

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 23 January 2014**

Case Number: T 0755/12 - 3.2.08

Application Number: 07106494.3

Publication Number: 1847670

IPC: E05D13/00, E05D7/086

Language of the proceedings: EN

Title of invention:

Hinge for wings or doors

Patent Proprietor:

NUOVA STAR S.p.A.

Opponent:

FARINGOSI HINGES S.r.l.

Headword:

Relevant legal provisions:

EPC Art. 100(c), 111(1)

RPBA Art. 12(4)

Keyword:

main request - added subject-matter (yes)

auxiliary request 1 - remittal to first instance

Decisions cited:

G 0003/89, T 0331/87

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 0755/12 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 23 January 2014

Appellant: NUOVA STAR S.p.A.
(Patent Proprietor) Via Balzani, 20,
Zona Industriale
40069 Zola Predosa (Bologna) (IT)

Representative: Lanzoni, Luciano
Bugnion S.p.A.
Via di Corticella, 87
40128 Bologna (IT)

Respondent: FARINGOSI HINGES S.r.l.
(Opponent) Via Martiri della Libertà, 66
25035 Ospitaletto (BS) (IT)

Representative: Marietti, Andrea
Marietti, Gislone e Trupiano S.r.l.
Via Larga, 16
20122 Milano (IT)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 13 February
2012 revoking European patent No. 1847670
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: T. Kriner
Members: M. Alvazzi Delfrate
C. Schmidt

Summary of Facts and Submissions

- I. By its decision given to the post on 13 February 2012 the opposition division revoked European Patent No. 1 847 670.
- II. The decision of the opposition division was based on the grounds of opposition according to Article 100(a) (lack of novelty) and 100(c) EPC.
- III. The appellant (patent proprietor) lodged an appeal against that decision on 4 April 2012, paying the appeal fee on the same day. The statement of grounds for appeal was filed on 12 June 2012.
- IV. Oral proceedings were held before the board of appeal on 23 January 2014.
- V. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted or in amended form according to one of auxiliary requests 1 to 2 submitted with letter of 23 December 2013. It further requested that the case be remitted to the first instance for further prosecution.

The respondent (opponent) requested that the appeal be dismissed. It further requested the board not to admit the auxiliary requests into the proceedings.

- VI. Claim 1 of the **main request** reads as follows:

"A hinge for wings or doors, in particular of electrical appliances, having a first element (5), a second element (6) and a lever (7) for connecting the first and second elements (5, 6); the lever (7)

pivoting on the second element (6) by means of a pin (8) and having a first portion (9a) integral with the first element (5) to render the first and second elements (5, 6) movable relative to one another with a tilting action; there being the possibility of fixing the first and second elements (5, 6) one to a frame (2) and the other to a wing or door (3), so that the wing or door (3) can move relative to the frame (2) between a closed position and an open position; the second element (6) consisting of a substantially box-shaped body containing elastic means (30) inserted between the second element (6) and the lever (7) for applying an elastic action on the lever (7); the hinge (4) comprising damping means (31) contained in the second element (6) for applying a damping action on the lever (7) during the reciprocal motion of the first and second elements (5, 6), when the closed position is almost reached; the damping means (31) comprise a gas or fluid cylinder (32), having an outer body (33) mounted in the second element (6) and a rod (34) which moves with linear motion relative to the outer body (33) characterised in that the outer body (33) is mounted near the longitudinal end (12) of the second element (6) opposite the end hinged to the lever (7), whereby the rod (34) consists of a first portion (37) acting directly on the cylinder (32) piston and of a second portion (38) forming an extension, having a first longitudinal end (39) connected to the first portion (37) and a second longitudinal end (40) which is free, designed to act on the lever (7) during the reciprocal motion of the first element 5 and the second element 6 and when the closed position is almost reached."

Claim 1 of **auxiliary request 1** reads as follows
(features added to claim 1 as granted emphasised):

"A hinge for wings or doors, in particular of electrical appliances, having a first element (5), a second element (6) and a lever (7) for connecting the first and second elements (5, 6); the lever (7) pivoting on the second element (6) by means of a pin (8) and having a first portion (9a) integral with the first element (5) to render the first and second elements (5, 6) movable relative to one another with a tilting action; there being the possibility of fixing the first and second elements (5, 6) one to a frame (2) and the other to a wing or door (3), so that the wing or door (3) can move relative to the frame (2) between a closed position and an open position; the second element (6) consisting of a substantially box-shaped body containing elastic means (30) inserted between the second element (6) and the lever (7) for applying an elastic action on the lever (7); the hinge (4) comprising damping means (31) contained in the second element (6) for applying a damping action on the lever (7) during the reciprocal motion of the first and second elements (5, 6), when the closed position is almost reached; the damping means (31) comprise a gas or fluid cylinder (32), having an outer body (33) mounted in the second element (6) and a rod (34) which moves with linear motion relative to the outer body (33) characterised in that the lever (7) has at least one thrust projection (41) positioned and shaped in such a way as to allow cylinder (32) compression during the reciprocal motion of the first and second elements (5, 6), when the closed position is almost reached, and that the outer body (33) is mounted near the longitudinal end (12) of the second element (6) opposite the end hinged to the lever (7), whereby the

rod (34) consists of a first portion (37) acting directly on the cylinder (32) piston and of a second portion (38) forming an extension, having a first longitudinal end (39) connected to the first portion (37) and a second longitudinal end (40) which is free, designed to make contact with the thrust projection (41) during the reciprocal motion of the first element (5) and the second element (6) and when the closed position is almost reached."

Auxiliary request 2 does not play a role for the present decision.

VII. The arguments of the appellant can be summarised as follows:

Main request

Paragraph [0025] of the application as originally filed disclosed a rod consisting of a first portion acting directly on the cylinder piston and of a second portion forming an extension, having a first longitudinal end connected to the first portion and a second longitudinal end which is free, designed to act on the lever during the reciprocal motion of the first element and the second element and when the closed position is almost reached. A similar disclosure could be found in claim 6 as originally filed. Accordingly, these features, which had been introduced into claim 1 during the examination proceedings, were based on the application as originally filed.

It was true that original claim 6 additionally disclosed a thrust projection of the lever, and that paragraph [0026], which related to the same embodiment as paragraph [0025], also mentioned thrust projections.

However, it was possible, provided that the conditions laid down in decision T 331/87 were satisfied, to supplement a claim with features taken from the specification while omitting some of the features of the described embodiment.

In the present case the embodiment of paragraph [0026] comprised two thrust projections, whereas claim 6 mentioned only one projection. Hence, it was clear that these projections were not essential to the invention. Rather, for a functioning of the claimed device it was only important that the rod acted on the lever. Since according to decision T 331/87 it was possible to omit non-essential features, the omission of the thrust projections did not result in subject-matter which extended beyond the content of the application as originally filed.

Introduction of the auxiliary requests into the proceedings

It was true that the auxiliary requests had been filed for the first time during the appeal proceedings. However, during the opposition proceedings the proprietor did not expect a revocation of the patent on the basis of Article 100(c) EPC. Moreover, the auxiliary requests did not constitute a fresh case, since they merely introduced the features whose omission had been objected to. Accordingly, they should be admitted into the proceedings.

Auxiliary request 1

Claim 1 of auxiliary request 1 comprised the reference to a thrust projection as disclosed in originally filed claims 6 and 3. Therefore, it complied with the

requirements of Article 123(2) EPC. Moreover, its subject-matter was novel.

VIII. The arguments of the respondent can be summarised as follows:

Main request

The conditions set out in decision T 331/87, which concerned the excision of a feature from the originally filed claim, were not applicable to the present case wherein some features from a particular embodiment were taken in isolation and introduced into the claim.

Rather, it had to be considered what was disclosed in the application as filed. In the application the rod was disclosed solely in combination with at least one thrust projection, which made possible its interaction with the lever. However, claim 1 of the main request did not mention such a thrust projection. Therefore, it had been amended in a way which introduced subject-matter extending beyond the content of the application as originally filed.

Introduction of the auxiliary requests into the proceedings

The fact that claim 1 did not mention any thrust projection was already objected to in the notice of opposition. However, the appellant chose not to file any request to address this problem during the opposition proceedings. It decided instead to submit such a request for the first time during the appeal proceedings. In this way a fresh case, which could already have been submitted during the opposition proceedings, was presented for the first time at the

appeal stage. For these reasons, the auxiliary requests should not be admitted into the proceedings.

Auxiliary request 1

If the auxiliary requests were introduced into the proceedings, no objection based on Article 123(2) EPC or concerning lack of novelty was raised against auxiliary request 1. Nor was there any objection to a remittal to the opposition division for examination of the requirements of inventive step.

Reasons for the Decision

1. The appeal is admissible.
2. Main request
- 2.1 The features according to which

the rod consists of a first portion acting directly on the cylinder piston and of a second portion forming an extension, having a first longitudinal end connected to the first portion and a second longitudinal end which is free, designed to act on the lever during the reciprocal motion of the first element and the second element and when the closed position is almost reached

were added to claim 1 during the examination proceedings.

- 2.2 These features introduced into claim 1 are to be found in originally filed claim 6 and in paragraph [0025].

However, paragraph [0025] relates to a specific embodiment which comprises further features, in particular those defined in paragraph [0026]. According to the latter paragraph the lever 7 has two thrust projections 41, extending in such a way that they are aligned with one another longitudinally from two opposite faces of the lever 7, and the end 40 has a fork-shaped free end portion, designed to make contact with the projections 41, simultaneously, when the door 3 has almost reached its closed position, and to remain in contact until the closed position is reached.

Original claim 6 also refers to a thrust projection. Moreover, it depends on claim 3, which defines that the lever has at least one thrust projection positioned and shaped in such a way as to allow cylinder compression during the reciprocal motion of the first and second elements, when the closed position is almost reached.

Accordingly, in the cases of paragraphs [0025] and [0026] and claims 6 and 3 the at least one thrust projection is in a clearly recognisable functional and structural relationship with the rod, since it makes an action of the rod on the lever possible. There is no disclosure in the application as originally filed of realising this interaction in a different way.

By contrast, claim 1, which does not mention any thrust projection, encompasses other possibilities of realising this interaction. As a consequence, it presents the person skilled in the art with information which is not directly and unambiguously derivable from the application as originally filed.

2.3 The appellant referred to the conditions set out in decision T 331/87 (OJ EPO 1991, 22), which in its view would allow the omission of the features relating to the thrust projection.

However, the case underlying decision T 331/87 is different from the present one, since it relates to the excision of a feature from the originally filed claim, whereas in claim 1 of the main request some features from a particular embodiment were taken in isolation and introduced into the claim.

Moreover, and most importantly, the question to be considered in assessing the allowability of an amendment in view of the requirements of Article 123(2) or Article 100(c) EPC is what a skilled person would objectively have derived from the description, claims and drawings of a European patent application on the date of filing (see G 3/89, OJ EPO 1993, 117, point 2 of the Reasons). Although some tests such as the test set out in decision T 331/87 (OJ EPO 1991, 22) have been used as a help for assessing this issue they cannot replace the need to answer this question.

2.4 Since in the present case, as explained above, claim 1 of the main request presents the person skilled in the art with information which is not directly and unambiguously derivable from the content of the application as originally filed, the main request is not allowable.

3. Introduction of the auxiliary requests into the proceedings

Auxiliary requests 1 and 2 were submitted for the first time during the appeal proceedings. Since they address

an objection which was already raised in the notice of opposition they could have been presented in the opposition proceedings. Accordingly, it was within the discretionary power of the board not to admit them into the proceedings (see Article 12(4) RPBA).

However, the auxiliary requests neither raise complex issues nor constitute a fresh case, since they merely introduce features whose omission had been objected to by the respondent and censured in the decision under appeal.

Under these circumstances the board decided to admit them into the proceedings.

4. Auxiliary request 1

4.1 It is common ground between the parties that claim 1 of auxiliary request 1 complies with the requirements of Article 123(2) EPC and that its subject-matter is novel. The board does not see any reason to depart from this assessment.

4.2 The decision under appeal did not deal with the ground of opposition of lack of inventive step, which was also raised during the opposition proceedings. The board therefore deems it appropriate not to decide on this issue in place of the first instance, in order to retain the possibility of examination by two instances in respect of this issue as well.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of auxiliary request 1 filed with letter of 23 December 2013.

The Registrar:

The Chairman:



A. Counillon

T. Kriner

Decision electronically authenticated