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**Datasheet for the decision
of 5 July 2012**

Case Number: T 0092/10 - 3.2.04

Application Number: 99943860.9

Publication Number: 1104252

IPC: A47G 19/22

Language of the proceedings: EN

Title of invention:

No-spill drinking cup apparatus

Patentee:

Hakim, Nouri E.

Opponent:

Koninklijke Philip Electronics N.V. (NL)/
Avent Limited (GB)

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 104(1)
RPBA Art 13(1)

Keyword:

"Amendments - added subject-matter (yes) (main request)"
"Apportionment of costs - (no)"
"Late filed requests - admitted (no) (auxiliary request)"

Decisions cited:

-

Catchword:

-



Case Number: T 0092/10 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 5 July 2012

Appellant I: Hakim, Nouri E.
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
10 November 2009 concerning maintenance of
European patent No. 1104252 in amended form.

Composition of the Board:

Chairman: C. Scheibling
Members: A. de Vries
C. Heath

Summary of Facts and Submissions

I. Both the Proprietor and the Opponent filed appeals against the decision of the Opposition Division posted 10 November 2009 concerning the amended form in which the European Patent Nr. 1 104 252 could be maintained.

The Proprietor (Appellant I) filed the notice of appeal on 14 January 2010 and paid the appeal fee on 15 January 2010. The statement setting out the grounds was received 22 March 2010.

The Opponent (Appellant II) filed the notice of appeal on 18 January 2009, simultaneously paying the appeal fee, and filed the statement setting out the grounds on 22 March 2010.

The opposition was based on added subject-matter, as well as lack of novelty and inventive step.

II. Oral proceedings were duly held before the Board on 5 July 2012. At the oral proceedings the parties discussed the issue of added subject-matter for the main request and the 2nd auxiliary request then on file. In response to the Board's finding that these requests both added subject-matter, the Appellant I withdrew these and all other auxiliary requests then on file and replaced them with a new main and a new sole auxiliary request.

III. Appellant I (Proprietor) requests that the decision under appeal be set aside and the patent be maintained in amended form according to a main request or in the

alternative according to an auxiliary request both filed during the oral proceedings before the Board.

Appellant II (Opponent) requests that the decision under appeal be set aside and the patent revoked. Additionally, he requests a different apportionment of costs.

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

Main Request

"A no spill drinking apparatus (7), comprising:
a cap (11) and a cup (22), said cap (11) being removably attachable to and detachable from said cup (22), said cap (11) comprising a soft spout (14, 130, 140);
a valve, said valve comprising a flexible material (126) having an opening (118), said valve further comprising a protruding member (108), said protruding member (108) extending into said opening (118) to block the passage of fluid through said opening, said valve having a resting position and an open position, wherein in said resting position liquid is blocked from passing through said opening (118) and through said spout (14, 130, 140);
a valve holder (31) which holds said valve, said valve holder (31) being attachable to said cap (11) and separable from said cap (11); and
an air vent located in said cap,
wherein the apparatus is configured such that application of negative pressure through said spout (14, 130, 140) causes said flexible material (126) to move, with said opening (118) of said flexible material (42,

126) moving along said protruding member (108) toward said spout (14, 130, 140), such that liquid passes through said opening (118) and out of said spout (14, 130, 140) and further such that air passes into said apparatus through said vent."

Auxiliary Request

Claim 1 is as in the main request but for the following modifications:

The second feature now reads (italics added by the Board indicate what has been added)"*a valve assembly comprising a valve and a valve holder, said valve comprisingsaid spout (14,130,140), and said valve (31)separable from said cap (11), the valve assembly further comprising a flow bridge*".

Additionally, the following text has been added at the end of the claim:

"*,wherein said flow bridge blocks movement of said valve beyond a certain maximum distance and said flow bridge provides a shield preventing the flexible material from damage*".

V. Regarding the decisive issues the Appellant I (Proprietor) argued as follows:

The amendments of the main and auxiliary request address the various points discussed in detail at the oral proceedings. For the blocking function the wording reverts back to that used in opposition.

In claim 1 of the main request the blocking by the protruding member can only reasonably refer to the

blocking of the valve in the rest position mentioned in the same feature.

The feature of the flow bridge in the auxiliary request recites word for word the relevant passage on page 18 of the original publication.

VI. Appellant II (Opponent) argued as follows:

Both requests are very late filed.

Neither request states the requirement that the protruding member perform its blocking function *in the closed position of the valve* as it appears in all original independent claims and as borne out by all the embodiments of the originally published application.

Claim 1 of the auxiliary request fails to properly state the primary function of the flow bridge as indicated on page 18 of the published application. That is to prevent the valve from inverting beyond a point where it can no longer return. This is an intermediate generalization.

The large number of additional requests filed with the reply 5 June 2012 not only do not represent bona fide attempts to address the issues raised, but have required extensive preparation. This justifies a different apportionment.

Reasons for the Decision

1. Both appeals are admissible.
2. *Admissibility*
 - 2.1 Main Request.
 - 2.1.1 The amendments to the main request filed at the oral proceedings are intended to address the various points raised during the discussion of added subject-matter in relation to the then main request at the oral proceedings. This discussion (see also the minutes) had focussed on three amendments: the omission from an independent claim of the feature of the blocking function in connection with the protruding member which appeared in all the originally filed independent claims, and the introduction from the description of the features of a valve holder and an air vent outside of the context in which they originally appeared in the description.
 - 2.1.2 At the oral proceedings the Board held the blocking function to be an integral and inseparable part of the technical teaching of the original disclosure concerning the protruding member. It found that this function was expressly stated in the independent claims and was also borne out by the only detailed embodiments with tapering pin. Furthermore, certain passages in description and claims might allow for a non-tapering shape of the protruding member, nevertheless these passages were open to interpretation as to the exact function of the pin and did therefore not teach directly and unambiguously that such a pin did *not* act

to block the opening. The only direct and unambiguous teaching regarding the protruding member's function that the Board was able to derive from the original disclosure was thus that of blocking liquid passage through the opening. It was therefore unable to find a direct and unambiguous basis for the omission of this feature, which was otherwise consistently presented as essential in the original independent claims.

2.1.3 At the oral proceedings the Board also held that the features of the valve holder and the air vent introduced from the description into claim 1 of the then main request were inextricably tied to other features together with which they appeared originally in the description, see in particular the page 12, last paragraph, to page 13, 2nd paragraph, of the application as published. Thus, the valve holder was originally disclosed as not merely holding the flexible member but the whole valve itself, including the protruding member. Similarly, the air vent was exclusively disclosed as being located in the cap.

2.1.4 The independent claims 1 and 25 of the main request now indicate that the protruding member extends "into said opening to block the passage of liquid through said opening". This formulation repeats the wording used in the corresponding claims that were held allowable by the opposition division, and reflects the terms in which that function was discussed at the oral proceedings before the Board. Both claims are also amended to indicate that the valve holder "holds said valve", which according to the previous feature comprises the flexible material and the protruding member. Finally, both claims now specify that the air

vent is "located in said cap". In each case the amendments are in terms that reflect those used in the discussion of added subject-matter at the oral proceedings. The Board is thus satisfied that they represent a genuine attempt to address those points. For this reason it decided to exercise the discretion afforded it under Article 13(3) RPBA to admit the main request filed at the oral proceedings into the procedure.

2.2 Auxiliary request.

2.2.1 Claims 1 and 25 of the auxiliary request filed at the oral proceedings correspond to those of the 2nd auxiliary request then on file. In addition to the amendments discussed above they include a further amendment intended to describe the primary function of the flow bridge. The flow bridge and its functions had been the subject of a further point raised in the discussion of added subject-matter against the then 2nd auxiliary request. That request incorporated the flow bridge together with its function as a shield for the flexible member into claims 1 and 25 from the description.

2.2.2 At the oral proceedings before the Board the Board concluded from the passage cited as main basis in the originally published application - page 18, 2nd full paragraph - that the main function of the flow bridge was "preventing the valve from inverting beyond a point where it can no longer easily revert to its original position". It saw the shielding function mentioned in the following lines as "in addition" to that first function as being supplementary or subsidiary to it. It

held that the statement on further page 22, first paragraph, that the "valve subunit or another suitable anti-inversion member or flow bridge ... can further serve to block excessive inversion" to be irrelevant to the question of the relationship of the two functions, as that passage makes no mention of the second function at all. It further held that the primary function implied clear limitations as regarding the placement of the flow bridge which were not necessarily implicit in the shielding function. For these reasons the Board concluded at the oral proceedings that introduction from the description of the feature of the flow bridge but without specifying its main function of preventing excessive inversion detailed in the description extended beyond the original disclosure.

2.2.3 The relevant amendment to claims 1 and 25 however does not fully address these points. Instead of expressly stating that the flow bridge serves to prevent excessive inversion as described in the application as filed it rather indicates that it "blocks movement of said valve beyond a certain maximum distance" in addition to its shielding function. This formulation may recite word for word that used in lines 12 to 13 of page 18 of the originally published application, it nevertheless fails to define the flow bridge's anti-inversion function in its full specificity as set out in the following lines 14 to 15 of page 18. That specific function moreover implies limitations on the location of the flow bridge (on the inverting and not the other side of the valve) and at a defined, verifiable distance, namely beyond which the valve cannot revert to its original position. Stating that movement is blocked "beyond a certain maximum distance"

sets no such clear limits, and consequently offers a much broader (and indeed unclear) definition of the flow bridge's primary function compared to what the skilled person derives from the 2nd paragraph of page 18 when read in its entirety. This amendment therefore results in an intermediate generalization of the specific disclosure of the flow bridge and its function, adding subject-matter that extends beyond the original disclosure, contrary to Article 123(2) EPC, see the Case Law of the Boards of Appeal of the EPO, 6th edition, 2010 (CLBA hereafter), III.A.2. For this reason the Board decided to use its discretion under Article 13(3) RPBA not to admit this request into the procedure.

3. Main Request: Added subject-matter

3.1 Though claims 1 and 25 now state that the protruding member extends through the opening of the flexible material "to block passage of liquid through said opening", it does not expressly state that it performs this blocking function *in the closed position* of the valve. All the original independent claims 1, 6, 16 and 18, link the blocking function to the closed position, for example, original claim 6 on which present claim 1 is said to be based requires that "said closed position being a configuration in which said protruding member extends through said opening ... to block ...". That link is now missing. That the member blocks in a closed position is also not implicit from the further requirement in claim 1 that liquid is blocked from passing through the opening in a resting position of the valve. That statement need not refer to the blocking by the protruding member; for example, a

narrow pin in a wide opening with no sealing function can also said to block passage to some extent. This argument further assumes that the resting position and the closed position are one and the same, but this need not be so.

- 3.2 The prominence given the link between blocking by the protruding member and the closed position is also reflected in the description. The only passage that provides specific detail of the protruding member, page 23, first complete paragraph, is quite unequivocal as to the central function of the tapered pin 108: tightly extending through the orifice it "forms a seal against fluid flow"; and again the orifice sits snugly against the pin's wider diameter portion "to form a tight seal".

No other passages in the original disclosure provide a clear and unambiguous teaching that this might be otherwise. The Board had already found that, for the subsequently withdrawn main request, none of the cited passages provided *direct and unambiguous* support for a pin without a blocking function (see above). Thus, original claim 16 is open to interpretation: is it the valve member resting proximal to the base - but then why proximal? - or the immediately following protruding member extending through said opening that serves to block the passage of liquid? Page 16, first complete paragraph, indicates that the protruding member is part of the centre stop or seal, but does not in fact specify any function. Page 22, second complete paragraph, is equally silent, but does refer to the protruding member as "male sealing member", which if anything suggests quite the opposite, that the member

seals i.e. blocks in the closed position. Page 24, first complete paragraph, in a reasonable reading also supports sealing action of the cone-like member (the valve being pulled off the tapered cone, off its base to open the valve).

If none of the cited passages provide *direct and unambiguous* disclosure of a pin that does not block, they do so even less for a pin that blocks but not necessarily in the closed position.

- 3.3 This blocking action in the closed, sealing position of the valve has clear implications on dimensioning and positioning of the protruding member. In the example cited earlier, a narrow pin in a wide membrane opening and serving merely as a guide for the membrane can always be said to block passage of fluid to some extent, but would not itself seal the valve. To block liquid passage in the closed position means that the member must fit snugly or tightly in the membrane opening to close the valve.
- 3.4 From the above the Board concludes that nothing else is taught in the original disclosure other than that the protruding member blocks liquid passage in the closed position of the valve. This was originally and consistently stated in the independent claims as an important part of the invention, and follows also from the only direct and unambiguous description of the member's function as central to sealing. Its omission thus results in a new, modified teaching for which there is no basis in the original disclosure and so adds subject-matter extending beyond that original disclosure, contrary to the requirements of Article

123(2) EPC, see also CLBA, III.A.7.2. The main request is thus not allowable. As it is the sole request remaining in the proceedings, the patent at which it is directed must be revoked.

4. Apportionment of costs

4.1 The Appellant-Opponent takes issue with the number of requests that were filed shortly before the deadline for filing submissions before the oral proceedings. Considering the stage at which they were filed, that number would be unreasonable and entailed an undue amount of preparation so soon before the oral proceedings.

4.2 In the Board's view what is reasonable or fair will depend on the particular circumstances of a case. Questions that might need to be considered in this regard are: how complex are the amendments and has a genuine attempt been made to explain how they address grounds; and, importantly, can they be dealt with in a reasonable time frame, that is without compromising procedural economy?

4.3 In the present case eight requests in all were filed shortly before expiry of the time limit for filing submissions in preparation of the oral proceedings. The accompanying letter sets out in fair detail how the amendments address the issues raised in the annex to the summons.

4.4 It is true that analysis of the requests was hampered by the absence of an exact and comprehensive indication of the amendments made, such as in the form of a mark-

up version. Nevertheless, the amendments were not so complex and the accompanying letter not so cursory that the Board was not able to assess the amendments and their relevance to the main issues within a reasonable timeframe and with reasonable effort. In its estimation a duly qualified and experienced representative would not have required significantly more time or effort to assess the claims. The Board adds the amendments also appear to represent genuine, if unsuccessful attempts to address the issue of added subject-matter. The Board consequently finds that the Appellant-Opponent has not been unreasonably or unduly burdened by the requests beyond what can be fairly expected in the course of an appeal and that therefore a different apportionment of costs would not be equitable, Article 104(1) EPC.

Order

For these reasons it is decided that:

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

The Registrar

The Chairman

G. Magouliotis

C. Scheibling