Meinders