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**Datasheet for the decision
of 13 September 2016**

Case Number: T 1434/13 - 3.5.07

Application Number: 06022069.6

Publication Number: 1777707

IPC: G11B33/04

Language of the proceedings: EN

Title of invention:

Media container with band header

Patent Proprietor:

DuBois Limited

Opponent:

Thomsen, Sönke

Headword:

Container with band header/DUBOIS

Relevant legal provisions:

EPC Art. 54(2), 56, 87(1), 88, 112(1)(a), 123(2)

Keyword:

Priority - identity of invention (no) - different problems in priority applications and patent - combination with isolated features from drawings

Novelty - granted patent (no)

Inventive step - first auxiliary request (no)

Amendments - feature disclosed in drawings in the context of specific embodiments - added subject-matter - second to sixth auxiliary requests (yes)

Referral to the Enlarged Board of Appeal - (no)

Decisions cited:

G 0002/98, G 0003/08, T 0169/83, T 0184/84, T 0081/87,
T 0666/89

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 1434/13 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 13 September 2016

Appellant: DuBois Limited
(Patent Proprietor) Amaray House
Arkwright Road
Corby
NN17 5AE (GB)

Representative: Coulson, Elizabeth Eve
Coulson & Rule
13 Whitehall Road
Rugby, Warwickshire CV21 3AE (GB)

Respondent: Thomsen, Sönke
(Opponent) Hunscheidtstr. 80
44789 Bochum (DE)

Representative: Vogel, Andreas
Patentanwälte
Bals & Vogel
Universitätsstrasse 142
D-44799 Bochum (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 25 April 2013
revoking European patent No. 1777707.**

Composition of the Board:

Chairman R. Moufang
Members: P. San-Bento Furtado
R. de Man

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the patent proprietor (appellant) against the decision of the Opposition Division to revoke European patent No. 1 777 707.
- II. European application No. 06022069.6 on which the patent was granted was filed on 20 October 2006, claiming priority from the following United States patent applications and respective filing dates:
P1: US 728456 P of 20 October 2005;
P2: US 728497 P of 20 October 2005.
- III. Granted claim 1 reads as follows (itemisation added by the Board):
- (1) "A container for carrying an information storage medium, the container comprising:
 - (2) a) a bottom cover (110; 410; 610) having inner and outer surfaces;
 - (3) b) a top cover (111; 411; 611) having inner and outer surfaces;
 - (4a) c) a medium-engaging element (115; 655) provided on the inner surface of at least one (110) of the top and bottom covers
 - (4b) or on an insert tray (650) inserted into the bottom cover (610), for securing a storage medium thereto;
 - (5) d) a hinge (112; 412; 612) connecting the bottom cover (110; 410; 610) and the top cover (111; 411; 611);
 - (6a) e) a display band region (114; 414; 614) provided on the outer surface of at least one of the top cover (111; 411; 611) and the bottom cover (110; 410; 610),

- (6b) in an area proximate and along one edge of the container,
- (7a) the display band region (114; 331; 414; 614) being configured and adapted for display of indicia,
- (7b) and being exposed to an outer side of the container,
characterised in that
- (8) the container comprises a transition (417) defined by said display band region (114; 414; 614)
- (9) that stands proud of the adjacent surface of the outer surface of the at least one of the top cover (111; 411; 611) and the bottom cover (110; 410; 610)."

IV. The patent had been opposed on the grounds of lack of novelty, lack of inventive step and added subject-matter (Article 100(a) and (c) EPC). The opponent had argued that priorities P1 and P2 were invalid with respect to the subject-matter of claim 1 of the granted patent and that, therefore, documents published between the claimed date of priority and the filing date constituted state of the art under Article 54(2) EPC. The opponent cited sixteen documents, including the following:

- D1: WO 2006/095202 A1, published on 14 September 2006;
- D2: US 2003/0029761 A, published on 13 February 2003;
- D4: CD (Community Design) 000527080-0001-0005, published on 27 June 2006;
- D11: US 2003/0094021, published on 22 May 2003;
- D15: EP 1 223 579 A1, published on 17 July 2002.

Documents D1 and D4 were published after the claimed priority date but before the date of filing of the contested patent.

V. The decision under appeal considered a main request of the proprietor that the patent be maintained as granted and further requests that the patent be maintained in amended form on the basis of one of two auxiliary requests, or on the basis of one of the combinations of claims 1 and 2, claims 1 and 3, or claims 1 to 3 of each of those requests.

The Opposition Division came to the conclusion that the subject-matter of the requests did not enjoy the right of priority from either of documents P1 and P2.

Granted claim 1 was regarded as lacking novelty over the disclosure of each of documents D1, D4 or D11. Claim 1 of the first auxiliary request was considered to be fully anticipated by document D1. Each of the filed requests based on combinations of claims of the main request or the then first auxiliary request were considered to lack novelty over document D1. The Opposition Division further found that the requests based on combinations of claims of the main request defined added subject-matter. The second auxiliary request and the requests based on combinations of its claims did not fulfil the requirements of Article 56 EPC when taking into account the combination of documents D1 and D4.

VI. With the grounds of appeal the appellant maintained its main request that the patent be maintained as granted. It also requested that the patent be maintained in amended form in accordance with one of first to sixth auxiliary requests submitted with the grounds of appeal.

VII. In reply to the grounds of appeal, the respondent (opponent) requested that the appeal be dismissed, that none of the requests be allowed, and that the patent be revoked.

The respondent raised objections against the maintenance of the patent, as granted or on the basis of any of the auxiliary requests, on the grounds of Article 100(a) and (c) EPC. It argued that none of the requests fulfilled the requirements for claiming priority from either P1 or P2.

The respondent submitted a conditional request that a question concerning priority right, which it formulated in its letter, be referred to the Enlarged Board of Appeal.

With regard to Article 100(a) and (c) EPC, the respondent argued that the subject-matter of claim 1 of the contested patent extended beyond the content of the original application, was not novel over any of documents D1, D2, D4 or D11, and was not inventive over several combinations of cited documents. The subject-matter of each of dependent claims 2 to 14 was not new and/or not inventive either.

With regard to the auxiliary requests, the respondent argued that claim 1 of each of the first to sixth auxiliary requests infringed Article 123(2) EPC and was not allowable for lack of inventive step over different combinations of the cited prior art. The respondent also argued that the subject-matter of claim 1 of each of the first to fifth auxiliary requests was not new.

VIII. The parties were invited to oral proceedings. In a subsequent communication, the Board summarised the

parties' submissions for each of the appellant's requests, and expressed its preliminary opinion.

With regard to the main request, the Board doubted that the combination of features of claim 1 of the disputed patent found a basis in the application as originally filed or in either of priority documents P1 or P2. The subject-matter of contested claim 1 did not seem to be novel over the disclosure of D1. The Board briefly discussed other cited prior art including document D15, which it considered to be particularly relevant.

The Board informed the parties that a referral of a question related to the problem formulated by the respondent to the Enlarged Board did not seem to be necessary.

Concerning the first auxiliary request, the Board doubted that claim 1 was supported by the application as originally filed or either of documents P1 or P2. None of documents D1, P1 or P2 disclosed the additional feature of the first auxiliary request, the transition retaining the printed material. It did not seem to be consistent to consider that feature not to be disclosed in document D1, but to be directly and unambiguously derivable from priority documents P1 and P2. Consequently, it seemed that either the priority was recognised and claim 1 of the first auxiliary request lacked novelty over document D1 under Article 54(1) and (3) EPC, or the priority was considered invalid and the question of inventive step over the disclosure of document D1 would have to be answered. The Board considered it obvious to conceive the transition of document D1 to retain printed material within the sleeve, especially in the light of document D15.

For each of the second to sixth auxiliary requests, the Board further summarised, and partly commented on, the submissions of the parties with respect to added subject-matter, priority, and novelty and inventive step. It informed the parties that it tended to agree with the respondent and Opposition Division that the technical effect alleged by the appellant regarding the additional feature of the second auxiliary request, which specified a hinge shorter than the covers, could not be recognised.

IX. With letter of 8 August 2016 the appellant informed the Board that it would not attend oral proceedings.

X. By fax of 24 August 2016 the registry of the boards of appeal informed the parties that the oral proceedings would take place as scheduled unless formally cancelled by the Board.

XI. With letter of 29 August 2016, the respondent informed the Board that it would not attend oral proceedings.

It maintained its then-pending requests, in particular that the patent be revoked and the appeal be dismissed. It further made some procedural requests.

The respondent submitted further arguments against novelty and inventive step with regard to the main request and against inventive step with regard to the first to sixth auxiliary requests.

XII. Oral proceedings were held on 13 September 2016 in the absence of both parties. At the end of the oral proceedings, the chairman pronounced the Board's decision.

- XIII. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted or, alternatively, that the patent be maintained in amended form in accordance with one of the first to sixth auxiliary requests submitted with the grounds of appeal.
- XIV. The respondent requested that the appeal be dismissed.

As an auxiliary request, in case the Board did not follow the respondent's reasoning with respect to the right of priority, and in particular if the Board considered features (7a) to (9) to be disclosed in at least one of documents P1 and P2, the respondent requested the following:

"Insbesondere wird beantragt, die Große Beschwerdekammer zu fragen, ob auf Merkmale, die nur in den Zeichnungen, nicht jedoch in der Beschreibung offenbart sind und in keinem Zusammenhang mit den in den Prioritätsdokumenten offenbarten Aufgabenstellungen und Vorteilen stehen, ein Erfindungsgegenstand einer Nachanmeldung gerichtet werden kann." [For a translation see point 12.2 of the reasons below]

With its letter of 29 August 2016 the respondent further requested that

- the oral proceedings be cancelled and a decision according to the state of the file be issued;
- possible submissions by the appellant made after 8 August 2016 not be admitted as late-filed; and
- a new deadline for further submissions or second oral proceedings be set, or the oral proceedings be postponed, in case any further submission by the appellant was not rejected as inadmissible, and

especially if the opposed patent were not to be revoked.

XV. Claim 1 of the first auxiliary request differs from claim 1 as granted (see section III above) in that e) reads as follows:

"e) a display band region (114; 414; 614) provided on the outer surface of the top cover (111; 411; 611) or the top cover (111; 411; 611) and the bottom cover (110; 410; 610), in an area proximate and along one edge of the container, the display band region (114; 331; 414; 614) being configured and adapted for display of indicia, and being exposed to an outer side of the container, characterised in that the container comprises a transition (417) defined by said display band region (114; 414; 614) that stands proud of the adjacent surface of the outer surface of the top cover (111; 411; 611) or the top cover (111; 411; 611) and the bottom cover (110; 410; 610), wherein the transition (417) retains printed material disposed within a sleeve held on said adjacent surface (430)."

XVI. Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that the characterising part of the claim reads as follows:

"the container comprises a transition (417) defined by said display band region (114; 414; 614) that stands proud of the adjacent surface of the outer surface of the at least one of the top cover (111; 411; 611) and the bottom cover (110; 410; 610) and in that the hinge is shorter in length than the top and bottom covers."

XVII. Claim 1 of the third auxiliary request differs from claim 1 of the first or second auxiliary request in that the characterising part of the claim reads as follows:

"the container comprises a transition (417) defined by said display band region (114; 414; 614) that stands proud of the adjacent surface of the outer surface of the top cover (111; 411; 611) or the top cover (111; 411; 611) and the bottom cover (110; 410; 610); in that the hinge is shorter in length than the top and bottom covers; in that the container further comprises a film (113; 330; 535; 635) applied thereto forming a pocket extending from and across the outer surface of the top cover (111; 411; 611), around the hinge (112; 412; 612) and across the outer surface of the bottom cover (110; 410; 610), the pocket providing a receptacle for printed material related to the media held in the container; in that the film (113; 330; 535; 635) is offset from the display band region (114; 331; 414; 614), allowing an unobstructed view of the display band region (114; 331; 414; 614), an edge of the film (113; 330; 535; 635) providing access to an interior of the pocket, which edge is located adjacent said transition; and in that the transition (417) retains printed material disposed within the pocket held on said adjacent surface (430)."

XVIII. Claim 1 of the fourth auxiliary request differs from claim 1 of each of the higher ranking requests in that features e) read as follows:

"e) a display band region (114; 414; 614) provided on the outer surface of the top cover (111; 411; 611) or the top cover (111; 411; 611) and the

bottom cover (110; 410; 610), in an area proximate and along one edge of the container, characterised in that the display band region (114; 331; 414; 614) carries indicia thereon and is exposed to an outer side of the container; in that the container comprises a transition (417) defined by said display band region (114; 414; 614) that stands proud of the adjacent surface of the outer surface of the at least one of the top cover (111; 411; 611) and the bottom cover (110; 410; 610); and in that the hinge is shorter in length than the top and bottom covers."

XIX. Claim 1 of the fifth auxiliary request differs from claim 1 of each of the higher ranking requests in that features e) read as follows:

"e) a display band region (114; 414; 614) provided on the outer surface of the top cover (111; 411; 611) or the top cover (111; 411; 611) and the bottom cover (110; 410; 610), in an area proximate and along one edge of the container, the display band region (114; 331; 414; 614) being configured and adapted for display of indicia by having indicia molded therein, and being exposed to an outer side of the container, characterised in that the container comprises a transition (417) defined by said display band region (114; 414; 614) that stands proud of the adjacent surface of the outer surface of the top cover (111; 411; 611) or of the top cover (111; 411; 611) and the bottom cover (110; 410; 610); and in that the hinge is shorter in length than the top and bottom covers."

XX. Claim 1 of the sixth auxiliary request differs from claim 1 of each of the higher ranking requests in that the text of features e) reads as follows:

"e) a display band region (114; 414; 614) provided on the outer surface of the top cover (111; 411; 611) and the bottom cover (110; 410; 610), in an area proximate and along one edge of the container, wherein indicia is [sic] integrally molded within the display band region (114; 331; 414; 614) and the display band region being exposed to an outer side of the container, characterised in that the container comprises a transition (417) defined by said display band region (114; 414; 614) that stands proud of the adjacent surface of the outer surface of the at least one of the top cover (111; 411; 611) and the bottom cover (110; 410; 610); in that the hinge is shorter in length than the top and bottom covers; in that the container comprises a film (113; 330; 535; 635) applied thereto forming a pocket extending from and across the outer surface of the top cover (111; 411; 611), around the hinge (112; 412; 612) and across the outer surface of the bottom cover (110; 410; 610), the pocket providing a receptacle for printed material related to the media held in the container wherein the film (113; 330; 535; 635) is offset from the display band region (114; 331; 414; 614), allowing an unobstructed view of the display band region (114; 331; 414; 614), an edge of the film (113; 330; 535; 635) providing access to an interior of the pocket, which edge is located adjacent said transition, wherein the transition (417) is suitable for retaining printed material disposed within a pocket held on said adjacent surface (430)."

XXI. Insofar as relevant for the present decision, the appellant's arguments may be summarised as follows:

Priority

Granted claim 1 enjoyed the right to priority from both documents P1 and P2. The features of the claim were disclosed in the description, essentially in paragraphs [0002] and [0003], and in Figures 2, 4B, 5A and 5B of document P1. The features regarding the display band region, including features (7a) and (7b), were recognisable from Figures 2, 5A and 5B of document P1 and Figures 1 to 5, 8, 10 to 13, 17 to 19, 21, 24, 26 and 28 of document P2.

Opinion G 2/98 (OJ EPO 2001, 413) had determined that priority of a previous application in respect of a claim in a European patent application, in accordance with Articles 87(1) and 88 EPC, was to be acknowledged only if the skilled person could derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole. This included subject-matter explicitly and implicitly disclosed by the description, claims and drawings. As set out in decisions T 81/87 (OJ EPO 1990, 250) and T 184/84 (of 4 April 1986), which following G 2/98 still remained sound law, identical wording was not required (emphasis by the appellant). To claim priority of "the same invention" referred to in Article 87(1) EPC, the priority documents did not have to literally mention the features.

The skilled person was knowledgeable of the injection-moulded plastic containers for storage of discs and

injection moulding techniques available at the time. It was from the point of view of the skilled person that the full disclosures of documents P1 and P2 needed to be considered.

Reference was made to Figures 2, 5A and 5B of document P1. The skilled person would have no problem in understanding that the subject-matter presented to him by Figure 5A of P1 was a moulded plastic disc package and that the Blu-Ray symbol that was shown as having a depth and profile was integrally moulded in that display band or header region. The skilled person would also recognise that the Blu-Ray symbol was one of many symbols that could be moulded into a display band and as such was representative of indicia. Figure 5A of P1 therefore disclosed to the skilled person a package for a disc having a display band region that was configured and adapted, by having a logo moulded therein, for the display of indicia. The skilled person was taught that the disclosure related to injection-moulded plastic packages. A region in the form of a band was visible in the drawings, which was deliberately raised to provide a display band region.

With respect to document P2, a display band region could be seen in each of Figures 1 to 5, 8, 10 to 13, 17 to 19, 21, 24, 26 and 28. In the embodiments shown in Figures 21, 24 and 26, an indicium was provided upon the inner surface of the back cover and an aperture was provided in a front cover, in a banded region. Through the provision of an aperture in the banded region, the display band region was configured and adapted for displaying the indicia when the front cover was closed. Figure 21 showed the edge of the aperture in the front cover. Paragraph [0031] explicitly stated that the package was moulded as shown in Figure 11.

With reference to paragraph 2.1 of the contested decision, it was submitted that the fact that neither P1 nor P2 was directed to solving the problem addressed by the patent in suit was immaterial. The problem objectively solved by each one of the inventions of P1 and P2 could be redefined during prosecution, and what might have appeared to be a lesser side-effect of a claimed invention at a certain point in time could turn out later to be the real invention. There was no legal basis therefore for inferring from the statements of P1 and P2 concerning the field of the invention what the entire subject-matter disclosed in those documents was.

The additional feature of claim 1 of the first auxiliary request was disclosed in priority document P1 in Figure 5B.

Novelty - document D1

Document D1 could only be citable under Article 54(3) EPC and did not disclose features (8) and (9), the container comprising a transition defined by the display band region that stands proud of the adjacent surface of the outer surface of the at least one of the top and bottom covers.

The term "transition" as defined in paragraph [0026] of the A1 publication was to be interpreted as a physical border, such as a step. The term "transition" was not literally mentioned in the specification of D1. The case law regarding the assessment of novelty was well established (the appellant cited decision T 666/89, OJ EPO 1993, 495). The explicit disclosure provided by the statement of page 4, first paragraph, of document D1 that the display band region stood proud, e.g. by 0.5

to 1.0 mm, of the adjacent surfaces of the container was only a novelty-destroying disclosure of "transition" if in producing such a display band region a transition was inevitably formed. This was not the case. For example, a smooth curve could exist between the proud-standing portion and the adjacent surface of the container. Figures 1A and 3A did not disclose the feature either.

Added subject-matter

Contrary to the finding of the contested decision, the statements in paragraphs [0008], [0011], [0017], [0018] [0033] and [0072] [sic] of the A1 publication clearly supported the provision of a first and second cover, at least one of which was provided with a band header, i.e. the "provision of a display band region in either of the first and/or second covers". The features of claim 1 of the first auxiliary request were further disclosed in paragraph [0026] and claim 2. The additional feature of the second auxiliary request was supported by Figure 6B.

XXII. In so far as relevant for the present decision, the respondent argued essentially as follows:

Priority

Priority documents P1 and P2 did not disclose features (7a), (7b), (8) and (9), as well as some alternatives recited by features (4a) and (6a).

The appellant had not explained where in priority documents P1 and P2 feature (7b), relating to the display band region being exposed to an outer side, was disclosed. Regarding features (8) and (9), it was not

clear from Figure 4b of P1 whether a transition existed and whether it stood proud. Since the three-dimensional perspective of Figure 12 of P2 was incorrect, no height information could be derived from it. None of the drawings of P1 and P2 showed the display band region standing proud only of the outer surface of the top cover. The Opposition Division had been right in considering that feature (7a) was not disclosed in either of the priority documents. The drawings of P1 and P2 showed only a particular relief-type marking. Since, however, the claim recited a display band region which was generally "configured and adapted for display of indicia", it also covered other markings, such as markings which were later printed or otherwise provided on or in the display band region.

Even if the features were considered to be depicted in the drawings of P1 and P2, that would still not lead to sufficient disclosure.

It was clear from opinion G 2/98 (reasons 5, 8.1 and 9 were cited) that a right to priority could only be validly claimed if the skilled person would directly and unambiguously derive the claimed subject-matter from the previous application as a whole, and that for reasons of ensuring equal treatment and legal certainty the application and the priority document had to relate to the same invention in accordance with Article 87(1) EPC. Opinion G 2/98 clearly departed from a broad interpretation of the priority right to give preference to a narrow interpretation of that right (emphasis by the respondent).

Likewise, decision T 169/83 (OJ EPO 1985, 193), which had been cited by the patent proprietor (in the first-instance proceedings), taught that the claims of a

patent could be restricted by further specifying features, as long as those features were clearly included in the originally filed drawings and were, in terms of structure and function, clearly, unmistakably and fully recognisable to the skilled person as being manifestly part of the invention from the drawings in accordance with the whole content of the description of the drawings (emphasis by the respondent).

Those requirements were not met in the present case. Documents P1 and P2 dealt with different problems and did not mention the problem described in the application, namely the difficulty in locating a film in the desired format, or the function of features (8) and (9) of securing the printed material in the pocket/sleeve. Documents P1 and P2 did not disclose the function of the essential features (7a) to (9). Claim 1 of the patent therefore did not recite the same invention as documents P1 and P2 and was not unitary with the inventions of those documents.

Regarding the appellant's argument that the solved problem could be redefined and that thus the problem addressed by the patent did not have to be mentioned in priority documents P1 and P2, the respondent was of the opinion that in any case this would only apply to side-effects, not to a completely different invention. Furthermore, it was not allowable to isolate features from the essential features of P1 and P2, such as those described in documents P1 and P2.

With regard to the first auxiliary request, the additional feature of claim 1 was definitely not disclosed in Figure 5B of document P1, according to which an adhesive was used to retain the printed material in the sleeve (see paragraph [0024]).

Document P2 disclosed neither printed material nor a sleeve.

Novelty and inventive step - document D1

The subject-matter of claim 1 of both the opposed patent and the first auxiliary request was disclosed in document D1, in passages on page 3, last paragraph, to page 4, and Figures 1A to 3B.

Regarding the appellant's arguments, the claim had to be read in its broadest interpretation, and the effect of the transition mentioned by the appellant was not recited in claim 1 of the contested patent. The "standing proud" feature of document D1 implied a transition in the form of a step.

Added subject-matter

None of the requests fulfilled the requirements of Article 123(2) EPC. With regard to the second auxiliary request, the additional feature reciting a hinge shorter than the adjacent edges was too broad, covering hinges shorter or longer than that shown in Figure 6B. That feature was not disclosed in the context of combinations of features covered by claim 1 of each of the third to sixth auxiliary requests either. Some combinations constituted added subject-matter; for example, the medium-engaging element provided on the bottom cover was only disclosed in connection with the embodiments of Figures 1 to 3, not in connection with the embodiment of Figure 6B.

Reasons for the Decision

1. The appeal complies with the provisions referred to in Rule 101 EPC and is therefore admissible.

The invention

2. The invention concerns a container for carrying a storage medium, e.g. a CD, including bottom and top walls connected by a hinge or spine and a medium-engaging element provided on the inner surface of at least one of the top and bottom walls (or "covers") for securing the storage medium (see paragraphs [0025], [0034] and [0035] of the B9 publication).

In one of the embodiments of the description, the container includes a display region provided on the outer surface of the top wall, configured and adapted for the display of indicia (paragraph [0025]).

The container may further include a film forming "a pocket extending from and across the outer surface of the top wall, around the hinge and across the outer surface of the bottom wall", which "can function as a receptacle for printed material related to the media held in the container" (see paragraph [0026]).

Main request

3. *Priority*
 - 3.1 The Opposition Division was of the opinion that neither P1 nor P2 disclosed feature (7a) of claim 1, i.e. the display band region being configured and adapted for display of indicia. Neither of those documents was concerned with the problem solved by the opposed

patent, which was displaying additional media format information on the container. Furthermore, some specific preferred features mentioned in the summary of the invention in paragraphs [0013], [0016] and [0018] of the B1 publication had no basis in documents P1 and P2.

3.2 It is common ground in the parties' submissions that neither of the priority documents P1 and P2 describes in written form all the features of claim 1 as granted. The points of dispute are whether the subject-matter of claim 1, in particular features (7a) to (9) and some alternatives recited by features (4a) and (6a), can be considered to be disclosed in the priority document as a whole, taking the drawings into account.

3.3 In opinion G 2/98, the Enlarged Board ruled that the requirement for claiming priority of "the same invention", referred to in Article 87(1) EPC, meant 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 reasons 9 and headnote).

It follows that when acknowledging priority, even though - as argued by the appellant - identical wording is not required, a narrow or strict interpretation of the concept of "the same invention" in accordance with opinion G 2/98 has to be applied. The criterion "directly and unambiguously derivable, using common knowledge" is the same as that used for judging whether an amendment fulfills the requirements of

Article 123(2) EPC (see also Case Law of the Boards of Appeal, 8th edition 2016, II.D.3.1.1 and 3.1.2).

Decision T 169/83, which has been cited by the parties, discusses the restriction of granted claims with features taken from drawings. The Board agrees that conclusions of that decision regarding the interpretation of features shown solely in drawings have since been considered relevant in different contexts, including those of priority right and added subject-matter (see e.g. Case Law of the Boards of Appeal, 8th edition 2016, I.C.4.6, II.C.2, II.D.3.1.3 and II.E.1.12.1).

According to decision T 169/83, features clearly disclosed only in the original drawings can be used to define more precisely the subject-matter for which protection is sought as long as the skilled person can, on the basis of the whole description, unmistakably and fully recognise those features in terms of their structure and function as being manifestly part of the invention. An amendment is unallowable if the overall change in content of the application, whether by way of addition, alteration or excision, results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application (see e.g. T 169/83, headnote, reasons 3.5 and 3.7). Amendments directed to an undisclosed arbitrary combination of features of different embodiments are not allowable.

Those findings equally apply to the requirements needed to establish whether the right of priority is valid with respect to claimed subject-matter comprising features taken from drawings of a priority document.

3.4 According to the appellant's submissions and the description, the invention of granted claim 1, and in particular the display band region characterised by features (7a) and (7b), addresses the problem described in paragraphs [0004] and [0005] of the B9 publication, i.e. difficulty locating a film in the desired format. This problem was due to the ever increasing variety of formats for recorded media and lack of a consistent way of providing icons indicating the medium format on an easy-to-find location of the printed material. The solution consisted in providing a band-shaped region for display of indicia (paragraphs [0018] and [0019]).

3.5 Each of documents P1 and P2 consists of a description in text and drawings. Neither of the documents includes claims. Some of the figures of documents P1 and P2 do indeed seem to depict a display band region. However, neither of the documents even refers in the text to a display region or a transition, or the function of displaying indicia for easily locating a film in the desired format. Without an accompanying description of the display band region, the Board is not fully convinced that the skilled person would be able to clearly and unambiguously derive from documents P1 and P2 the function and structure of the display band region in the packages described in those documents.

The Board further notes that the drawings of documents P1 and P2 do not show all the alternatives covered by the claim. For example, none of the drawings depicts the alternative defined by feature (6a) of a display band region only on the outer surface of the bottom cover.

More importantly, the packages of documents P1 and P2 address different problems to those addressed by the

container of the disputed patent and have different combinations of features, as explained in the following.

- 3.5.1 The package of document P1 is designed in such a way that the spine of the package has a curved or rounded profile similar to the three remaining edges of the CD package. This is achieved through a living hinge configuration that is adapted to allow the spine to be curved or rounded (paragraphs [0007] and [0008]). In that configuration, the spine portion and living hinges of the package are not located in the plane of the base and cover portions when the package is in the open position, as in the related art described in P1, but above that plane at approximately the mid-height of the base and cover portions. The living hinges are positioned at the end of an arc that extends from the outer surfaces of the cover and base (see paragraphs [0021] and [0022] and Figure 3B).

The rounded or curved ends and spine are therefore essential features of the invention disclosed in document P1 (see also paragraph [0020]). Those features are present in each of the packages described or depicted in the drawings, with the exception of Figure 1 illustrating the prior art, which however does not show a display band region. The skilled person would understand each of the embodiments of the invention of document P1 to include those essential features and that the curved or rounded edges and spine could not be left out. However, claim 1 of the contested patent does not recite rounded or curved ends. Document P1 therefore does not disclose the subject-matter of claim 1, which lacks those features.

3.5.2 The compact disc packages of document P2 address the problem of avoiding tampering with or theft of the storage medium in the package (paragraph [0004]). In order to solve that problem, each of the embodiments includes a security feature such as a band (see e.g. Figure 6, reference sign 270, paragraph [00022]), a bar (see e.g. Figure 10, reference sign 490, paragraphs [00016] and [00029]) or a tag (see e.g. Figure 29, reference sign 530, paragraph [00032]). The security feature is described in document P2, for each of the respective embodiments, as an essential feature of the package. Furthermore, the spine and edges of each of the containers shown in the drawings of document P2 are rounded or curved for the same purpose as that described in document P1 (see paragraphs [00021] and [00028] of document P2).

Figures 10 to 13, 17 to 19, 24, 26 and 28 of document P2, cited by the appellant as depicting the display band region, do not show a medium-engaging element. The appellant also argued that Figures 1 to 5, 8 and 21 showed an embodiment with a front cover comprising an aperture provided in a display band region and an insert tray with indicia thereon. However, the Board notes that the written disclosure of document P2 describes neither the display band region nor the marking. Even if the skilled person were to interpret the drawings of document P2 as depicting a display band region, he would not derive from those drawings and corresponding written description the broader display band region covered by claim 1 of the contested patent, but only the specific solution including a display region with an aperture, an insert tray, the marking being provided on the insert tray (paragraph [0022]). Paragraph [0003] mentions that other enclosures omit the tray, but this paragraph

describes the prior art and does not disclose a display band region.

The Board is therefore of the opinion that the skilled person would not directly and unambiguously derive from document P2 the teaching of a package including the specific combination of features recited in claim 1 of the contested patent, which includes features of separate embodiments and excludes essential features common to all embodiments. The skilled person would not understand from document P2 that the security feature and the curved or rounded edges were optional.

3.6 Taking the above reasoning into account, the Board concludes that neither document P1 nor document P2 discloses the same invention as claim 1 of the contested patent as required by Articles 87(1) and 88 EPC. Neither of those documents therefore can serve as a basis for validly claiming a right of priority with respect to the subject-matter of claim 1 of the disputed patent.

4. *Novelty - document D1*

4.1 It follows from the above that the effective filing date with respect to claim 1 of the disputed patent is the date of filing of the European patent application, 20 October 2006. Since document D1 was published before that date, on 14 September 2006, it forms part of the state of the art under Article 54(2) EPC.

4.2 The Opposition Division found that the disclosure of document D1 anticipated the subject-matter of claim 1 of the contested patent.

4.3 It is undisputed that document D1 discloses all the features of the non-characterising part of the claim, features (1) to (7b). Indeed, the paragraph bridging pages 3 and 4 describes, with reference to Figures 1A and 1B, a container for carrying an information storage medium comprising a bottom cover and a top cover connected by a hinge, a medium-engaging element 15 on the bottom cover and a band region 14. The band region is described as being "at the top", extending "across the front face of the container, around the spine and across the rear face of the container", being "available for customized moulding, e.g. of graphics or logos". The Board therefore confirms that features (1) to (7b) are disclosed with respect to the container described on page 3, last paragraph, to page 4, and Figures 1A and 1B of document D1.

The Board further notes that in the container of Figures 3A and 3B, which also comprises those features, the band 31 is larger and is explicitly described (see page 6, first paragraph) as being "adjacent the upper end of the container, where the external surface of the injection moulded container is exposed and where customised features can be formed".

With regard to the characterising features (8) and (9), the Board confirms the appellant's assertion that the word "transition" is not literally used in the text of document D1. However, the paragraph bridging pages 3 and 4 includes the following sentence (which is very similar to the last sentence of paragraph [0035] of the B9 publication of the present patent):

"Preferably, this band around the upper end of the container stands proud, e.g. by 0.5-1.0mm, of the adjacent surfaces of the container."

The Board does not find the arguments of the appellant convincing according to which a transition in the meaning of the claim was not inevitably formed by the feature disclosed in that paragraph of document D1. In the Board's view, a transition in the container of D1 is implied by the fact that the display band region stands proud of the adjacent surfaces of the container. In the absence of a further description of the transition, the claim covers a simple transition established by the border between two regions in different planes, as described in that sentence of document D1.

Features (8) and (9) are therefore also disclosed for the embodiment described in the paragraph bridging pages 3 and 4 of document D1.

- 4.4 Consequently, the subject-matter of claim 1 of the contested patent is not novel over the disclosure of document D1 (Article 54(1) and (2) EPC).

First auxiliary request

5. Claim 1 of the first auxiliary request differs from granted claim 1 in that features (6a) and (9) were amended as listed below under features (6a') and (9'), respectively, and in that feature (10) was added:
- (6a') e) a display band region (114; 414; 614) provided on the outer surface of the top cover (111; 411; 611) or top cover (111; 411; 611) and the bottom cover (110; 410; 610);
 - (9') that stands proud of the adjacent surface of the outer surface of the top cover (111; 411; 611) or the top cover (111; 411; 611) and the bottom cover (110; 410; 610),

- (10) wherein the transition (417) retains printed material disposed within a sleeve held on said adjacent surface (430).

Features (6a') and (9') differ from the corresponding features (6) and (9) of the main request in that the second option referring to only the bottom cover is no longer recited.

6. *Priority*

6.1 For the first auxiliary request, the appellant repeated its submissions with respect to the main request and additionally argued that priority document P1 disclosed feature (10) in Figure 5B, which illustrated a clear film (150), a trap (152) and a slip sheet inserted therein.

6.2 The reasoning given under points 3.5 to 3.6 above with regard to the main request equally applies to claim 1 of the first auxiliary request.

Furthermore, the Board finds that feature (10) is not disclosed in document P1, for substantially the same reasons as given by the respondent (see section XXII above, last paragraph). In particular, feature (10) is not recognisable from Figure 5B of document P1 and the description of that drawing in paragraph [0024] only discloses that the depicted container uses an adhesive to retain the printed material in the sleeve.

With respect to document P2, the Board notes that paragraph [0003], last three lines, reads "in certain embodiments a clear plastic sheet or film is weld [sic] across the outside of the package so as to form a pocket or trap for receiving an insert containing

graphics (i.e., a slip sheet)." However, there is no disclosure of the transition retaining the slip sheet.

In consequence, neither of the two priority claims can be considered valid with regard to claim 1 of the first auxiliary request (Articles 87(1) and 88 EPC).

7. *Novelty and inventive step - document D1*

7.1 Regarding novelty over the disclosure of document D1, the appellant essentially relied on its reasoning for the main request, further arguing that document D1 did not disclose feature (10).

7.2 The respondent contended that features (8), (9') and (10) were disclosed in document D1, in the paragraph bridging pages 3 and 4.

In reply to the appellant's argument that document D1 did not disclose a transition within the meaning of the claim, which had to be interpreted as a step, the respondent argued that the German term "hervorstehen" was the translation for "standing proud" and implied a step. Furthermore, only a step transition would make sense for the skilled person (the respondent referred to the Guidelines for Examination in the EPO, G-VI,2). In its letter of 29 August 2016 the respondent further argued that it would be clear for the skilled person that with a gradual transition the distance between the band and the adjacent surface would fall below the limit of 0.5 mm as a side-effect, and that only a step would ensure that the band stood proud by at least 0.5 mm of the adjacent surfaces of the container, as taught by document D1.

In both its letters, the respondent submitted that even if it were considered that the transition of the container of document D1 did not retain the printed material, the subject-matter of claim 1 of the first auxiliary request would nevertheless not be inventive. It would be obvious for the skilled person facing the problem of retaining the printed sheet in the container of document D1 to do so by means of the transition which stood proud of the adjacent surface, based on his common general knowledge or the disclosure of document D15, paragraphs [0014], [0015], [0112] and [0114] and Figures 29 to 31.

- 7.3 For the reasons given under point 4 above concerning the main request, the Board is of the opinion that document D1 discloses a container comprising features (1) to (9') of claim 1 of the first auxiliary request.

With regard to feature (10), in addition to the passages cited by the respondent, document D1 also describes the sleeve for holding printed material (part of feature (10)) in combination with the band region on page 6, second to seventh lines, with reference to Figures 3A and 3B, and in claims 5 and 6.

- 7.4 The appellant argued, on the one hand, that the skilled person understood that the transition of either P1 or P2 retained the slip sheet and, on the other hand, that document D1 did not disclose that feature. The Board notes that none of the documents D1, P1 or P2 explicitly describes that feature. It would be inconsistent to consider it not to be disclosed in document D1, but to be directly and unambiguously derivable from priority documents P1 and P2. The appellant's line of argument is therefore not convincing.

The Board however recognises that document D1 does not disclose that the transition has the function of holding the slip sheet.

7.5 The subject-matter of claim 1 of the first auxiliary request therefore differs from the container of document D1 in that the transition retains printed material. The distinguishing feature solves the problem of how to retain printed material in the sleeve of the container of document D1.

7.6 Document D1 does not explain how the printed material is inserted into the sleeve. In the Board's opinion, it would be obvious for the skilled person facing the above problem to insert the sleeve from the top and to conceive the existing transition to the display band region as means for holding the sleeve.

Furthermore, the Board notes that document D15 describes a magnetic tape cassette storage case with a transparent sheet for inserting printed material between the transparent sheet and the lid portion of the case (see abstract, paragraphs [0111] to [0113], Figures 29 to 31). Document D15 is in the same field of containers for storage media as the present invention and also includes a transparent sheet for printed material.

The skilled person would therefore take document D15 into account when looking for solutions related to the transparent sheet of the container of document D1. Document D15 discloses that ridges around the lid portion are used to prevent the printed material from slipping out (see paragraphs [0014], [0015] and [0114], Figures 29 to 31).

In the Board's view, the skilled person facing the above-mentioned problem would immediately recognise that a solution equivalent to that of document D15 could be adopted in the container of document D1 by using the transition described in document D1 for retaining printed material in the sleeve.

- 7.7 The subject-matter of claim 1 of the first auxiliary request therefore does not involve an inventive step (Articles 52(1) and 56 EPC).

Second to sixth auxiliary requests

8. Claim 1 of each of the second to sixth auxiliary requests recites the following feature:
(11) in that the hinge is shorter in length than the top and bottom covers.

9. *Added subject-matter*

- 9.1 In the context of its inventive-step analysis in the decision under appeal, the Opposition Division found implausible the technical problem mentioned by the proprietor with regard to the shorter hinge, namely the retention of written material in the sleeve/pocket located adjacent to the display band region and avoiding interference of such written material with the indicia in the display band region. It was completely unclear why and how the shorter hinge should produce such an effect, which could not be inferred from the drawings. The description as originally filed was silent on the length of the hinge and thus could not assist in the identification of the technical problem.

When analysing Figures 5 and 6A to 6C, which formed the basis for the amendment of the feature of a shorter hinge, it appeared rather that the hinge being shorter than the top and bottom covers was an immediate consequence of the rounding of the covers' corners, since the hinge could only extend along the straight portions of the adjacent edges of the covers.

9.2 In the statement of grounds of appeal, the appellant argued that feature (11) was supported by Figure 6B of the application as originally filed, and that the fact that the hinge was shorter than the top and bottom covers had the advantage of "preventing the hinge from acting as a guide along which the printed material may slide so as to move over the transition provided by the display band region".

9.3 With regard to feature (11), the respondent argued that the feature was too broad, covering hinges shorter or longer than that shown in Figure 6B. Feature (11) was therefore not allowable under Article 123(2) EPC. The function of feature (11) was unclear, as had been explained by the Opposition Division. The advantage mentioned by the appellant of preventing the hinge from acting as a guide could not be derived from the feature as claimed in its whole scope and was not mentioned in the application as originally filed.

The respondent also argued, with regard to claim 1 of each of the second to sixth auxiliary requests, that feature (11) was not disclosed in the context of combinations of features covered by each of those claims. The respondent stated *inter alia* that since the medium-engaging element provided on the bottom cover was only disclosed in connection with the embodiments of Figures 1 to 3 and not in connection with the

embodiment alleged to show feature (11) of Figure 6B, the combination of features (4a) and (11) constituted added subject-matter.

9.4 The Board points out that no details regarding the length of the hinge, either in general or for specific embodiments, can be found in the description and claims as originally filed, which therefore do not provide support for feature (11). Accordingly, the appellant has only cited drawings as a basis.

9.4.1 The skilled person immediately recognises from an analysis of the drawings that the hinges of the containers of Figures 1A, 1B, 2 and 3 have the same length as the covers and that one of the major distinctions between those containers and that of Figures 4 and 5 is that the latter "includes rounded edges 435, which meet at respective rounded corners 431", the corners being "arcuate and relatively gradual" (see page 10, second paragraph, of the original description). It is also directly apparent from a comparison of the drawings that the embodiment of Figures 6A to 6C includes substantially the same rounded corners as the embodiment of Figures 4 and 5.

9.4.2 From Figure 4 it is impossible to derive the length of the hinge. In Figure 5 only the lower end of the hinge is visible; the hinge seems to extend substantially to the edge of the covers. Even if the skilled person were to interpret Figure 5 as depicting a hinge shorter than the covers, she would only derive from that drawing the specific embodiment shown on it. She would note that Figure 5 depicted a container with rounded corners and edges, and a rounded hinge. As explained in the decision under appeal (see point 9.1 above), from an analysis of Figure 5 she would conclude that the lower

end of the hinge extended to the rounded portions of the adjacent edges of the covers to accommodate the rounded corners of the covers. The skilled person would not derive a general teaching of shorter hinges with arbitrary lengths, as recited in claim 1 of each of the second to sixth auxiliary requests.

- 9.4.3 With regard to Figures 6A to 6C, it could be argued that the skilled person would interpret Figure 6B as depicting a hinge extending from a point at the transition defined by the display band region down to the rounded portion of the adjacent edges of the top and bottom covers, i.e. a hinge shorter than the adjacent edges of the top and bottom covers. However, as explained in the preceding point, the skilled person would see a connection between the upper and lower ends of the hinge and, respectively, the transition to the display band region and the rounded portion of the adjacent edges. Furthermore, Figure 6B relates to the specific embodiment of Figures 6A to 6C explicitly described in the application as comprising e.g. rounded corners, an insert tray with an indicia region and a top cover with an aperture through which the indicia region is visible (page 10, third paragraph). The skilled person would only derive from Figure 6B, or from Figures 6A to 6C, an embodiment including those features.

Claim 1 of each of the second to sixth auxiliary requests not only fails to recite those features of the embodiment of Figure 6B, but in addition specifies features not originally disclosed with regard to that embodiment. For example, each of those claims covers a container comprising the medium-engaging element on the inner surface of at least one of the covers (feature (4a)), in spite of the fact that the medium-

engaging element of the embodiment of Figures 6A to 6C is provided on the insert tray. Finally, claim 1 of each of the second to sixth auxiliary requests covers hinges of different lengths, including hinges shorter or longer than that shown in Figure 6B. The combination of features of claim 1 of each of the second to sixth auxiliary requests cannot therefore be directly and unambiguously derived from the application as originally filed.

- 9.5 From the above reasoning it follows that none of the second to sixth auxiliary requests fulfils the requirements of Article 123(2) EPC.

Further procedural requests

10. Concerning the request by the respondent that the oral proceedings be cancelled and that a decision according to the state of the file be issued, the declaration of the appellant that it would not attend oral proceedings could indeed have been treated as equivalent to a withdrawal of the request for oral proceedings (see Case Law of the Boards of Appeal, 8th edition 2016, II.C.1.3.). However, in the present case the Board found it expedient to hold oral proceedings in order to arrive at a final decision on the scheduled date (Article 116(1) EPC) and therefore decided to maintain the oral proceedings.
11. Both the request that possible submissions by the appellant made after 8 August 2016 not be admitted as late-filed, and the request for a new deadline for further submissions, second oral proceedings, or postponement of oral proceedings if the opposed patent was not to be revoked are moot as they are conditional on developments that did not take place. In particular,

there were no further submissions by the appellant and the revocation of the patent is not to be reversed.

12. *Conditional request for referral*

12.1 As an auxiliary request, in case the Board did not follow the respondent's reasoning with respect to the right of priority, and in particular if the Board considered features (7a) to (9) to be disclosed in at least one of documents P1 and P2, the respondent requested that a question be referred to the Enlarged Board of Appeal.

12.2 In its communication, the Board suggested the following translation of the request formulated in German by the respondent (see section XIV. above):

"In particular, it is requested that the Enlarged Board of Appeal be asked whether the subject-matter of a subsequent application can be directed to features which are disclosed only in the drawings, and not in the description, and which are not related to the problems and advantages disclosed in the priority documents."

12.3 As explained in the Board's preliminary opinion, it is primarily the duty of the boards of appeal to interpret and apply the European Patent Convention (G 3/08, OJ EPO 2011, 10, reasons 7.3.2 to 7.3.5). In the present case, the Board is not convinced that there is a divergence or conflict in the case law regarding the question posed (see also G 3/08, reasons 7, 7.1, 7.2.6); the established case law already gives a clear answer to the question, in line with opinion G 2/98 and decision T 169/83 discussed above.

12.4 Furthermore, an answer is not required in order to decide on the present appeal because the Board has come to the conclusion that, for the reasons set out above (see points 3.5, 3.6 and 6), the priorities P1 and P2 can in any event not be validly claimed with respect to the subject-matter defined in claim 1 of the patent as granted and in claim 1 of the first auxiliary request.

12.5 Referral of a question of law to the Enlarged Board of Appeal is therefore not needed.

Conclusion

13. Since none of the appellant's requests is allowable, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Vottner

R. Moufang

Decision electronically authenticated