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Datasheet for the decision of 14 October 2014

Case Number: T 1246/12 - 3.2.06

Application Number: 04736016.9

Publication Number: 1629147

IPC: D06F37/04, D06F58/02

Language of the proceedings: EN

Title of invention:
DRUM FOR WASHER AND DRYER

Patent Proprietor:
LG Electronics, Inc.

Opponent:
Electrolux Home Products Corporation N.V.

Headword:

Relevant legal provisions:
EPC Art. 123(2)
EPC 1973 Art. 87(1), 54

Keyword:
Priority - basis in priority document (no)
Novelty - main request (no)
Amendments - added subject-matter (yes)

Decisions cited:
G 0001/93, G 0002/98

Catchword:

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Case Number: T 1246/12 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 14 October 2014

Appellant: (Patent Proprietor)	LG Electronics, Inc. 20, Yoido-dong, Youngdungpo-gu Seoul 150-721 (KR)
Representative:	Bryn-Jacobsen, Caelia Kilburn & Strode LLP 20 Red Lion Street London WC1R 4PJ (GB)
Respondent: (Opponent)	Electrolux Home Products Corporation N.V. Belgicastraat 17 1930 Zaventem (BE)
Representative:	Maccalli, Marco Maccalli & Pezzoli S.r.l. Via Settembrini, 40 20124 Milano (IT)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 30 March 2012 revoking European patent No. 1629147 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	M. Harrison
Members:	M. Hannam
	W. Sekretaruk

Summary of Facts and Submissions

I. An appeal was filed by the proprietor against the decision of the opposition division revoking European Patent No. 1 629 147.

II. With its grounds of appeal, the appellant (proprietor) requested that the decision under appeal be set aside and the patent be maintained as granted, auxiliarily that the patent be maintained in an amended form based on one of its auxiliary requests 1-7.

III. The Board issued a summons to oral proceedings including a communication containing its provisional opinion, in which it indicated *inter alia* that claim 1 of the main request did not appear to validly claim priority from

P1 KR-2003-036393

such that the subject-matter of claim 1 lacked novelty over

D0 Korean Utility Model No. 20-0349444 (machine translation into English).

The Board further indicated that the subject-matter of claim 1 of each of the auxiliary requests appeared not to meet the requirement of Article 123(2) EPC.

IV. With letter of 11 September 2014 the appellant filed further auxiliary requests 8-16. It also submitted that the certified translation of P1 required correction in paragraph 80 to read, '... also to any types of drums that require to be compressed.'

V. Oral proceedings were held before the Board on 14 October 2014, during which the appellant withdrew auxiliary requests 1 - 12, 14 and 15. The appellant requested that the decision under appeal be set aside and the European patent be maintained as granted or on the basis of auxiliary request 13 or on the basis of auxiliary request 16, both as filed on 11 September 2014.

The respondent (opponent) requested that the appeal be dismissed.

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

"A drum (1) for a washer and a dryer comprising:
a cylindrical metal body part (100);
reduced parts (110) at opposite ends of the body part, each having a diameter smaller than a diameter of the body part; and
bent parts (120) having a folded edge of the reduced part."

Claim 1 of auxiliary request 13 reads:

"A method of making a drum (1) for a dryer comprising;
rolling metal sheet into a cylinder and butt welding a seam to form a cylindrical metal body part (100);
reducing the diameter of parts (110) at opposite ends of the body part, whereby each has a diameter smaller than a diameter of the body part;
pressing the body part inwardly at a predetermined depth along a circumferential direction of the body part to form beads in the surface of the body part for strengthening; and
folding an edge of each reduced part (110) to form bent parts (120)."

Claim 1 of auxiliary request 16 reads:

"A method of making a drum (1) for a dryer comprising a cylindrical metal body part (100); reduced parts (110) at opposite ends of the body part, each having a diameter smaller than a diameter of the body part; beads formed in the body part for strengthening; and bent parts (120) having a folded edge of the reduced part, the method comprising:
rolling metal sheet and butt welding a seam to form the cylindrical metal body part (100);
reducing the diameter of the opposite ends of the body part by pressing;
pressing the body part inwardly at a predetermined depth along a circumferential direction of the body part to form the beads; and
folding an edge of each reduced part (110) to form bent parts (120)."

VII. The appellant's arguments may be summarised as follows:

As regards the main request, the priority was validly claimed since P1 *inter alia* clearly disclosed a drum suitable for a washer, not only one suitable for a dryer. The skilled person would understand that, regardless of the presence of the wording 'for a washer' in claim 1, the same invention was being claimed as that disclosed in P1. Whilst the translation of paragraph 80 of P1, when corrected, indicated that a drum in general was disclosed therein, this was not decisive as to whether a drum suitable for a washer was disclosed or not; rather the skilled person would implicitly derive the specific disclosure of a drum suitable for a washer from P1 as a whole. Further, the wording 'for a washer', when interpreted as 'suitable

for a washer', was anyway a very broad definition of the claimed drum, which simply needed to be able to contain water and clothes. It was furthermore apparent that the drum being also suitable for a washer did not provide a technical contribution to the subject-matter of the claimed invention and, according to G1/93, was thus not to be considered as subject-matter extending beyond the content of the application as filed or, in the present case, did not change the identity of the invention within the meaning of Article 87(1) EPC. Since the priority from P1 was validly claimed, the subject-matter of claim 1 was novel over D0 due to its later publication date.

Regarding auxiliary request 13, the subject-matter of claim 1 met the requirement of Article 123(2) EPC since claim 1 as originally filed did not include the feature regarding pressing of the end parts of the body; this feature was present in claim 2 as originally filed as a preferred feature. Further, the reduced parts could be achieved by pulling the end parts inwardly, rather than pressing them inwardly, which indicated that the reduction in diameter of the body by pressing was not an essential feature of the invention. By comparing the prior art method in Figure 2 and the inventive method in Figure 3 of the application as filed, the skilled person would readily determine the features making up the inventive method.

As regards auxiliary request 16, the subject-matter of claim 1 met the requirement of Article 123(2) EPC since this was based on claims 1, 2, 4 and 25 as originally filed and the method steps in the claim were consistent with the claimed structural features of the drum. Any omitted method features from the description did not contribute to the technical effect of the invention, as

would be understood by the skilled person. Furthermore, the skilled person would understand that the features contained in claim 5 as originally filed were not essential to the invention and could thus be omitted from claim 1 of this request, even if the discussion of butt welding in the description included this feature. It was irrelevant that claims 1, 2, 4 and 25 as originally filed were not dependent on one another, since each feature would be taken independently of the other.

VIII. The respondent's arguments may be summarised as follows:

Regarding the priority validity of claim 1 of the main request, not a single passage in P1 discussed washer specific features justifying the inclusion of a drum "for a washer" in claim 1. The correction suggested to paragraph 80 of P1 also failed to disclose a drum suitable specifically for a washer.

The subject-matter of claim 1 of auxiliary request 13 failed to meet the requirement of Article 123(2) EPC as such a general method claim could not find a basis in a product claim. The sole disclosure of a method in the originally filed application was the more specific embodiment disclosed from page 6, line 23 onwards which, in conjunction with Figures 3 and 4, necessarily included the reduction of the diameter of end parts by pressing. The omission of 'by pressing' thus offended Article 123(2) EPC.

As regards auxiliary request 16, claims 1, 2, 4 and 25 as originally filed were only individually dependent from claim 1 and so did not provide a direct and unambiguous basis for the subject-matter of claim 1,

but rather represented an arbitrary combination of features.

Reasons for the Decision

1. Main request

1.1 Invalid claim to priority from P1

The subject-matter of claim 1 does not enjoy a right of priority (Article 87 EPC 1973) from P1.

1.1.1 The requirement for claiming priority of 'the same invention', referred to in Article 87(1) EPC, means that priority of a previous application in respect of a claim in a European patent application in accordance with Article 88 EPC is to be acknowledged only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole (see e.g. G2/98, Headnote). In the present case, therefore, the question to be answered is whether the subject-matter of claim 1 (of the patent) can be directly and unambiguously derived by the skilled person, using common general knowledge, from P1 as a whole.

1.1.2 P1 explicitly discloses a moulding method of a drum solely for a dryer (see claims 1-11 and, for example, paragraphs 25, 55, 56, 65). By contrast, the present claim 1 is directed to 'a drum for a washer and a dryer' i.e. not only a drum suitable for a dryer, but additionally one suitable for a washer; for the latter there is no disclosure in P1.

1.1.3 The appellant's argument that, regardless of the presence of the wording 'for a washer' in claim 1, the same invention was being claimed as that disclosed in P1 does not convince the Board. In this respect, for the appellant's 'same invention' argument to hold, it would need to be directly and unambiguously derivable to a skilled person, using common general knowledge, that the drum suitable for a dryer disclosed in P1 would equally be suitable for a washer. However, lacking a single reference in this respect, P1 solely disclosing a drum for a dryer, no basis for such a disclosure of a drum for a washer can be found.

1.1.4 Regarding the proposed correction in paragraph 80 of the translation of P1, the appellant provided no evidence in support of its contention that the certified translation indeed contained such an error. However, even if such an error were present and the correction were appropriate, paragraph 80 of P1 could not support the clear and unambiguous disclosure of a drum for a washer in P1. This paragraph, if corrected, would then state that '... this process can be applied not only to the drums used in dryers but also to any types of drums that require to be compressed.' It is thus apparent that even here there is no specific reference to a drum for a washer, rather simply to general, undefined types of drums. From this paragraph, therefore, the skilled person would not be guided necessarily and implicitly to consider that the entire disclosure of P1 also applied to a drum specifically for a washer.

Rather than rely only on the corrected translation, the appellant's further argument was that the skilled person was anyway able to derive the disclosure of a drum suitable for a washer from P1 as a whole. The

Board however does not accept this. As already stated under point 1.1.3, the lack of explicit reference to a drum for a washer results in the skilled person being unable to directly and unambiguously derive such a disclosure in P1, even when considering the disclosure as a whole.

1.1.5 The appellant's further argument that the wording of claim 1 was to be interpreted as a drum 'suitable for a washer', which thus simply needed to be able to contain water and clothes, was also unpersuasive. Whilst there may indeed be certain similarities between a drum for a washer and that for a dryer, this does not have the consequence that a drum disclosed solely as being for a dryer is necessarily equally appropriate for a washer. Neither can it be considered that a drum for a washer is clearly and unambiguously disclosed in a document directed solely and specifically to a drum for a dryer. It is not relevant in this respect whether or not any additional feature must be added to the drum disclosed in P1 in order to make it suitable as a drum for a washer or not, since there is simply no disclosure to that effect at all.

1.1.6 The appellant's argument on the basis of G1/93 is not relevant to the present case. In that decision the issue of an added feature limiting the protection conferred by the patent, and which did not provide a technical contribution to the invention, was found not to offend Article 123(2) EPC (see G1/93, Headnote Point 2). However, in the present case, the inclusion of the feature in claim 1 relating to a drum for a washer relates to providing limitations to a particular suitability for a drum and is not merely concerned with limiting the protection of a claim by features lacking a technical contribution. The conclusion drawn by the

appellant on the basis of G1/93 that, in the present case, the amendment to claim 1 does not offend Article 123(2) EPC (or rather that claim 1 can validly claim priority from P1) since the addition of a drum for a washer does not provide a technical contribution to the subject-matter of the claimed invention, is thus unsound. The amendment of claim 1 to cover a drum for a washer indeed includes technical information additional to that of simply a drum for a dryer as disclosed in P1.

1.1.7 It thus follows that there exists no basis in P1 as a whole from which it can be derived unambiguously that a drum for a washer, as in claim 1 under consideration, was included within its content. As a result, at least for this reason, the subject-matter of claim 1 cannot be derived directly and unambiguously using common general knowledge from P1 as a whole and thus cannot enjoy the right of priority from P1 (Article 87 EPC 1973).

1.2 Lack of novelty

The subject-matter of claim 1 lacks novelty (Article 54 EPC 1973) with respect to the disclosure in D0.

1.2.1 Since the subject-matter of claim 1 does not enjoy the right of priority from P1, D0 represents prior art under Article 54(2) EPC 1973. Using the wording of claim 1 and references in parentheses from D0, D0 discloses (see Fig. 3 and page 10, lines 13-19):
a drum (1) for a washer and a dryer comprising:
a cylindrical metal body part (A);
reduced parts (B) at opposite ends of the body part, each having a diameter smaller than a diameter of the body part; and

bent parts (at open ends; see also the reference to 'hemming' and the enlarged partial view of Fig. 3) having a folded edge of the reduced part.

1.2.2 The appellant presented no defence to the attack that the subject-matter of claim 1 lacked novelty over D0 where claim 1 did not enjoy a right of priority from P1.

1.2.3 The main request is thus not allowable.

2. Auxiliary request 13

2.1 Article 123(2) EPC

The subject-matter of claim 1 fails to meet the requirement of Article 123(2) EPC at least for the following reason.

2.1.1 Claim 1 is directed to a method of making a drum for a dryer including a step of:
'reducing the diameter of parts at opposite ends of the body part'.
The basis for such a method step without the qualification that this is achieved through pressing of the body parts is not derivable directly and unambiguously from the application as originally filed.
Page 3, lines 22-25 of the PCT A-publication (which corresponds to the application as originally filed) is a recitation of claim 1 as originally filed and is directed to a product, namely a drum for a washer and a dryer, and therefore cannot provide a basis for a method claim directed to a particular method of making such a drum, especially since a plurality of possible methods could be envisaged for making the disclosed drum. A basis for the particular method step of

reducing the diameter of end parts without the pressing of the body parts is also not present from page 4, line 25 - page 5, line 19 which discloses three preferred embodiments of a drum for a washer and a dryer. Thus, again, this does not provide the basis for a particular method claim directed to manufacture of the drum. While the detailed embodiment disclosed from page 6, line 23 onwards does disclose a method for making a drum for a dryer, page 7, lines 11-13 cannot be viewed in isolation of the disclosure of the entire paragraph which includes page 7, lines 11 to 16 specifying the detail of pressing between dies to reduce the diameter of the end parts. There is no disclosure in this section, or any other section of the application, which allows it to be derived unambiguously that the pressing between dies can be omitted.

It thus follows that the sole disclosure in the originally filed application of 'reducing the diameter of parts at opposite ends of the body part' is in combination with a particular pressing process. The extraction of the diameter reduction step alone from the application as originally filed and insertion into the claim to a method of making a drum presents the skilled person with new information in the form of a new combination of features which is not directly and unambiguously derivable from the application as originally filed, thus contravening the requirement of Article 123(2) EPC.

2.1.2 The appellant's suggestion that claim 1 as originally filed did not include the feature regarding pressing of the end parts of the body, it only being present in claim 2 as a preferred feature, is not persuasive. As already found under point 2.1.1, claim 1 as originally filed is directed to a product (a drum for a washer and

a dryer) rather than to a method of making such a product. It is also noted that a number of different methods of making the disclosed drum can be envisaged by the skilled person. It thus follows that the originally filed claim to the drum *per se* does not provide a basis for a claim directed to the particular method of making such a drum (as claimed) as this would entail a selection of one particular method, albeit stated in very general terms, which lacks a basis in the originally filed documents.

2.1.3 The appellant further argued that when comparing Figures 2 and 3 with each other in the application as filed, the skilled person would recognise the concept of the method used for the invention (Figure 3) which was different to the prior art method (Figure 2), only by the step of reducing the diameters of opposite ends of the drum without any reference being made to a reduction by pressing. However, this argument also fails since Figure 3 is merely a flow chart of steps which does not stand alone but must be read and understood in the content of the description where its content is explained; this includes *inter alia* the previously mentioned description on page 7, lines 11 to 16 concerning reduction by pressing between dies.

2.1.4 Regarding the appellant's still further argument that the reduced parts could be achieved by pulling the end parts inwardly, rather than pressing them inwardly, this is not persuasive in permitting the omission of the pressing feature from claim 1. While indeed the reduced diameter might perhaps be achieved by a pulling rather than a pressing of the end parts inwardly, this is not disclosed. The sole disclosure of a method of making a drum in which the diameter of the end parts are reduced in the originally filed application is in

combination with a pressing of the end parts; no broader disclosure of the diameter reduction method step is disclosed. Merely if the skilled person might be able to arrive at further undisclosed methods of producing reduced diameter end portions without pressing thus lacks relevance to the issue at hand.

2.1.5 The omission of at least the feature regarding the pressing of the end parts of the body from claim 1 thus contravenes the requirement of Article 123(2) EPC, with the consequence that auxiliary request 13 is not allowable.

3. Auxiliary request 16

3.1 Article 123(2) EPC

The subject-matter of claim 1 fails to meet the requirement of Article 123(2) EPC at least for the following reason.

3.1.1 Claim 1 of this request is based on *inter alia* a combination, with claim 1 as filed, of dependent claims 2, 4 and 25. Each of these claims was singly dependent on product claim 1 (i.e. claim 25 was not dependent on claim 4 nor on claim 2, and claim 4 was not dependent on claim 2). Claim 1 thus now includes a specific combination of features for which no basis existed in the claims as filed.

The further question as to whether there is a basis elsewhere in the application as filed for such a combination of features must also be answered in the negative. Thus, the combination of features selected from merely certain of the dependent claims results in a selected combination of features which is not

disclosed in the application as filed.

3.1.2 In as far as a method is disclosed, it is noted first that, in the application as filed, claim 4 is dependent on claim 1, yet claim 1 itself defines only features of a drum and, importantly, not a method for its manufacture. Claim 4 comprises the feature 'wherein the cylindrical body is form (sic) by rolling metal sheet and butt welding a seam'.

3.1.3 Claim 1 as filed on the other hand defines, in its last feature, "bent parts each having a folded edge of the reduced part". Whilst this is a feature of the drum *per se*, it does not allow the conclusion to be drawn that end parts may simply be bent irrespective of other factors such as the metal thickness or how they are attached (in this case by butt-welding) or indeed in what order such steps may occur. Thus, whilst the features of claim 4 define rolling and then butt-welding a seam, this is dependent on a claim (i.e. claim 1) which does not define a method step which is used to provide parts which are bent so as to have a folded edge, but merely that they are somehow present in the product. The method step concerning 'folding an edge of each reduced part to form bent parts' introduced into claim 1, allegedly from the language in claim 1 as filed concerning the product, however ignores this relationship. For example, on page 12 of the description lines 18 to 24, it is explained, in a description of a method, how predetermined lengths of the seam which are to be bent are not welded at the ends. The same feature appears in claim 5 of the application as filed. As is evident, bending of a circular edge which is already welded completely up to its ends presents a higher force to be overcome than one without a full length weld, and the only

unambiguously disclosed method of forming bent parts after seam welding describes these end parts not being welded right to their ends. This may be contrasted for example with the disclosure on page 7, lines 1 to 10, where it is merely stated that edges are bent, but notably without disclosing to which extent welding takes place along the seam in the manufacturing method (and whereafter many further method steps are disclosed, which are also not included in claim 1).

3.1.4 It thus follows that the features of the method given in the description (which are also found in claim 5 as originally filed) are disclosed in the context of a method of manufacture (as opposed to a drum already having bent end portions) which is linked to the features of the method of welding given in the description and which also appear in claim 4 as originally filed.

Therefore, considering at least the combination of the features in claim 4 with those of claim 1, without additionally including the features of leaving predetermined lengths at opposite edges unwelded from the method disclosed in the application as originally filed (and as defined in claim 5 as filed) presents the skilled person with information in the form of a new combination of features of a method which in such a general form is not directly and unambiguously derivable from the application as originally filed, thus contravening the requirement of Article 123(2) EPC.

3.1.5 The appellant's argument that any omitted features do not contribute to the technical effect of the invention, and are thus not essential, is unconvincing. Whether or not the omitted features contribute to a

particular technical effect of the invention, or are regarded by the proprietor as essential to the invention or not, is not decisive in the question of whether a basis exists for the subject-matter of a claim. Rather, it is decisive whether the skilled person can directly and unambiguously derive the combination of features in the claim, using common general knowledge, from the application documents as originally filed. The appellant however failed to convincingly demonstrate from where the specific combination of elements combined into claim 1 of this request could unambiguously be derived; nor could the Board itself find any such basis.

3.1.6 Auxiliary request 16 is thus not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

M. H. A. Patin M. Harrison

Decision electronically authenticated