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**Datasheet for the decision
of 22 November 2011**

Case Number: T 1538/09 - 3.2.04

Application Number: 01998255.2

Publication Number: 1339307

IPC: A47L 9/24

Language of the proceedings: EN

Title of invention:

A coupling device for a detachable connection of a suction hose to a vacuum cleaner housing

Applicant:

Nilfisk-Advance A/S

Opponent:

BSH PAE S.L., Parque Tecnológico de Alava

Headword:

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Relevant legal provisions:

EPC Art. 123(2)

RPBA Art. 13(3)

Relevant legal provisions (EPC 1973):

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Keyword:

"Admissibility of the appeal (yes)"

"Added subject-matter (yes - all requests)"

"Extraction of isolated features"

"Admissibility of late filed request (yes- third auxiliary request)"

Decisions cited:

T 0252/95, T 1067/97, T 0714/00, T 0025/03, T 0934/02,
T 0760/08

Catchword:

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Case Number: T 1538/09 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 22 November 2011

Appellant: Nilfisk-Advance A/S
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 10 June 2009
revoking European patent No. 1339307 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: A. de Vries
C. Heath

Summary of Facts and Submissions

I. On 17 July 2009 the Appellant (Proprietor) lodged an appeal against the Opposition Division's decision of 10 June 2009 to revoke European patent No. 1 339 307 and simultaneously paid the prescribed appeal fee. The grounds of appeal were filed on 9 October 2009.

The opposition was filed against the patent as a whole and based on Article 100(a) EPC in combination with Articles 54 and 56 for lack of novelty and inventive step.

The Opposition Division held that these grounds prejudiced maintenance of the patent in view of the following documents among others:

D1: EP-A-0 328 494

It further held that amendments made in the course of the opposition proceedings added subject-matter, contrary to the requirements of Article 123(2) EPC.

II. The Appellant (Proprietor) requests that the decision under appeal be set aside and the patent be maintained in amended form according to a main request, or one of auxiliary requests 1 and 2, filed with the grounds of appeal, and of auxiliary request 3 filed at the oral proceedings before the Board.

The Respondent (Opponent) requests that the appeal be dismissed.

III. Oral proceedings before the Board were duly held on 22 November 2011.

IV. The wording of claim 1 of the main and auxiliary requests is as follows:

Main request

"An assembly comprising a vacuum cleaner housing (1) partly bordering the dust compartment of the vacuum cleaner and having an inlet opening and a coupling device for a detachable connection of a suction hose (4) to the inlet opening, the coupling device comprising a tube connecting piece (7) to be fixed in use on the suction hose (4) and a socket (8) on the vacuum cleaner housing for receiving the tube connecting piece (7), said tube connecting piece (7) including sealing means (17) interacting with the socket (8) and latch means (9, 10) that are releasably connected to the socket (8) by means of latch receiving means (12, 14, 20, 21) integrally moulded with the vacuum cleaner housing (I), characterised in that said latch means includes a plurality of symmetrically arranged resilient latches (9, 10, 11, 13), that the latch receiving means (12, 14, 20, 21) are formed in a wall member (15) formed externally on the vacuum cleaner housing, that said wall member (15) extends radially to the tube connecting piece (7), and wherein said external wall member (15) comprises openings (20, 21) for receiving said latches."

Auxiliary Request 1

Claim 1 is as in the main request but adds the following final feature

"and the latch receiving means are formed such that the latch receiving means can be made with the same slide moulding part of the moulding tool that makes the hole for the inlet/socket.".

Auxiliary Request 2

Claim 1 reformulates claim 1 of auxiliary request 1 as a method claim by inserting at the beginning of claim 1 of auxiliary request 1 the wording : "A method for forming".

Auxiliary Request 3

Claim 1 is as in the main request but replaces the term "moulded" with "formed" so that the latch receiving means (12,14,20,21) is now "integrally formed with the vacuum cleaner housing (1)".

V. The Appellant argued as follows:

The various requests attempt to distinguish claim 1 still further from D1. In this respect they address the decision under appeal which departed from this document as closest prior art.

The amendments to claim 1 of the main request have a direct basis in the original disclosure. In particular, specifying "moulding" instead of "forming", and the external wall member comprising openings for receiving latches have a basis in cited passages of the description. There is no need to include other features that appear in those passages as these are implicit in

the terminology used. For example, a snap and hook are implicit in the term latch.

The further amendment to claim 1 of auxiliary request 1 need not specify "single injection moulding" as this does not lead to any easily discernible structural difference.

Reformulating the invention in terms of a method (auxiliary request 2) also does not result in an overall change in content or scope. Its features are essentially identical to those of claim 1 of auxiliary request 1. It includes only a single process step, the use of a slide moulding part, but this implies other process features, in particular injection moulding, described in the application as filed.

Auxiliary request 3 reinstates in the final feature of its preamble the term "formed" used of claim 1 as granted. The amendment addresses an issue discussed in the oral proceedings in a manner that is clearly allowable and is thus admissible.

VI. The Respondent argued as follows:

The requests presented in the appeal differ from those that were the subject of the decision under appeal. Nor do the amendments address the reasoning of the decision. They rather give rise to new objections and in particular have no clear basis in the application as filed. The appeal should therefore be rejected as inadmissible.

The amendments to claim 1 in any of the requests add subject-matter. Thus, the description may describe the external wall being integrally moulded, but not the latch receiving means. Where the claim requires openings in the external wall, the cited passages also mention cavities which play an important role in the latching mechanism. These amendments in claim 1 of the main request thus add subject-matter.

In auxiliary request 1, additionally, the further feature incorporated from the description does not mention the hole or snaps mentioned there.

There is no complete or coherent disclosure of a method. In as far as anything is disclosed it is a single injection moulding step, which does not appear in claim 1 of the auxiliary request 2.

The amendment to claim 1 of auxiliary request 3 is late filed and should not be admitted. It addresses only one of a number of points raised, the others still remain valid.

Reasons for the Decision

1. *Admissibility of the appeal*
 - 1.1 In the total loss of rights incurred by the decision to revoke his patent, the Proprietor is clearly adversely effected by that decision. This adverse effect is absolute and irrespective of the extent of the relief sought, as defined by the appellant's requests, or ultimately awarded.
 - 1.2 It is established case law that the filing of new requests not previously considered in first instance can sufficiently substantiate an appeal in the sense of Article 108 EPC. This is in principle possible to the extent that such new requests are intended to remove the legal basis of the decision, see for example T 252/95 and T 934/02. In so far as not evident from amendments themselves, the grounds should indicate in sufficient detail how the amendments address the decision's findings, see T 760/08, reasons 3. As long as requests do not extend beyond the legal and factual scope of the first instance proceedings, they do not conflict with the main purpose of inter partes appeal proceedings to give the losing party the possibility to challenge the contested decision on its merits see e.g. the Case Law of the Boards of Appeal (CLBA), 6th edition 2010, VII.E.16.2.1-2 and the case law cited therein.
 - 1.3 In the present case the requests can be seen to be based on the third and fourth auxiliary requests discussed in the decision under appeal. They add detail

intended to underline perceived differences over the prior art of D1 in particular, as is clear from the extensive arguments in the statement of the grounds of appeal. They thus refine the appellant's earlier positions in the first instance proceedings and perforce do not extend beyond their legal and factual framework.

1.4 The arguments presented in the statement of the grounds of appeal also attempt to explain why the decision was wrong in its analysis of the prior art D1 and why perceived differences would be inventive over this prior art. From these arguments the Board has no difficulty in understanding the Appellant's case, why he believes the decision to be wrong and how the amendments are intended to address its findings. Whether or not they do so successfully without giving rise to new grounds for objection is immaterial. Those questions reflect on the case's merits and whether the appeal is well-founded - not on the question of admissibility which is to be decided before any consideration of merit.

1.5 In the light of the above the Board concludes that the appeal is admissible.

2. *Admissibility of auxiliary request 3*

According to Article 13(3) of the Rules of Procedure of the Boards of Appeal amendments submitted after oral proceedings have been arranged shall not be admitted "if they raise issues which the Board or the other party ... cannot reasonably be expected to deal with without adjournment ...". Auxiliary request 3 filed at

the oral proceedings before the Board includes a sole amendment to claim 1 of the main request, restoring a formulation used in granted claim 1 see section 3.2 below. It so remedies that particular instance of added subject-matter, but leaves all others instances discussed at the oral proceedings with regard to the main request unaddressed. It is clear that this request will then stand or fall with the main request on those remaining points. It can therefore easily be dealt with without adjournment. For this reason the Board decided to admit this request into the proceedings.

3. *Added subject-matter*

3.1 In claim 1 of the *main and first to third auxiliary requests* the feature that "*the external wall member (15) comprises openings for receiving [the] latches*" has been introduced from the description pertaining to a particular embodiment.

According to established case law, see e.g. decisions T 1067/97, T 714/00 or T 25/03 cited in the Case Law of the Boards of Appeal, 6th edition, 2010 (or CLBA), III.A.2, it is normally not admissible under Article 123(2) EPC to extract isolated features from a set of features originally disclosed only in combination in the description. This will only be justified if there is no clearly recognizable functional or structural relationship between the features.

3.1.1 The only passage that expressly mentions "openings" in the external wall is page 4, second paragraph, of the description as filed, corresponding to specification

paragraph [0012]. In reference to figures 2 to 4 this passage describes a latching arrangement where the latches have "hooks 11, 13 that engages [sic] the latch receiving means 12,14;20,21". These include "cavities 12, 14 between the external wall member 15 ... integrally formed on the outside of the genuine wall housing 1". Furthermore, "the latches 9,10 are inserted through openings 20,21 in the external wall member 15 whereby the latch hooks 11,13 enter the cavities behind the external wall member". As is clear from figure 4 in particular, once inserted through the openings 20, 21 into the cavities 12, 14, the hooks 11, 13 engage the ends of the external wall 15.

3.1.2 An alternative basis may be found on page 2, second paragraph, of the application as filed, corresponding to specification paragraph [0006]. This refers to a "snap fit connection", in which the latches of the tube connecting piece "hook" to the external wall member outside the housing wall, so that there is no hole through to the dust compartment. "[The] holes for the snap can be made with the same slide moulding part of the moulding tool that makes the hole for the inlet/socket" in a "single injection moulding process" for integrally forming the external wall and housing. It is assumed that these "holes for the snap" correspond to the openings mentioned on description page 4, which allow the latch to hook to the external wall member, and which, by being provided only in the external wall and not the genuine housing wall, do not pass through to the dust compartment.

3.1.3 Read in context these passages describe a specific latching arrangement in which, during insertion of the

tube into the socket, a "hooked" latch on the tube connection piece *inserts through the opening* in the external wall into a *cavity between it and the housing wall* and then *hooks behind the wall edge* providing a *snap fit*. This particular snap fit arrangement does not require holes through the housing and so secures an air tight snap fit connection, page 1, lines 29 to 31 of the filed description (specification paragraph [0004]), one of the invention's main objectives. No other latching arrangement with openings is apparent in the application as filed. In this particular arrangement the openings act in close cooperation with the arrangement's other features - latch hooks, cavity - and cannot be seen in isolation from them. This feature is thus originally presented in a specific structural and functional context. Lifting it out of this context and adding it in isolation to claim 1 represents a generalization that adds subject-matter extending beyond the original disclosure.

- 3.1.4 Nor are the features omitted somehow implicit in the terms used in claim 1. Thus, "latch" is a generic term that does not imply any specific engaging mechanism. That the openings in the external wall are "for receiving [the] latches" also does not mean that latch hooks engage the edge of the external wall defining the opening. This is not helped by that fact that claim 1 fails to expressly link the *external wall openings* and the feature of the *latch receiving means* that releasably connects the latch means to the socket. In claim 1's present wording the two features can in fact be read as separate and unrelated. The original disclosure however allows for only one interpretation with the edge of the external wall at the opening

forming the actual latch receiving means. Consequently, in this regard also the above amendment to claim 1 adds subject-matter extending beyond the original disclosure.

3.2 Claim 1 of the *main request and auxiliary requests 1 and 2* now also requires the latch receiving means to be integrally *moulded* with the vacuum cleaner housing, rather than integrally *formed* as in granted claim 1. This amendment is said to derive from page 2, lines 19 to 21 of the description as filed (patent specification, column 2, lines 8 to 11). There however, it is the *external wall member* which is integrally formed in the housing, that is "produced together with the housing in a *single injection moulding* process". Leaving aside the question of how the external wall member and latch receiving means relate exactly, the formulation in claim 1 of these requests generalizes the original disclosure to include forming the two parts by any type of integral moulding, not just moulding by single injection.

That this would not lead to any discernible difference in the assembly is beside the point. That is a matter of the scope of protection of the claim and (for the claims to the assembly at least) this may not have changed. What is at issue, however, is whether the amendment adds subject-matter to the application as a *whole*. The question to be posed is: does the amendment add new information to the application as filed? The broader formulation in claim 1 teaches moulding other than just by single injection moulding and thus adds to the original information content.

3.3 *Auxiliary requests 1 and 2* add to claim 1 the further feature that "*the latch receiving means are formed such that [it] can be made with the same slide moulding part of the moulding tool that makes the hole for the inlet/socket*". The passage of the as filed description cited as basis, page 2, lines 22 to 24, indicates more specifically that it is the "holes for the snap" that can be so made. As noted above, section 3.1.4, the claim's wording, which is otherwise unchanged where it defines the assembly, the *latch receiving means* and the holes for the snap fit are by no means synonymous. As a consequence this feature conveys different information than the originally disclosed formulation and so adds subject-matter.

3.4 *Auxiliary request 2* is directed at "*a method for forming*" an assembly defined as in claim 1 of the auxiliary request 1. Page 2, lines 15 to 27, of the as filed description (patent specification, column 2, lines 2 to 21) provides disclosure of a method of manufacture, but within a very limited context. The steps described there relate firstly to the manufacture of only part of the assembly (the tank element shown as 1 in figure 1). Secondly, the steps are defined differently there than in the claim : as noted previously, the housing is moulded together with *the external wall* in a *single injection* moulding process and *holes for the snap* are made with the same slide moulding part as the socket. Finally, the passage indicates forming the other parts with *normal parting of the tool*, a step not included in claim 1. The claimed method is thus defined in different terms and with less detail than the method originally disclosed, which again represents a change in information content.

4. *Conclusion*

The Board finds that each of the above amendments adds subject-matter that extends beyond the content of the application as filed, and that none of the main and first to third auxiliary requests therefore meet the requirements of Article 123(2) EPC. It can therefore not allow any of the Appellant's requests. Consequently, the appeal must fail.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

G. Magouliotis

M. Ceyte