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**Datasheet for the decision
of 18 June 2014**

Case Number: T 1946/10 - 3.2.04

Application Number: 01104778.4

Publication Number: 1129657

IPC: A47L5/36

Language of the proceedings: EN

Title of invention:

Electric cleaner

Patent Proprietor:

Panasonic Corporation

Opponent:

Dyson Technology Limited

Headword:

Relevant legal provisions:

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

Keyword:

Amendments - added subject-matter (yes) -
extension beyond the content of the application as filed (yes
) - disclosure in drawings

Decisions cited:

G 0002/10

Catchword:



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Chambres de recours**

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Case Number: T 1946/10 - 3.2.04

**D E C I S I O N
of Technical Board of Appeal 3.2.04
of 18 June 2014**

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 16 July 2010
revoking European patent No. 1129657 pursuant to
Article 101(2) EPC.**

Composition of the Board:

Chairman A. de Vries
Members: J. Wright
C. Heath

Summary of Facts and Submissions

- I. The Appellant (proprietor of the patent) lodged an appeal, received on 16 September 2010, against the decision of the opposition division of the European Patent Office posted on 16 July 2010 revoking European patent No. 1129657 pursuant to Article 101(2) EPC. The appeal fee was paid simultaneously. The statement setting out the grounds of appeal was received on 25 November 2010.

Opposition was filed against the patent as a whole and based *inter alia* on the opposition ground mentioned in Article 100(c) together with 123(2) EPC (extension of subject matter). The opposition division held that this opposition ground prejudiced the maintenance of the patent.

- II. Oral proceedings were duly held before the Board on 18 June 2014.
- III. The Appellant requests that the decision under appeal be set aside and the opposition rejected based on the patent as granted as main request (with unamended description as requested at the oral proceedings before the Board). Alternatively, he requests that the decision under appeal be set aside and the patent be maintained in an amended form, according to the claims of the auxiliary request filed with letter of 16 May 2014 (then second auxiliary request).

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

IV. Claim wording

The wording of claim 1 according to the main request (as granted) is as follows:

"An electric cleaner comprising:

a main body provided with a cleaner housing (20) containing therein an electric blower (21) for generating suction force and a pair of wheels (27) mounted on said cleaner housing (20) for mobility on a floor surface; a suction nozzle (22) for suctioning dust on the floor surface being cleaned through an extension pipe (24) and a hose (23) with the suction force of said electric blower (21); and a dust chamber (31) for collecting dust, said chamber located in a portion along an air passage from said suction nozzle (22) to said electric blower (21), wherein both side surfaces (A36) of said main body extend outwardly beyond rim portions (35) of said respective wheels (27) that stay in contact with the floor surface, and the center of gravity "G" (40) of said main body is placed in a position so that said main body rolls toward a direction where said wheels (27) stand on the floor surface,

characterized in that said main body is generally spherical or generally spherically polyhedral in shape so as to return itself into the original posture when said main body tilts in a way that any point of the side surface lies in contact to the floor, wherein said rim portions (35) do not protude therefrom."

Claim 1 according to the auxiliary request is the same as claim 1 of the main request except that the feature "and a pair of wheels (27) mounted on said cleaner housing (20) for mobility on a floor surface;" is

reworded to read (added text emphasised in *italics* by the Board): "and a pair of wheels (27) mounted on *both side surfaces (A36)* of said cleaner housing (20) for mobility on a floor surface;" and wherein the characterising portion is reworded to read:

"characterized in that said main body is generally spherical or generally spherically polyhedral in shape, wherein said rim portions (35) do not protrude therefrom so as to return itself into the original posture when said main body tilts in a way that any point of the side surface lies in contact to the floor."

V. The Appellant's arguments can be summarised as follows:

Claim 1 of both main and auxiliary requests includes the feature F10 "wherein said rim portions do not protrude therefrom". The word "therefrom" should be interpreted as referring to the generally spherical shape of the main body, rather than the main body per se. However an alternative interpretation is that "therefrom" refers to the main body per se, of which the wheel rims are a part.

Considering the alternative interpretation, the feature F10 merely clarifies that the wheel rims do not protrude beyond themselves, so no subject matter is added by the feature.

Considering the first interpretation above, the structure of F10 is clearly disclosed in figures 1 to 8 and 10 to 30 of the application as filed which show wheel rims that do not protrude from the generally spherical shape of the main body. Furthermore the skilled person immediately recognises that because the rims do not protrude, they contribute to the vacuum

cleaner being able to right itself by not hindering the vacuum cleaner when rolling into an upright position. Thus also the function of F10 is immediately clear from these figures. The feature F10 is less clearly disclosed in figure 9, where the wheels are arranged underneath rather than at the sides of the housing. However, it is not contradicted by figure 9.

Furthermore feature F10 can be incorporated into claim 1 isolated from other features shown in the drawings without adding subject matter. The rims are part of the wheels, but these have been claimed. However, they are independent of other features shown in the drawings such as the battery pack in the housing.

In claim 1 of the auxiliary request, the wheels are specified to be mounted on the side of the housing so that the embodiment of figure 9 is excluded. Since the feature F10 emerges clearly from figures 1 to 8 and 10 to 30, no subject matter is added for the same reasons as for the main request.

VI. The Respondent's arguments can be summarised as follows:

The only meaningful interpretation of the feature F10 is that the word "therefrom" refers to the generally spherical shape of the main body.

Figure 9 contradicts the feature F10, since extrapolating the circular profile of the main body shows the rims to protrude beyond the circle, therefore the feature F10 cannot be said to be unambiguously disclosed by the drawings and supporting description of the application as filed.

F10 is not directly and unambiguously derivable from the remaining figures 1 to 8 and 10 to 30 because,

being a negative feature, the skilled person would not directly and unambiguously recognise it. Even if he did, it is not an isolated feature but only disclosed in combination with other features which have not been claimed such as hemispherically shaped wheels.

With regard to the auxiliary request, merely excluding the arrangement shown in figure 9 from claim 1 does not change the fact that the feature is not directly and unambiguously derivable from the remaining figures for the same reasons as for the main request. Therefore including feature F10 in claim 1 extends its subject matter beyond the application as filed.

Reasons for the Decision

1. The appeal is admissible.
2. Background

The patent concerns a household vacuum cleaner of the kind having a housing containing an electric blower and which rolls on a pair of wheels. To vacuum-clean a user pulls the housing behind him on a hose. A problem with such cleaners is that they may topple over when riding over an obstacle and remain there until righted by the user, see patent specification paragraphs [0001] and [0002]. The main aim of the invention is to provide a vacuum cleaner which returns to its normal posture after tilting sideways, in other words a self-righting vacuum cleaner, see specification paragraph [0007].

Claim 1 of the main request (as granted) and auxiliary request both add, amongst others, the feature "wherein [wheel] rim portions do not protrude therefrom" to

claim 1 as originally filed. This feature is referred to as feature F10 and was added to claim 1 during examination leading to grant. In the decision under appeal the opposition division held that this amendment added subject-matter contrary to the requirements of Article 123(2) EPC and this is the sole contentious issue with which the present decision is concerned.

All parties acknowledge that the feature has no literal basis in the original documents as filed. The issue to be decided is whether the skilled person would derive the feature "directly and unambiguously using common general knowledge" from the whole of the documents filed, that is the description, claims and drawings read as a whole (see e.g. G0002/10 OJ 2012, 376, reasons 4.3, first paragraph).

3. Interpreting the claim

3.1 A first issue the board must consider before deciding whether information has been added is how the added feature F10 is to be interpreted. In particular it is not immediately apparent from the claim's wording what the word "therefrom" refers to. It may refer to any of the "main body", its "generally spherical or generally spherically polyhedral shape" or the "side surface" mentioned in the immediately preceding lines of the characterizing part. The appellant has argued that it would refer to the main body shape, or, in more recent submissions, to the main body. In the context of this latter interpretation, he argues that as the description defines the wheels as part of the main body (see specification column 4, lines 35 to 36) the feature would then merely state what is implicitly true: that the wheel rims, being part of the wheels and therefore part of the main body cannot protrude beyond

themselves and feature F10 would therefore not represent a true technical limitation.

3.2 According to established jurisprudence the skilled person interprets a claim with a mind willing to understand, so as to arrive at an interpretation which is technically sensible and takes into account the whole disclosure of the patent. See Case Law of the Boards of Appeal, 7th edition, 2013 (CLBA), II.A.6.1, and the decisions cited therein. Though he strives in principle to understand a claim within the wording and terms of the claim itself, he may, where he encounters ambiguities, need to consult the description and drawings to gain a better understanding.

3.3 In the present case he will therefore need to refer to any relevant passages that may inform him as to how wheel rims might protrude. The only part of the granted patent that mentions "protruding wheel rims" is patent specification paragraph [0005], which was added in examination to cite and summarise the relevant prior art.

Here the skilled person learns that, once tilted onto its side, a prior art vacuum cleaner with dome shaped sides is prevented from self-righting "due to its protruding wheel rims". In the light of this sole passage the skilled person understands that feature F10 is meant to differentiate the vacuum cleaner from that of the prior art, where the wheel rims protrude from the general spherical shape formed by the two dome shaped wheels. This means that in the claimed invention feature F10 is meant to convey the information that wheel rims must not protrude beyond the generally spherical or spherically polyhedral shape of the body, so that they do not impede the tilted vacuum cleaner

from righting itself. In other words "therefrom" is understood as referring to the overall shape of the main body. Feature F10, read in the light of the description, therefore does represent a definite technical limitation vis-a-vis the prior art (hence its placement also in the characterizing part of the claim).

Such a reading is also seen to be consistent with the overall self-righting aim of the invention as wheel rims that do not stick out beyond the overall spherical shape of the body will offer no resistance when the cleaner rolls back to its upright position.

4. Added subject matter, main request
- 4.1 With the above understanding of feature F10 and the technical information conveyed thereby, the Board must now decide whether the skilled person can derive this information directly and unambiguously from the application documents as originally filed. As stated, it is common ground that there is no literal basis for the feature F10 in the as filed description and claims. The appellant argues that it would be derivable from the figures when considered in conjunction with the description, where he cites paragraphs [0005], [0007] and [0014] of the application as published.
- 4.2 According to established jurisprudence, see CLBA, II.E. 1.2 and the case law cited therein, it will normally not be admissible under Article 123 (2) EPC to extract isolated features from a set of features originally disclosed only in combination in a particular embodiment unless the skilled person recognizes without a doubt that the isolated feature is unrelated to those other features structurally or functionally and may be

applied in a more general context. Where features are added from figures, their structure and function must be clearly, unmistakably and fully derivable from the figures, as well as the fact that they can be isolated from the other features shown but not claimed, CLBA, II.E.1.5.

4.3 As stated in paragraph [0006] the figures present different views of various embodiments of an electric cleaner of the invention (figures 32 to 34 concern prior art cleaners). As is immediately clear from figures 1 to 30 the subject cleaner is a vacuum cleaner which has a main body containing the fan and dust collector and which is generally spherical (or spherically polyhedral - figure 6) in shape. In the cross-sections and front views of figures 3 to 15, 20 to 23 and 27 that generally spherical shape is without protrusions. In the majority of the figures 1 to 8 and 10 to 30 the wheels indicated at 27 or 49 (figure 10), see description, form convex side sections or segments of that shape and are an integral part of the main body shape defined by wheels and cleaner housing 20, see also paragraph [0007] of the published application. At their internal sides the wheels are shown as forming mainly flat rims which contact the floor surface when the cleaner is upright.

4.4 In figures 1 to 8 and 10 to 30 it can indeed be said that the wheel rims do not protrude beyond the generally spherical shape of the main body but are contained within that shape. See for example figure 3 where the wheel rims are indicated at 35. However, the Board believes that the presence of the feature will be discernible only for an eye that is seeking to confirm rather than discover it for the first time i.e. an eye that is already informed by the present discussion and

the relevant prior art. It does not believe that a skilled person approaching the figures and corresponding text for the very first time and without knowledge that particular prior art is cited against it would positively identify this feature or would recognize it as in some way significant in particular in relation to the main purpose of the invention.

- 4.4.1 Firstly the figures show many different features, many of which are mentioned in the description some specifically in the context of self-righting, cf. paragraphs [0010], [0011], [0012], [0013] of the published application discussing distance between rims, side rolling surfaces, or batteries projecting into the spaces inside the wheels to lower the centre of gravity. As noted, that the rims protrude or not is not mentioned anywhere in the description (or claims) as filed.
- 4.4.2 Secondly, from the figures and associated description passages, the Board is unconvinced that the skilled person would attach any significance to the *form* of the rims in the context of the overall aim of self-righting. The only information the description and claims gives him in relation to the rims and self-righting is that the distance between the rims is less than the width of the main body, see published application, paragraphs [0010], [0027] and claim 6. However the skilled person is given no information about the *shape* of the rims relative to the main body or any associated effect, let alone told that they may not protrude beyond the overall spherical shape of the main body.
- 4.4.3 Nor can the non-protrusion of the rims be said to be consistently taught by the figures. Figure 9, described

in paragraph [0014], shows an embodiment in which wheels 45 project from the bottom flat surface of the main body. If the circle of the circumference of the body cross-section is completed in figure 9 the wheels are found to extend beyond that circle, and must therefore protrude beyond the general spherical shape of the main body. Even if the skilled person recognizes that the embodiment of figure 9 is rather different from that of the other figures, the fact that it does show protruding rims means that when he considers the figures and description together, as a whole (as he must), he is highly unlikely to draw therefrom a single clear teaching that the rims should not protrude.

4.4.4 This is not changed by the information in published application paragraph [0014] where he learns that a margin of projection of the wheels should allow the main body to roll over the wheels. Far from saying that the wheel rims (that is the outer edges of the wheels) can never protrude beyond the spherical shape of the main body, if anything the statement suggests that a small protrusion (margin of projection) can be tolerated. Indeed there is nothing in this passage that suggests that such a projection is in some way disadvantageous or less preferred and which might have drawn attention to the alternative rim arrangement and its significance in the other figures. For this reason the Board also does not believe that paragraph [0014] when read in conjunction with the figures would inexorably lead the skilled person to recognize feature F10 and its significance in the figures.

4.4.5 Paragraphs [0005] and [0007] of the published application equally fail to provide any pointers to feature F10. That the side surfaces of the main body extend outwardly beyond the main body, paragraph

[0005], composed of the housing and wheels, paragraph [0007], relates to the width or lateral extent of the body relative to the inter rim distance as explained in more detail in paragraph [0010]. This has no implications for the mainly downward protrusion of the rims, let alone that it excludes that the rims extend beyond the sphere shape.

4.5 Finally, even if the skilled person could directly and unambiguously derive the feature F10 from the drawings and description, which the Board finds not to be so, the feature in any case appears to be one feature of an interrelated set of features making up complex embodiments, and has thus been added in isolation from that specific context resulting in an unallowable generalisation.

4.5.1 The various factors involved in self-righting are discussed mainly in relation to the first embodiment of figures 1 to 8, see published application paragraphs [0009] to [0013], but apply equally to the further embodiments of figure 10 to 30. Figures 1 to 8 show various views of the first vacuum cleaner according to the invention. Here the wheels are partly hollow hemispherical wheels. The connection pipe 25 is freely rotatable with respect to the hose 23 (see published application figure 1 and paragraph [0013]).

4.5.2 The effects of this complex configuration are explained in the published application paragraphs [0009] to [0013]. In particular the wheel's hemispherical shape provides side rolling surfaces for rolling back into the upright position (paragraph [0011]). Making them partly hollow allows the heavy batteries to extend into spaces in the wheels, thereby lowering the centre of gravity (paragraph [0013]). This enables the cleaner to

gain greater rotational momentum when righting itself (see paragraph [0012]). Lastly, the freely rotatable hose allows the main body to roll without the hose twisting (paragraph [0013]). All of these features interact to produce the claimed invention's main aim of a self-righting vacuum cleaner. They combine to produce this effect and are thus closely linked. That the skilled person will immediately recognize that any of these features can be considered in isolation and in a more general context is not immediately apparent to the Board.

4.5.3 The feature of the wheel rims not extending beyond the spherical shape of the body is thus set in a tight structural and functional context. Its exact role is neither identified in the original text, nor immediately apparent from the figures. However it is only one feature among several that produces the desired effect of a self-righting cleaner. Lifting it out of this context and adding it in isolation to the claim therefore represents a generalisation of the specific structural and functional context in which the feature originally appears. At the same time it raises the featured to prominence and gives it a significance over the remaining features that have not been claimed, which it does not have in the original disclosure.

4.6 Therefore, adding F10 to original claim 1 isolated from its context in the figures from which it is said to derive, presents a new teaching not originally disclosed, contrary to article 123(2) EPC.

5. Added subject matter, auxiliary request

The Board's finding in respect of claim 1 of the main request also applies to claim 1 of the auxiliary

request. Claim 1 of the auxiliary request adds to claim 1 of the main request that the pair of wheels are mounted on both side surfaces of the cleaner housing. This feature distinguishes the claim from the embodiment shown in figure 9, where wheels 47 are mounted at the bottom surface 44 of the housing. However, as explained above for the main request, since the structure and function of the feature F10 is also not directly and unambiguously derivable from the remaining embodiments (figures 1 to 8 and 10 to 30), the feature adds subject matter. Furthermore, as also explained above, it represents an inadmissible generalisation of those embodiments. Merely qualifying that the wheels are mounted on the sides of the housing still leaves other features out of the claim that were originally disclosed in combination with feature F10. For example hollow hemispherical wheels and a freely rotatable hose, as explained above for the main request. On both accounts, this results in added subject matter contrary to Article 123(2) EPC.

6. The Board concludes that claim 1 according to both the main and auxiliary request is not allowable under Article 123(2) EPC. Therefore the ground for opposition under Article 100(c) EPC with Article 123(2) EPC prejudices the maintenance of the European Patent. The Board therefore confirms the appealed decision to revoke the patent.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated