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**Datasheet for the decision
of 29 May 2012**

Case Number: T 1966/09 - 3.2.04

Application Number: 02749029.1

Publication Number: 1408807

IPC: A47L 11/33, A47L 11/32
A47L 11/40

Language of the proceedings: EN

Title of invention:
Surface cleaning apparatus

Patentee:
Grey, Nicholas Gerald

Opponent:
Alfred Kärcher GmbH & Co.

Headword:
-

Relevant legal provisions:
EPC Art. 83

Relevant legal provisions (EPC 1973):
-

Keyword:
"Sufficiency of disclosure (no - all requests)"

Decisions cited:
T 0409/91, T 0435/91, T 0990/07, T 1831/07

Catchword:
-



Case Number: T 1966/09 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 29 May 2012

Appellant: Grey, Nicholas Gerald
(Patent Proprietor) 7 Laxton Close
Crowle
Worcestershire WR7 43H (GB)

Representative: Gee, Steven William
1 South Lynn Gardens
London Road
Shipston on Stour
Warwickshire CV36 4ER (GB)

Respondent: Alfred Kärcher GmbH & Co.
(Opponent) Alfred-Kärcher-Str. 28 - 40
D-71364 Winnenden (DE)

Representative: Hoeger, Stellrecht & Partner Patentanwälte
Uhlandstrasse 14c
D-70182 Stuttgart (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 20 July 2009
revoking European patent No. 1408807 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: A. de Vries
Members: C. Scheibling
T. Bokor

Summary of Facts and Submissions

- I. On 30 September 2009 the Appellant (Proprietor) lodged an appeal against the Opposition Division's decision of 20 July 2009 to revoke European patent No. 1 408 807 and simultaneously paid the prescribed appeal fee. The grounds of appeal were filed on 30 November 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 amendments made in the course of the opposition procedure to claim 1 of a sole main request added subject-matter, contrary to the requirements of Article 123(2) EPC.

- II. In reply to the statement of the grounds of appeal the Respondent raised the issue of insufficiency of disclosure among others against the requests then on file.

The Board also mentioned this issue in preliminary observations made in the annex to the summons issued in accordance with Article 15(1) RPBA.

Oral proceedings before the Board were duly held on 29 May 2012.

- III. The Appellant requests that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the claims of one of a main, first

or second auxiliary requests filed with letter dated 19 April 2012.

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

IV. The wording of claim 1 according to the different requests is as follows:

Main Request

"A surface cleaning apparatus comprising:
a body (1; 106);
an elongate rotatable brush arrangement (11; 116)
positioned within and extending across the body;
an electric motor for rotating the brush arrangement;
a compartment for collecting debris positioned within
the body adjacent to the elongate rotatable brush
arrangement; and
elongate handle means (33; 154; 41) comprising a first
handle means attached to the body,
characterised in that the elongate handle means has a
second handle means (41) which serves to extend the
first handle means;
in that the handle means (33; 154; 41) has a
longitudinal axis and is provided with a first means
(43) to allow the handle to rotate about the
longitudinal axis and with separate second means (45)
to allow the handle to pivot about a second axis, the
second axis being transverse to the longitudinal axis,
to enable the surface cleaning apparatus to be steered,
and in that the first means (43) which allows the
handle to rotate about its longitudinal axis functions

only in certain positions of the first handle means (33; 154).

Auxiliary Request 1

Claim 1 adds to claim 1 of the main request the feature of "*drive means extending between the rotatable brush arrangement and the electric motor*" immediately after the feature of electric motor in the preamble, while specifying in the last characterizing feature but one that the first and second means allow the handle to rotate respectively to pivot "*relative to the body*".

Auxiliary Request 2

Claim 1 is as in the auxiliary request 1 but for features of the preamble, which are amended as follows (added italics indicate added text, while strikethrough indicates deleted text):

"a body (1; 106) *having a rear compartment (3; 108) and a forward compartment (9; 114)*";

"an elongate rotatable brush arrangement (11; 116) positioned within and extending across the *forward compartment* ~~body~~";

"an electric motor *positioned in the rear compartment* for rotating the brush arrangement"; and

"*an intermediate compartment arranged between the rear and forward compartments* for collecting debris positioned within the body adjacent to the elongate rotatable brush arrangement".

V. The Appellant argued as follows:

The passage at the top of page 13 describing the embodiment on which claim 1 in its various versions is based is obviously in error. It starts off referring to a two part handle but finishes referring to a one part handle. This final part is obviously wrong and the skilled person will ignore it. Though this passage is unfortunately formulated and a further paragraph would have been helpful, the remaining text and figures still provide sufficient clues for the skilled person to be able to carry out the invention. Thus, the general concept of swivel means that functions only in certain positions but is inhibited in others is per se known to him. There are many different ways of achieving this. One way of blocking movement which suggests itself immediately and which is demonstrated by means of a model, is to give the rotatable handle a noncircular shape to fit in a correspondingly shaped recess when the handle is pivoted forward.

The patent may not give any example of how to realize the invention. However, as stated in T 990/07 the lack of an example does not need to be a bar for the skilled person to carry it out, as long as there is sufficient information in the whole patent. Here the skilled person recognizes obvious errors and fills in gaps with his own knowledge.

VI. The Respondent argued as follows:

Legal certainty requires that there is a clear definition of what is protected and a clear disclosure of how the invention is realized.

The final feature of claim 1 defines a result to be achieved, without however indicating the necessary means for achieving this result. The patent does not provide any clear technical teaching in this regard. Nor does the skilled person know how to achieve this desired result. He cannot obtain it by simple experiments. The noncircular solution demonstrated does not form part of the disclosure.

Reasons for the Decision

1. The appeal is admissible.
2. *Insufficiency of disclosure (all requests)*
 - 2.1 It is established jurisprudence of the Boards of Appeal that the requirements of sufficiency of disclosure are only met if the invention as defined in the claims can be performed by a person skilled in the art across the whole area claimed without undue burden, using common general knowledge and having regard to further information given in the patent in suit, see for example T 409/91, OJ 1994, 653, reasons 3.5; or T 435/91, OJ EPO 1995, 188, reasons 2.2.1.
 - 2.2 In the case at hand each of the versions of claim 1 according to the main and first and second auxiliary request includes the final feature that "the first means which allows the handle to rotate about its longitudinal axis functions only in certain positions of the first handle means". This feature, introduced in the course of the opposition procedure and defined in

purely functional terms (stating a result but not how that result is achieved), has no basis in the claims as granted or as filed, but rather derives from the final two sentences of paragraph [0029] of the patent specification.

- 2.3 Specification paragraph [0029] is the only relevant part of the description which specifically describes handle configurations and functions. It first details a configuration with swivel means 43 which allows rotation of the handle and is provided in the extension handle part 41 and that replaces a removable part 39 of handle 33 (another part 37 remains secured to the main body). It is the final two sentences of paragraph [0029] describing an alternative to this first embodiment on which the added feature is based. The two sentences read as follows: "As an alternative to interchangeable handles, the handle part 41 may be removably engageable with the handle part 33. In such a case, the handle part 33 is arranged such that the swivel means 43 functions only in certain positions of the handle part 33 in order that movement can be inhibited when the handle part 33 is used alone." The first sentence gives structural detail of the alternative handle that are relatively clear and straightforward. However, the second sentence gives a purely *functional* definition of the handle part. It describes how the handle should function, namely with the swivel means functioning only in certain positions so that movement is inhibited when the handle is used alone, but does not give any particulars of the structure or configuration that might achieve this function. Nor is such further detail apparent anywhere else in the patent.

2.4 The function set out in the final sentence of paragraph [0029] is also not trivial. Nor is it self-evident to the Board how a handle might be designed that achieves this function. The question arises whether, without further information and thus on the basis of the functional definition alone the skilled person can realize the desired function using his normal skills and common general knowledge.

2.5 In this connection it should be noted that the way the function is phrased in specification paragraph [0029] is far from perfect. Not only is it indeterminate it is moreover inconsistent with the first handle embodiment of the preceding lines in the paragraph. Thus, it is not immediately clear which particular movement should be inhibited, nor how the swivel means cannot work in certain positions of handle part 33 if, as in the first embodiment, it is located on the extension part, and that part is removed. Nevertheless, using normal reading skills some sense can still be made of these aspects. For example, it can be inferred that, if the swivel means is to function only in certain positions of the handle when the extension part is not attached, it must be located on the main handle part 33 and not the extension part as in the first embodiment. The inhibited movement in the second half of the sentence most likely refers to the condition that the swivel operates only in some positions (and thus not others) in its first half, that it is it will be the rotational movement of the swivel means that is inhibited. Indeed, in this respect, the Board is unconvinced by the Appellant's contention that these parts of the sentence would be critically wrong and that this would be immediately apparent to the skilled person who would

ignore them altogether. He can still make sense of these functional aspects.

2.6 The skilled person however faces a much more daunting task when is asked to practically realize the functions stated in final two sentences of specification paragraph [0029]. In the present case the skilled person will be a mechanical engineer involved in the design of surface cleaning apparatus and their handles, with good knowledge in those areas, but otherwise of routine skill and of very limited ingenuity and imagination. It is from this level of skill that the question of sufficiency is to be considered.

2.7 As stated the description, figures and claims offer no clues or starting points, let alone any examples. The mechanical engineer defined above must therefore start from scratch, with only the desired function as objective. Does he have available to him from his knowledge of handles or of more general, underlying principles, standard solutions or working examples that achieve the desired result, or, alternatively, can he arrive at the desired result by routine design procedure, in a process of trial and error say?

In view of the many design options and possibilities and the relative complexity of the desired function the Board holds that it would be far from trivial or straightforward to design a handle with a swivel that operates as described following routine experimentation. Nor does it believe that there exist standard, common solutions for obtaining what, in its view, is not a standard function.

- 2.8 The Appellant has also not been able to provide compelling evidence to the contrary. It cites an example of a handle that would achieve the desired result, which has a swivel joint that allows its upper half to rotate with respect to its lower half which is pivotably connected to the cleaner main body. The handle has a non-circular cross-section so that when the handle is tilted forward it fits into a matching recess in the body where rotation is then blocked.
- 2.8.1 Firstly, no proof is provided to substantiate that this example, which is acknowledged to have no explicit basis in the text or drawings, would belong to common general knowledge either in the specific field of vacuum cleaners or any other field. The Board also considers it unlikely that the skilled person would infer such a relatively complex configuration from the mere mention of movement being inhibited, all the more so, if, as argued, the skilled person were to ignore that part of the last sentence as an obvious error.
- 2.8.2 More importantly, as the model demonstrates, movement is inhibited only in the tilted position and irrespective of whether or not the handle is used alone or with an extension attached, and thus the example fails to realize an important part of the function as set out in paragraph [0029]. As stated previously, even if somewhat poorly formulated the skilled person is still able to make sense of it and certainly has no reason to believe it is wrong and to be disregarded.
- 2.8.3 A further example said to involve pins is provided without other detail, let alone documentary evidence, and can be disregarded offhand. The Appellant has thus

failed to provide any working example that convincingly demonstrates the desired function and which might belong to common general knowledge.

- 2.9 It is true that, as noted in T 990/07, see reasons 2.3, the lack of an embodying example of a central feature of a claimed invention (the absence due to all examples described being obviously wrong) need not in itself constitute a bar to realizing the invention. In T0990/07 the feature in question - a wiring pattern so as to connect antenna wiring portions in a loop form - was formulated in the claim or the summary of invention in such concrete terms that it was considered to contain sufficient information for the skilled person to arrive at the intended configuration (a single loop). This distinguishes it from the present case where the information available to the skilled person, in its most complete form in the final sentence of paragraph [0029], is formulated exclusively in terms of a desired function or operation, using a purely functional definition.

A functional definition, which is intended to cover any number of possible alternatives, also need not per se pose a problem for sufficiency, as held in T 1831/07 also cited by the Appellant, see reasons 4.2. As long as the skilled person can determine without undue burden the technical characteristics of the alternatives which achieve the desired result, the invention will be sufficiently disclosed. In the Board's view that is however not the case here. Where in the case considered in T 1831/07 the result (a layer having greater hydrophilicity than another) was fairly straightforward and concrete examples were given (the

question of sufficiency hinging on whether the absence of a concrete method for measuring hydrophilicity meant that the skilled person could not achieve the result), here the nature of the result is not trivial, nor is it straightforward or self-explanatory. Finally, no examples are given. This is only underlined by the failure of the Appellant to produce working examples that achieve the complete function as is understood by the skilled person from paragraph [0029]. Other than the result the patent contains no further information whatsoever, so that the skilled person is at a complete loss as to which direction his endeavours should take.

- 2.10 The Board can but conclude that the alternative embodiment outlined in the paragraph [0029] of the specification and on which the final feature of present claim 1 in any of its forms is based, is not disclosed in a manner sufficiently clear and complete for it to be carried out by the skilled person. In as far as claim 1 of the main and first and second auxiliary requests is directed at this material those requests fail to meet the requirements of Article 83 EPC and are not allowable. The appeal must fail.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

G. Magouliotis

A. de Vries