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**Datasheet for the decision
of 8 November 2016**

Case Number: T 1587/12 - 3.2.04

Application Number: 06830113.4

Publication Number: 1954118

IPC: A01G17/06, F16B2/24

Language of the proceedings: EN

Title of invention:
CLASPING DEVICE FOR WIRE-LIKE BODIES

Patent Proprietor:
MOLLIFICIO BORTOLUSSI S.R.L.

Opponent:
GR S.r.l.

Headword:

Relevant legal provisions:
EPC Art. 84, 123(2), 123(3)

Keyword:
Amendments - added subject-matter (yes)
Claims - lack of clarity

Decisions cited:

G 0003/14

Catchword:



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Case Number: T 1587/12 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 8 November 2016

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 15 June 2012
revoking European patent No. 1954118 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman A. de Vries
Members: S. Oechsner de Coninck
T. Bokor

Summary of Facts and Submissions

I. The appellant (proprietor) lodged an appeal received on 9 July 2012 against the decision of the opposition division dispatched on 15 June 2012 on the revocation of the patent EP 1 954 118, and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received on 8 October 2012.

II. The opposition was filed against the patent as a whole and based on Article 100(a) together with 52(1), 54(1) and 56 EPC, as well as Article 100(c) together with 123(2) EPC.

The opposition division held that claim 1 as amended according to the main request did not meet the requirements of Article 123(2) and (3) as well as Article 84 EPC.

III. Oral proceedings were held on 08 November 2016.

IV. The appellant(proprietor) requests that the decision under appeal be set aside, and that the patent be maintained in an amended form on the basis of the Main or Auxiliary Requests 1 to 4, all filed with letter dated 5 October 2016.

V. The respondent (opponent) requests that the appeal be dismissed.

VI. The wording of the independent claim 1 of the relevant requests reads as follows:

Main Request

"Method for connecting two elongated rigid means having an elongated or wire-like shape of a large-meshed vertical grid, which trunks, branches and shoots of agricultural plants can be tied to, comprising the steps of:

- providing rod-like members vertically set up in a ground;
- providing metal wires arranged horizontally above each other to connect horizontally said rods to each other;
- providing a clasping device comprising a flexible metal wire-like member (3) adapted to be wound in a saddle-like manner (15) by about half a turn round the first arm (1A) of said first means (1), the two opposite elongated prongs (5, 6) of said wire-like member being bendable round respective ones of two opposite arms (2A, 2B) of said second means (2), wherein each of said elongated prongs (5, 6) comprises an end portion (5A, 6A) shaped so as to form a curvature adapted to be engaged, independently one another, upon a surface of the opposite arm (1B) of said first means (1), which lies substantially on the same outer face of said first means (1) that is engaged by said saddle-like conformation (15) and said elongated prongs (5, 6) have different lengths;
- fastening together a first one (1) and a second one (2) of said rods and metal wires, respectively, extending substantially across each other and in contact with each other at the point of mutual intersection, from which each one of said means branches out with respective pairs of opposite arms (1A, 1B) and (2A, 2B), said clasping device being connected in a removable manner."

Auxiliary request 1

"Method for connecting a first one (1) and a second one (2) of two rigid means having an elongated or wire-like shape of a large-meshed vertical grid, which trunks, branches and shoots of agricultural plants can be tied to, comprising the steps of:

- providing rods vertically set up in a ground as the first one (1) of said two rigid means;
- providing metal wires arranged and stretched horizontally above each other to connect horizontally said rods to each other, as the second one (2) of said two rigid means;
- providing a clasping device comprising a flexible metal wire-like member (3) adapted to be wound in a saddle-like manner (15) by about half a turn round the first arm (1A) of said first means (1), the two opposite elongated prongs (5, 6) of said wire-like member being bendable round respective ones of two opposite arms (2A, 2B) of said second means (2), wherein each of said elongated prongs (5, 6) comprises an end portion (5A, 6A) shaped so as to form a curvature in form of an angle bend or an arc of a circle (8) adapted to be engaged, independently one another, upon a surface of the opposite arm (1B) of said first means (1), which lies substantially on the same outer face of said first means (1) that is engaged by said saddle-like conformation (15) and said elongated prongs (5, 6) have different lengths;
- fastening together a first one (1) and a second one (2) of said rods and metal wires, respectively, extending substantially across each other and in contact with each other at the point of mutual intersection, from which each one of said means branches out with respective pairs of opposite arms

(1A, 1B) and (2A, 2B), said clasping device being connected in a removable manner."

Auxiliary Request 2

The independent claim 1 of the auxiliary request 2 adds the following features in the last but one paragraph of claim 1 of the auxiliary request 1 (underlined by the Board):

"...a curvature in form of an angle bend or an arc of a circle (8) adapted to be engaged, independently one another, elastically upon a surface of the opposite arm (1B) of said first means (1), which lies substantially on the same outer face of said first means (1) that is engaged by said saddle-like conformation (15) and said elongated prongs (5, 6) have different lengths and wherein at least one of the end portions is selectively disengageable from the opposite arm (1B);"

Auxiliary Request 3

The wording of the independent claim 1 of the auxiliary request 3 reads as follows:

"Use of a clasping device in agricultural applications for fastening together a first one (1) and a second one (2) of two substantially rigid means having an elongated or wire-like shape, extending substantially across each other and in contact with each other at the point of mutual intersection, from which each one of said means branches out with respective pairs of opposite arms (1A, 1B) and (2A, 2B), respectively, to form a large-meshed vertical grid to which trunks, branches and shoots of agricultural plants can be tied, said first substantially rigid means (1) being rods (1) set up in a ground vertically and said second substantially rigid means (2) being metal wires (2)

arranged vertically above each other to horizontally connect the rods with each other, said clasping device comprising a flexible metal wire-like member (3) adapted to be wound in a saddle-like manner (15) by about half a turn round the first arm (1A) of said first means (1), the two opposite elongated prongs (5, 6) of said wire-like member being bendable round respective ones of two opposite arms (2A, 2B) of said second means (2), wherein each of said elongated prongs (5, 6) comprises an end portion (6A, 6B) wherein the two end portions (5a, 6a) of said two elongated prongs (5, 6) are engaged, independently one another, elastically upon a surface of the opposite arm (1B) of said first means (1), which lies substantially on the same outer face of said first means (1) that is engaged by said saddle-like conformation (15) and said elongated prongs (5, 6) have different lengths; and wherein each of said two end portions (5a, 6a) of said two opposite elongated prongs (5, 6) is engaged elastically against said opposite arm (1B) of said first means (1) by means of a curvature formed thereon in the form of an angle bend or an arc of a circle (8), and is selectively disengageable from said opposite arm (1B)."

VII. The appellant argues as follows:

With respect to added subject-matter, the following features omitted from claim 1 of the main request are implicitly encompassed within its wording:

- by the arrangement of the wires above each other and extending between two of the vertical rods according to page 1, lines 25 to 27 of the published application the wires are de facto in a stretched relationship between these rods.

- the elastic character is directly derivable from the clasping means made of flexible metal wire, and being removable.

With respect to clarity, the skilled person will understand that the clasping device defined in claim 1 of all requests has to be used to connect the other intersections between the plurality of rods and wires forming the meshed-grid also defined in claim 1.

The auxiliary requests address the objections under Article 123(2) EPC in varying degree.

Remittal is consented to.

VIII. The respondent argues as follows:

Claim 1 of each of the requests lacks some of the features of its main basis, originally filed claims 1,4,5, respectively, relevant parts of the original description relating to the second embodiment:

- the claim defines only a single coupling between a single wire and single rod, whereas in the originally disclosed grid all couplings are as claimed
- the wires are not stated to be vertically arranged
- the claims fail to define the exact shape of curvature, "end section" vs. "prong"
- the independent coupling is not specified
- the elongated prongs need to be engaged elastically against the second arm of the first means,
- according to lines 20-23 of page 1, the wires also need to be stretched between the rods.

Claim 1 of all requests is also unclear as it is not apparent how the means of the opening lines relate to the rod-like members and metal wires further on in the claim. Further, the various versions of claim 1 define

a plurality of rods and wires to form a large meshed grid but only a single clasping for connecting one intersection between a rod and wire. It is thus unclear how the other intersections of the grid are connected.

The term large is relative and does not provide a clear limitation. The condition defined in the claim of rods vertically set up in the ground and horizontal wires does not provide a clear limitation when the ground is inclined.

Remittal is consented to.

Reasons for the Decision

1. The appeal is admissible.
2. Added subject-matter : main request, auxiliary requests 1 and 2
 - 2.1 The present European patent EP 1 954 118 B1 was filed as an international application PCT/EP2006/068901 which was published by WIPO under International publication number WO-A-2007/060224, the content of which forms the application as filed for the purposes of Article 123(2) EPC.
 - 2.2 Whereas the originally filed claims were directed at a clasping device, claim 1 according to the main request is now directed at a method for connecting two rigid means of a grid using a clasping device. The clasping device is further defined in claim 1 of the main request as having certain features. The final step defines how it is then used to fasten together first and second ones of the rods and wires.

The clasping device which is provided to connect rods and wires in a removable manner is defined in claim 1 of the main request as comprising: "...an end portion (5A, 6A) shaped so as to form a curvature ... adapted to be engaged, independently one another, upon a surface of the opposite arm (1B) of said first means (1), which lies substantially on the same outer face of said first means (1) that is engaged by said saddle-like conformation (15) and said elongated prongs (5, 6) have different lengths." This definition combines the features of claims 1,4 and 5 as published together with the feature from the description that the elongated prongs have different lengths. This corresponds to the embodiment described on page 7 of the as filed and published application, lines 6 to 27 in particular, in reference to figures 9 to 12.

However, only some but not all of the features of the clasping device originally defined in claims 4 and 5 have been included. In particular the following feature is missing from claim 1 of the main request and auxiliary request 1: "the two end portions (5a, 6a) of said two opposite elongated prongs (5, 6) are independently engaged elastically against the surface of said second arm".

2.2.1 It therefore needs to be established whether, using the "gold standard" of established case law, cf. Case Law of the Boards of Appeal, 8th edition, 2016 (CLBA hereinafter) II.E.1.2.1, the skilled person can derive directly and unambiguously, using common general knowledge, from the content of the application as filed and in the present case as published that the above feature can be dispensed with. Given that the feature is disclosed originally either in the combination of

claims 1, 4 or 5 or, alternatively, on description page 7 and figures 9 to 12 of the application as published, its omission, which results in an intermediate generalization, is justified only in the absence of any clearly recognisable functional or structural relationship between this feature and those now in claim 1, cf CLBA, II.E.1.7.

2.2.2 The case where each one of both prongs are adapted to independently engage a surface of the opposite side of the first means or wire corresponds, as stated above, to the second embodiment as disclosed in figures 9 to 14 in relation to page 7, line 1 to page 8, last line of the published international application. In that embodiment the prongs 5,6 have different lengths and each one engages the other arm 1B of the rods 1 after the intersection engaging the same side as the saddle 15. On page 7, line 23-25, the prongs are defined to be elastically forced in the direction of the axis of the rod. In the following paragraph, lines 29-32, it is further specified that in a next step each of the prongs are elastically forced in an independent manner into coupling with the arm. The dependent claim 5 as originally filed and referring to the same embodiment also requires the two opposite prongs to be elastically engaged against the same second arm of the rod.

From this description of the prong's structure the skilled reader clearly derives that their elasticity is an important characteristic of this second embodiment. The next sentence on page 7, lines 25 to 27 provides an additional technical explanation of the way this characteristic is used. The fact that the prongs are elastically forced causes the saddle 15 to be pressed against the corresponding portion of the same rod.

The skilled person therefore directly and unambiguously derives from the above content of the description that the elastic force applied by each of the independent prongs provides an important contribution to the coupling force of the clasp device. As such these prongs and their elasticity are not only functionally interrelated in use but also appear indispensable in combination with the arms of different lengths independently engaging the opposite arm of the rods to exert that coupling force. Being closely related for the skilled person it is not immediately apparent that the elastic nature of the engagement could be dispensed with from the specific context of the second embodiment where the prongs having different length and are independently engaged with the other side of the intersection.

- 2.2.3 The appellant argues that the elastic character is implicit from the clasp device made of flexible metal wire-like member as well as from its removability. The Board does not share this view: the term "flexible" in its normal sense implies nothing more than the ability to bend in one direction, it does not require a restorative spring force acting in an opposite direction as is inherent in the term "elastic".

Likewise, a clasp device may be removable without the presence of an elastic force, nor does it mean that device is re-usable. In fact the first embodiment depicted in figures 1 to 8 gives an example of such a removable clasp device in which the coupling is obtained by bending one of the prongs around a loop i.e. without elastical force (e.g. Page 5, last paragraph).

2.2.4 As a clear functional and structural relationship exists between the various features of the 2nd embodiment and the elastic nature of the prongs, the latter feature cannot be omitted without adding subject-matter. Hence claim 1 of the main request as amended is not allowable under Article 123(2) EPC.

2.3 As noted, the subject-matter of claim 1 of the main request has shifted away from the originally claimed clasp device to the method of connecting two elements of a grid. This method includes the steps of providing rods in the ground and arranging metal wires between them and can thus be read as a method of making a grid involving steps, including the provision of the clasp device and its use for fastening, that define how one of the connections is realized.

The originally filed description is mainly concerned with the features of the clasp device (in two alternative embodiments) and how an individual clasp device clamps together a rod and a wire, as illustrated in figures 1 to 8 (first embodiment) and 9 to 14 (second embodiment). It is much less concerned with the actual forming of a complete grid, though the use of the clasp in agricultural applications is indicated in a very general sense, without going into great detail, on page 1, lines 18 to 23.

In that claim 1 of the main request focuses on the connection of only one intersection of the grid, between first and second ones of the rods and wire-like members respectively, it sets down a more specific teaching than the originally disclosed general application of the clasp device to an agricultural grid. That general application at best implies that all intersections are connected with the clasp device of

the claims. The current focus on only a single connection in the grid, however, leaves open how all other intersections are to be connected, and thus allows for the use of different connection means, e.g. that of the first embodiment or those mentioned in the discussion of prior art on page 2. This use of other means together with a clasp device was however never contemplated in the original disclosure. Consequently, this shift of the focus on only a single connection in a grid consequently adds subject-matter extending beyond the original disclosure, contrary to Article 123(2) EPC.

2.4 Claim 1 of auxiliary request 1 adds to claim 1 of main request further features of the second embodiment. However, these amendments fail to address either of the points raised above. The above arguments therefore apply *mutatis mutandis*. Claim 1 of the auxiliary request 1 is thus also not allowable under Article 123(2) EPC.

2.5 Though claim 1 of auxiliary request 2 does now feature elastic engagement of the end portions, it still concerns only a single connection in a grid. The argument raised under point 2.3 above therefore still applies, and claim 1 of the auxiliary request 2 is therefore also not allowable under Article 123(2) EPC.

3. Clarity : main request, auxiliary requests 1,2

The point raised above under section 2.3 also results in a lack of support between the current description and the wording of claim 1 according to any of the main and auxiliary requests 1 and 2, and a concomitant lack of clarity of the claims when read in the light of the description. This lack of clarity is introduced by the

amendments per se and may thus be examined under Article 101(3) EPC for compliance with the EPC, pursuant to G03/14 (OJ 2015, 102).

The description of the patent, which is unchanged vis-a-vis the originally filed description, refers only to the general application of the invention to agricultural grids. There is no definite teaching how this application might look like, though it might be argued that this refers to all connections in a grid. In any case there is no suggestion in the description that only a single connection of a grid must be formed using the clasp device.

4. Auxiliary request 3.

4.1 Article 123(2) and (3) EPC

4.1.1 Claim 1 of the auxiliary request 3 has been amended to define the use of a clasp device in agricultural applications for fastening two rigid means by providing a clasp device, instead of being directed at the clasp device originally defined in the claims as published. A claim defining a physical entity generally confers protection for any use of this physical entity. The shift from a clasp device -for any use- to a more specific use for fastening two rigid means is therefore more limited and does not result in protection being extended, Article 123(3) EPC. This has not been challenged by the respondent.

4.1.2 The use is also limited to an agricultural application and includes all the features of the clasp device originally defined in claim 1 as well as the elongated prongs independently engaged elastically against a surface of the opposite arm of the first means being

rods and which lies on the same outer surface as the saddle-like conformation. These features were the subject of claim 4 as originally published. Claim 1 furthermore includes the features of the original claim 5 in its last paragraph that requires in particular the curvature of the end portions to be in the form of an angle bend or arc of a circle. Thus the clasping device used has all the features of originally filed claims 1, 4 and 5. The question is now whether its use as defined in the claim is directly and unambiguously derivable from the original disclosure.

The claim defines the use in agricultural applications in general to connect wire-like or rodlike members (rods or other elongated members such as poles, posts etc) with metal wires extending horizontally between them. The rods are set up vertically with the wires one above the other to form a large-meshed vertical grid as plant support. These features correspond to the use detailed in lines 25-29 of page 1 of the application as originally published. The use of the clasping device in agricultural field thus has the same specificity as originally disclosed.

Furthermore, by directing the claim to the use of the clasping device for fastening together first and second ones of rigid means its wording corresponds to the more generally formulated use as stated originally on page 1, lines 18 to 24. This formulation moreover avoids the problems associated with that used in the main and first auxiliary request and discussed above under sections 2.3 and 3. Contrary to these previous formulations, claim 1 of the auxiliary request 2 is not limited to a single connection of the grid but rather provides an instruction as to how the connections are to be generally formed, namely by fastening by means of

the clasping device the first and second ones of two rigid means which correspond to the rods and metal wires of the grid.

The resulting subject-matter therefore does not extend beyond the content of the application as filed.

- 4.1.3 The respondent has however argued that according to lines 20-23 of page 1, the wires also needed to be stretched between the rods, which requirement is not included in claim 1 of auxiliary request 3. The description does not give further information on stretching the wires and the skilled person thus interprets the term "stretched" according to the general definition of "extending the full length" between the rods, especially as the description does not include any basis for the more restrictive definition to "draw tight". With that understanding the Board holds that the amended claim 1 implicitly contains the limitation of the wires being stretched between the rods as the metal wires are defined to horizontally connect the rods with each other and therefore extend the full length between these rods. The Board thus concurs with the appellant that the feature is implicit from the wording of claim 1 as amended.

The claim also expressly requires a vertical arrangement of the wires above each other.

Finally, all features defining the clasping device are seen to correspond to the basic features of the second embodiment as set out on as filed application page 7, lines 1 to 27. That there are differences in the terminology (the claim refers to "elongated prongs" and "independent engagement" of "end portions" of the

prongs, where page 7 uses "end sections" and "independent coupling") is of no import, as the skilled person who reads both texts and the figures with his mind willing to understand has no difficulty establishing that they refer to one and the same teaching and have the very same features. In particular he understands that the independent coupling effected by the different length end sections which are shaped with curvatures is identical to the independent engagement by means of curvatures of the end portions of the two prongs of different length.

4.1.4 From the above the Board concludes that the amendments to claim 1 of the Auxiliary request 3 also do not add subject-matter extending beyond the original disclosure, Article 123(2) EPC.

4.2 Clarity - Article 84 EPC

The Board is also satisfied that the use of a clasping device for fastening a first one and a second one of two rigid means which are the rods and wires respectively forming the grid generally defines the fastening of all intersections in the grid, see above. It is also clear that the rigid means correspond to the rods and wires. Similarly, the skilled reader understands easily the arrangement of horizontal wires above each other and across vertical rods that forms the grid. Finally, the meaning of large in "large meshed grid" will be sufficiently clear for the skilled person from the field of agricultural application. In conclusion, insofar as the amendments made subsequent to grant are concerned, these are clear as required by Article 84 EPC.

5. Remittal

The Board has considered the opposition ground based on Article 100(c) EPC together with Articles 123(2) and (3) EPC as well as the requirement of clarity pursuant Article 84 EPC decided by the opposition division in its decision and challenged in the appeal. However, the opposition division did not examine and decide the grounds of Article 100(a) in relation with novelty and inventive step, also raised in opposition. The Board therefore considers it appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the first instance, so that it may examine this remaining opposition ground for claim 1 of the auxiliary request 3. This is particularly so as the appellant and respondent both agree on the remittal.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated