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Datasheet for the decision of 24 September 2014

Case Number: T 1247/11 - 3.2.06

Application Number: 03026417.0

Publication Number: 1405683

IPC: B21D51/26

Language of the proceedings: EN

Title of invention:
Apparatus and method for deforming thin walled bodies

Patent Proprietor:
Envases (UK) Limited

Opponents:
Mall + Herlan Italia Srl
Mall + Herlan Schweiz AG

Relevant legal provisions:
EPC Art. 105, 112, 123(2)
EPC 1973 Art. 114(2)
RPBA Art. 13(1)

Keyword:
Intervention of the assumed infringer - admissible (yes)
Amendments -
extension beyond the content of the application as filed (yes)
Referral to the Enlarged Board of Appeal - (no)

Decisions cited:
G 0002/10

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Case Number: T 1247/11 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 24 September 2014

Appellant: (Patent Proprietor)	Envases (UK) Limited Unit 1 Christchurch Road, Baglan Industrial Park Port Talbot SA12 7BZ (GB)
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Party as of right: (Opponent 3)	Mall + Herlan Schweiz AG Austrasse 6 8505 Pfyn (CH)
Representative:	Eisenführ Speiser Patentanwälte Rechtsanwälte PartGmbB Anna-Louisa-Karsch-Strasse 2 10178 Berlin (DE)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 14 April 2011 concerning maintenance of the European Patent No. 1405683 in amended form.**

Composition of the Board:

Chairman	M. Harrison
Members:	G. Kadner
	W. Sekretaruk

Summary of Facts and Submissions

I. The mention of grant of European patent No. 1 405 683, on the basis of European patent application No. 03026417.0 filed as a divisional application on 9 February 2001 and claiming GB-priorities from 10 February 2000 and 27 October 2000, was published on 24 January 2007.

II. Two notices of opposition, in which revocation of the patent on the grounds of Articles 100(a), 100(b) and 100(c) EPC was requested, were filed against the granted patent.

By way of its decision posted on 14 April 2011, the opposition division found that the main request did not meet the requirement of Article 123(2) EPC. Although this requirement was met by the subject-matter of claim 1 according to the first auxiliary request, it was however not deemed to be inventive. Account being taken of the amendments made by the patent proprietor during the opposition proceedings according to the second auxiliary request, the opposition division decided that the patent and the invention to which it related met the requirements of the Convention.

Independent claims 1 and 4 as granted read:

"1. Apparatus for use in deforming a predetermined wall zone of a thin walled container (1), the apparatus comprising:

i) a tooling arrangement comprising internal tooling (11) to be positioned internally of the container, external tooling (13) to be positioned externally of the container, the internal tooling (11) being moveable relative to the container wall between

a first tooling configuration in which the internal tool can be inserted into or retracted from, the interior of the container; and
a second wall engaging configuration for effecting deforming of the wall zone; and
ii) a reorientation arrangement (104, 105) to rotationally co-align the container and the tooling with respect to one another for deformation of the wall zone;
wherein the reorientation arrangement is first operable to rotationally co-align the container and the tooling with respect to one another, and with the tooling and container in fixed rotational orientation the predetermined wall zone of the container (1) is deformed between the internal and external tooling (11, 13), the internal and external tooling moving translationally only without rotation from the first configuration to the second, wall engaging configuration thereby to effect deformation at the predetermined wall zone.

4. A method of deforming a thin walled container (1) at a predetermined wall zone comprising:
rotationally co-aligning with respect to one another the container (1) and a tooling arrangement comprising internal tooling (11) to be positioned internally of the container and external tooling (13) to be positioned externally of the container;
with the container and tooling in fixed rotational orientation;
i) advancing the tooling (11, 13) arranged in a retraction/insertion configuration such that the internal tooling is positioned adjacent and exterior (13) to the predetermined wall zone of the container; and
ii) moving the tooling to a wall engaging configuration for effecting deforming of the wall

zone, wherein the internal and external tooling (11, 13) moves translationally only without rotation to effect deformation."

III. Notices of appeal were filed against this decision by appellant I (opponent 1) on 9 June 2011, by appellant II (patent proprietor) and by appellant III (opponent 2) on 14 June 2011, and the appeal fees were paid simultaneously. The respective grounds of appeal were filed within the prescribed time-limit.

IV. On 2 July 2014 the parties were summoned to oral proceedings, and in a communication dated 26 August 2014 the Board expressed its preliminary view that it considered the opposition division's conclusion in respect of the main request to be correct. The first auxiliary request seemed to give rise to problems under Article 123(2) EPC, and the proprietor's arguments in respect of inventive step did not seem persuasive. The same problems under Article 123(2) EPC seemed to be present in the second auxiliary request. The Board also commented that if the amendments to the claims were considered to be clearly and unambiguously disclosed in the application as originally filed, inventive step then did not seem to be in doubt.

V. On 12 August 2014 a third party (opponent 3) filed an intervention (Article 105 EPC).

VI. With letter dated 16 September 2014, appellant II (proprietor) filed auxiliary requests 3 and 4.

VII. With letter dated 19 September 2014, appellant III (opponent 2) withdrew its opposition.

XIII. Oral proceedings were held before the Board on 24 September 2014, during which appellant II (proprietor) filed amended auxiliary requests 1 to 4.

Appellant II (patent proprietor) requested that the decision under appeal be set aside and the European patent be maintained as granted or on the basis of any of the auxiliary requests 1 to 4, all filed 24 September 2014.

It further requested referral of a question to the Enlarged Board of Appeal.

Appellant I (opponent 1) and the intervener (opponent 3) requested that the decision under appeal be set aside and that the European patent No. 1405683 be revoked.

IX. The claims

A) The order of the apparatus and method claims according to auxiliary request 1 has been changed with respect to the claims as granted such that claim 1 reads (with respect to granted claim 4 deletions being shown by strike-though and additions by underlining):

1. A method of ~~deforming a thin walled container (1) at a predetermined wall zone comprising~~ necking or shoulder forming a thin-walled aluminium material aerosol container (1) having a wall thickness in the range 0.25mm to 0.8mm and also embossing the wall of the container at a predetermined zone to co-ordinate with a pre-printed design, the method being carried out on an apparatus comprising a vertically orientated multi-station tooling table (6) having a plurality necking/ shoulder forming stations (7) for performing successive stages in a necking/shoulder forming process, the

tooling table comprising, in addition to the necking/ shoulder forming tooling stations, an embossing station (9) comprising an embossing tooling arrangement; the containers being held at a vertically orientated holding table (3) facing the tooling table for both the necking and the embossing operations; and the holding table (3) being operated to rotate about a horizontal axis to be rotationally indexable relative to the tooling table (6) to bring the containers in succession to successive tooling stations (7); by means of one of either rotation of the tooling or rotation of the container rotationally co-aligning with respect to one another the container (1) and ~~a~~ the embossing tooling arrangement comprising internal embossing tooling (11) to be positioned internally of the container and external embossing tooling (13) to be positioned externally of the container;

with the container and tooling in fixed rotational orientation;

i) advancing the tooling table (6) with tooling (11, 13) arranged in a retraction/insertion configuration such that the internal tooling is positioned adjacent and interior to the predetermined wall zone of the container; and the external tooling is positioned ~~exterior (13) to the predetermined wall zone of the container~~ externally of the container spaced (*wrongly used expression "spacer" corrected by the Board*) adjacently from the container wall; and moving the internal tooling part (11a, 11b) to lie against the container wall

ii) moving the tooling to a wall engaging configuration for effecting deforming of the wall zone, wherein the internal and external tooling (11, 13) moves translationally only without rotation to effect deformation;

wherein the container is supported in a holding station (4) during the deforming of the wall zone, the tooling being provided at a separate tooling station (7).”

B) Claim 1 according to auxiliary request 2 has the following wording (with respect to granted claim 1 deletions being shown by strike-though and additions by underlining):

Apparatus for use in ~~deforming a thin walled container (1) at a predetermined wall zone comprising~~ necking or shoulder forming a thin-walled aluminium material aerosol container (1) having a wall thickness in the range 0.25mm to 0.8mm, and also embossing the wall of the container at a predetermined zone to co-ordinate with a pre-printed design, the apparatus comprising a vertically orientated multi-station tooling table (6) having a plurality necking/shoulder forming stations (7) for performing successive stages in a necking/shoulder forming process, the tooling table comprising, in addition to the necking/shoulder forming tooling stations, an embossing station (9) comprising an embossing tooling arrangement; the containers being held (*aux 3) at a vertically orientated holding table (3) facing the tooling table; and the holding table (3) being operated to rotate about a horizontal axis to be rotationally indexable relative to the tooling table (6)to bring the containers in succession to successive tooling stations (7); the apparatus comprising:

i) ~~a~~ an embossing tooling arrangement comprising internal embossing tooling (11) to be positioned internally of the container, external embossing tooling (13) to be positioned externally of the container, the internal embossing tooling (11) being moveable relative to the container wall between a first tooling configuration in which the internal

tool can be inserted into or retracted from, the interior of the container; and
a second wall engaging configuration for effecting deforming of the wall zone; and
ii) a reorientation arrangement (104, 105) to rotationally co-align the container and the tooling with respect to one another for deformation of the wall zone by means of one of either rotation of the tooling or rotation of the container;
wherein the reorientation arrangement is first operable to rotationally co-align the container and the embossing tooling with respect to one another, and with the embossing tooling and container in fixed rotational orientation the predetermined wall zone of the container (1) is deformed between the internal and external tooling (11, 13), the internal and external tooling moving translationally only without rotation from the first configuration to the second, wall engaging configuration thereby to effect deformation at the predetermined wall zone."

C) Independent claim 3 according to auxiliary request 3 is based on claim 1 of auxiliary request 2. Into the first paragraph of that claim (see item B above), the underlined portion of the following text has been inserted at the location given by "(*aux 3)":

"... the containers being held in a clamp at a vertically orientated holding table (3) facing the tooling table".

Additionally, at the end of feature ii), the wording:

"by means of one of either rotation of the tooling or rotation of the container"

has been replaced by:

"wherein said reorientation arrangement comprises:
a) means for optically viewing the container to determine its orientation relative to datum situation;
b) means for automatically rotating the container about its longitudinal axis if the orientation of the container differs from the desired datum situation;
c) means for inserting the container automatically into the clamp"

D) Independent claim 3 according to auxiliary request 4 is based on claim 3 of auxiliary request 3. The amended text at the end of feature ii) has been replaced by the wording (added text underlined by the Board):

"wherein said reorientation arrangement comprises:
a) means for optically viewing the container to determine its orientation relative to datum situation, immediately prior to the container being placed in the clamp and secured;
b) means for automatically rotating the container about its longitudinal axis to bring the container into the preset datum situation if the orientation of the container differs from the desired datum situation;
c) means for inserting the container automatically into the clamp of the holding station with the container in the desired datum position and clamping the container securely"

E) The question which the proprietor requested be referred to the Enlarged Board of Appeal reads:

"In order to generalise from a specific embodiment the case law establishes that it is a requirement to show:

(i) the absence of any clearly recognisable functional or structural relationship among the features of the specific combination and

(ii) that the extracted feature is not inextricably linked with those features.

Is it sufficient that this be shown by the absence of any positive finding either that there is a clearly recognisable functional or structural relationship among the features of the specific combination and/or an absence of a positive finding that there is specific feature with which the extracted feature is inextricably linked?"

XIII. The arguments of the appellant/proprietor can be summarized as follows:

With regard to the main request, the starting point was claim 35 of the parent application. Feature ii), which was related to the reorientation arrangement, defined the general function of the coordination of the container with the tooling, and was clearly disclosed in the parent application (PA = WO-A-01/58618). It covered all the alternatives of relative movement of the tooling and the container and therefore complied with Article 123(2) EPC. Support was found in the general description as well as in the description of the first embodiment (page 10, lines 13 to 21) where it was stated that the coordination of the container with the tooling to effect deformation was crucial.

The term "reorientation arrangement", although not literally disclosed, was another expression or "label" for the means for effecting the reorientation of the container with the tooling. In the mind of the skilled

person it was clearly disclosed since the means to effect the reorientation could easily be identified when considering the function of co-alignment as described. A rotation of the clamping stations or chucks was not necessary in the first embodiment, but was not excluded according to the second embodiment. The specific way of performing the reorientation was not an essential feature and could therefore be omitted. From the description of the parent application (page 10, lines 13 to 21) the skilled person would clearly derive that the reorientation of the container with the tooling was crucial, and was easily in a position to recognize the meaning of this feature. The best way of carrying out the invention was also clearly disclosed according to the description of the first embodiment. In any case, although the claim was rather broad and covered other possibilities of reorientation, it was disclosed in its general form and should therefore be allowed.

The newly filed first auxiliary request overcame the objections made in the Board's communication and should therefore be admitted into the proceedings. The vertical orientation of the holding table had been inserted, and in claim 3 the containers being held "in a clamp" had been added, thus reflecting the literal disclosure in the application as filed, and therefore the objections made in the Board's communication with respect to Article 123(2) EPC had been overcome.

Claim 1 according to the second auxiliary request was again based on the apparatus claim 3 of the first auxiliary request and had further been restricted by the insertion of features disclosed in paragraphs [0007] and [0011] (page 2, line 6 and page 3, lines 25 to 27 of the parent application). To the skilled person it was made clear that reconfiguring of the tooling was

advantageous. However, reorientation of the container was not excluded by this wording. The skilled person would immediately recognize that the means disclosed in paragraphs iii) and iv) (page 3) were also applicable in the second embodiment described on page 19, starting in line 24.

In claim 1 according to the third auxiliary request, with respect to that of the second auxiliary request, the reorientation arrangement (feature ii) had been formulated in detail by the means which were clearly and unambiguously disclosed in the parent application. For a skilled reader it was made clear that, in order to be able to carry out the reorientation as described, the reorientation arrangement must necessarily comprise the means a), b) and c) for optically viewing the container to determine its orientation relative to the datum situation, for automatically rotating the container about its longitudinal axis if the orientation of the container differs from the desired datum situation and for inserting the container automatically into the clamp. The functional features had only been reformulated as means for effecting the function within the apparatus.

Claim 1 according to the fourth auxiliary request was even more restricted by the detailed description of the means used in the reorientation arrangement and their functional relationship. At least this request should therefore be admitted into the proceedings.

Moreover, since the Board did not allow the amendments made to the claims which, to the appellant/proprietor's conviction were clearly and unambiguously disclosed in the originally filed application, a question should be referred to the Enlarged Board of Appeal to establish a

reliable rule for the allowability of amendments to the claims. In particular, the Board should inform the proprietor which features were lacking from the claim, and where it saw any structural or functional relationship to lie, otherwise the proprietor could not address the issue.

XIV. The appellant/(remaining) opponent and the intervening party argued that claim 1 according to the main request contravened Article 123(2) EPC since the subject-matter of claim 1 was not disclosed in the form as claimed, neither in the parent application nor in the divisional application. Any reorientation of the container supported or fixed in the chuck was not disclosed as claimed. The disclosure was only related to a preferred embodiment which could not be generalized as formulated in the claims.

Claim 1 of the first to fourth auxiliary requests respectively was not admissible under Article 123(2) EPC since the amended features had been isolated out of the context in which they had been originally disclosed or had been generalized in a form which was not clearly and unambiguously disclosed.

Changing the scope of the claims as granted, relating to the deformation of a predetermined wall zone of a container to a necking or shoulder forming method and apparatus was not admissible under Article 123 EPC.

Therefore none of the appellant/proprietor's requests should be admitted into the proceedings.

Reasons for the Decision

1. The appeals are admissible. By virtue of its intervention, which the board found to be admissible, opponent 3 became party to the appeal proceedings (Article 105 EPC).

2. *Main request (Article 123(2) EPC)*

2.1 The claims as granted were not allowed by the opposition division for the reason that they did not meet the requirement of Article 123(2) EPC. In particular, the subject-matter of claim 1 was held to have extended beyond the content of the application as filed. A reorientation arrangement to rotationally co-align the container and the tooling with respect to one another was claimed, which covered the alternative that the container and the tooling are each rotated with respect to one another. Since rotation of either only the container or only the tooling was originally disclosed, the third alternative extended beyond the original disclosure.

2.2 The appellant/proprietor argued that feature ii) defined the general function and that a reorientation arrangement was merely a "label" for the means disclosed for reorientation. To the skilled person it was clear that this feature indicated that it was generally only necessary to co-align the container with the tooling in some way. Although claim 35 of the parent application did not disclose such reorientation, it was evident that this had to be performed and how it was performed was not limited. The description gave general basis for co-alignment and this was sufficient; specific examples did not limit the disclosure.

2.3 However, the Board shares the opposition division's view and agrees with its conclusion. Indeed, subject-matter

is claimed which was not included in the parent application as originally filed.

2.4 As also stated by the proprietor, claim 35 includes no reorientation arrangement. The basis for its inclusion in such a general manner into the claim, as in feature (ii), cannot however not be found to be present in the application as originally filed. Merely because a reorientation has to occur, does not by itself mean that a general means of re-orientation is therefore disclosed (even if this were to be equated with a generally defined "reorientation arrangement" as the proprietor argues). Thus, even though page 3, line 16 refers to co-alignment being typically required, this does not provide a disclosure of a generally formulated reorientation arrangement performing co-alignment. Nowhere in the application as filed is there an unambiguous disclosure for a skilled person of such a general means. All the references to the application provided by the proprietor merely disclose a specific way of providing co-alignment, none involving any type of arrangement (i.e. a reorientation arrangement) allowing rotation of both the container and the tooling, which is now however covered by the general definition provided in feature (ii). Merely because the description may refer to these specific means of realignment using such terms as "particularly" (see e.g. page 4, line 27), does not provide an unambiguous disclosure of what might otherwise by the case if that particular reorientation means disclosed were not used.

2.5 Since the requirement of Article 123(2) EPC is not fulfilled, the main request cannot be allowed.

3. *First auxiliary request (Article 13(1) RPBA)*

3.1 According to Article 114(2) EPC 1973 the European Patent Office may disregard facts or evidence which are not submitted in due time by the parties concerned. In Article 13(1) of the Rules of Procedure of the Boards of Appeal (RBPA) it is stated that it is within the Board's discretion to admit and consider any amendment to a party's case after it has filed its grounds of appeal or reply. The discretion shall be exercised inter alia in view of the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. According to the established case law of the Boards of Appeal a late filed request should, not least for reasons of procedural economy, normally only be admitted into the proceedings if it overcomes all deficiencies and appears *prima facie* allowable.

3.2 Although the appellant/proprietor had made amendments to the claim with respect to particular objections mentioned in the Board's communication by inclusion of features related to the vertical/horizontal orientation, movement of the tooling table and the position of the external tooling, the claim is however prima facie not allowable since the requirement of Article 123(2) EPC is not met.

3.3 The appellant/proprietor relied on the disclosure of the PA (page 3, lines 16 to 27, page 5, line 4 et seq., page 7, line 9 et seq. and page 12, line 3 et seq.) particularly relating to the positioning and movement of the tooling with respect to the container.

3.4 According to a method step of claim 1, "the containers (are) held at a vertically orientated holding table (3) facing the tooling table for both the necking and the embossing operations", and in a further step "by means

of one of either rotation of the tooling or rotation of the container rotationally (are co-aligned) with respect to one another the container". Rotation of the tooling while the container is clamped in a chuck in accordance with the first embodiment is indeed described (page 16, lines 11 to 18) whereas in the second embodiment (page 19, line 24 to page 20, line 9) the container is not rotated when held at the holding table. To the contrary, the container is rotated to the required position – before - it is held at the holding table, and after thus having been co-aligned it is inserted into the clamp of the holding station.

3.5 Since according to claim 1 the container is held at the holding table during the reorientation step, contrary to the second embodiment, subject-matter is claimed which extends beyond the content of the application as filed. The Board thus exercised its discretion not to admit the first auxiliary request into the proceedings.

4. *Second auxiliary request (Article 13(1) RPBA)*

4.1 Claim 1 is an apparatus claim which comprises the features
"ii) a reorientation arrangement (104, 105) to rotationally co-align the container and the tooling with respect to one another for deformation of the wall zone by means of one of either rotation of the tooling or rotation of the container;
wherein the reorientation arrangement is first operable to rotationally co-align the container and the embossing tooling with respect to one another".

4.2 The Board refers to the reasons given in respect of the first auxiliary request. There is no clear and unambiguous disclosure, with regard to the second

embodiment on which the proprietor relies, that the container is rotationally aligned with the tooling in fixed rotational orientation. The added features do not alter this finding. Therefore subject-matter is claimed which is not disclosed in the original application.

4.3 The appellant/proprietor argued that the disclosure in the PA on page 3:

"iii) determination means for determining the orientation of the cylindrical body relative to a reference (datum) situation

iv) means for co-ordinated movement to reconfigure the tooling to co-align with the predetermined wall zone prior to deforming engagement of the tooling with the body"

was equally applicable for both the first and the second embodiment and thus the claim covered both alternatives of rotational orientation of the tooling and of the container. Therefore there was sufficient disclosure for the wording used in the claim, particularly for the disclosure of the second embodiment.

4.4 However, the Board concludes that the wording of feature iv) is clearly and unambiguously only directed to the first embodiment with the container in rotationally fixed orientation and the tooling rotating. Therefore no basis in the original disclosure for the amendment under consideration can be derived from that passage of the application. Since claim 1 of the second auxiliary request is not *prima facie* allowable, the Board exercised its discretion not to admit it into the proceedings.

5. *Third auxiliary request (Article 13(1) RPBA)*

5.1 In claim 1 of this request, the function in feature ii):

"by means of one of either rotation of the tooling or rotation of the container"
has been replaced by the means for effecting same:
"a) means for optically viewing the container to determine its orientation relative to datum situation;
b) means for automatically rotating the container about its longitudinal axis if the orientation of the container differs from the desired datum situation;
c) means for inserting the container automatically into the clamp".

5.2 The appellant/proprietor argued that in the mind of the skilled person such means were clearly disclosed, at least implicitly, since the function which was replaced by the means could only be effected with such means as disclosed, e.g. camera 60 or controller 70 in relation to the first embodiment. In relation to the second embodiment, the detailed function was described (page 19, line 24 to page 20, line 8). The proprietor also argued that such replacement of a function by means for effecting the function was generally allowed in opposition.

5.3 The Board cannot accept this argument. According to the first embodiment means are indeed disclosed, however in a very specific manner, and replacement of e.g. a "camera" (as disclosed) by "means for optically viewing" is an inadmissible intermediate generalisation of the only unambiguous disclosure, since the means are not originally disclosed in the form now claimed. Merely because a skilled person might be able to arrive at other means without exercising inventive skill does not mean that means, generally, for optically viewing are disclosed, nor that the skilled person is taught to generalise such means when a functional definition is used.

5.4 As to the second embodiment, where the function of the reorientation is described, no means at all are disclosed for this (in particular no structural features). Therefore – irrespective of whether the teaching can be carried out by the skilled person - subject-matter is claimed which finds no basis in the content of the original application.

5.5 Already for reason of these deficiencies, claim 1 is *prima facie* not allowable and therefore the Board again exercised its discretion not to admit this request into the proceedings.

6. *Fourth auxiliary request (Article 13(1) RPBA)*

The same reasoning as above applies when considering the fourth auxiliary request. Although the "means" have now been defined in a more specific functional way in this request, an unambiguous disclosure is still lacking, as is the case with respect to claim 1 of the the third auxiliary request, and therefore the Board again exercised its discretion not to admit this request into the proceedings.

7. *Request to refer a question to the Enlarged Board of Appeal*

7.1 In order to ensure uniform application of the law, or if a point of law of fundamental importance arises the Board of Appeal shall, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes (Article 112 EPC). The question which is requested to be referred to the

Enlarged Board of Appeal concerns the conditions under which a disclosure made in a specific embodiment can be generalized in the absence of any structural relationship among the features of the specific combination or an inextricable link with those features.

7.2 Structural relationships or an inextricable link of the added information alone are however not relevant for defining the standard for judging amendments with respect to Article 123(2) EPC since this would be at odds with the "gold standard" (see e.g. G2/10, Reasons 4.3 last paragraph). The standard whereby an amendment must be directly and unambiguously derivable, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application as filed, remains a pre-requisite for judging any amendment with respect to the requirement of Article 123(2) EPC.

7.3 Hence, relationships and links, as such, of the technical information is not the sole item of importance for deciding upon whether the requirement of Article 123(2) EPC is fulfilled, rather simply whether this technical information (and here, in particular, the subject-matter according to the combination of features defined in claim 1) received by the skilled person is new having regard to the content of the originally filed application. Consequently, no decision of the Enlarged Board of Appeal is required.

7.4 When considering, in the case at hand, whether the amendment to the claim is allowable based on features taken from the description, it is not only necessary to consider whether an isolated feature is inextricably linked with other features, but also whether such a feature or a group of such features of a specific

embodiment disclosed in their specific relationship can be combined with the content of the original claim to which they are being added.

7.5 In the present case the question is thus not whether a clearly recognisable feature might be related to a specific combination, but the fact that new features or a new combination of features inserted into the claim have not been clearly and unambiguously disclosed in the application as originally filed. The conclusion reached by the Board was that at least the newly claimed combination of features as a whole, and consequently the (newly defined) subject-matter of the claim was not originally disclosed and thus extended beyond the content of the application as filed.

7.6 Although the proprietor argued that it should be incumbent upon the Board to state which features from the application as filed the proprietor should include in a claim in order to overcome an objection under Article 123(2) EPC, this however does not appear to the Board to support the need to refer the question formulated. In as far as the argument can be understood in this regard, it can however be stated that such is not incumbent on the Board but rather on the party making amendments since it is the party that must explain to the Board where such subject-matter is disclosed in order that the Board may then examine whether the requirement of Article 123(2) EPC is met; the function of the Board is not to propose possible amendments to the proprietor in such a case (which is notably an inter partes case).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The European patent is revoked.

3. The request for referral of a question to the Enlarged Board of Appeal is rejected.

The Registrar: The Chairman:

M. H. A. Patin M. Harrison

Decision electronically authenticated