Internal distribution code:

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

Datasheet for the decision of 19 December 2018

Case Number: T 1698/14 - 3.2.04

Application Number: 07733479.5

Publication Number: 2043494

IPC: A47L9/16, A47L5/24

Language of the proceedings: EN

Title of invention:
HANDHELD CLEANING APPLIANCE

Patent Proprietor:
Dyson Technology Limited

Opponent:
Stanley Black & Decker Inc.

Headword:

Relevant legal provisions:
EPC Art. 54(2), 111(1)
RPBA Art. 12(4), 13(3)

Keyword:
Late-filed document - admitted (yes)
Novelty - (no)
Appeal decision - remittal to the department of first instance (no)
Late-filed request - submitted during oral proceedings - admitted (no)

Decisions cited:
T 1913/06, T 1060/96, T 0402/01, T 0111/98, T 1600/06

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1698/14 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 19 December 2018

Appellant-Opponent: (Opponent)	Stanley Black & Decker Inc. 210 Bath Road Slough Berkshire SL1 3YD (GB)
Representative:	SBD IPAdmin 210 Bath Road Slough, Berkshire SL1 3YD (GB)
Respondent-Proprietor: (Patent Proprietor)	Dyson Technology Limited Tetbury Hill Malmesbury, Wiltshire SN16 0RP (GB)
Representative:	Macpherson, Carolyn May Dyson Technology Limited Intellectual Property Department Tetbury Hill Malmesbury, Wiltshire SN16 0RP (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 18 June 2014 rejecting the opposition filed against European patent No. 2043494 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	A. de Vries
Members:	G. Martin Gonzalez
	C. Heath

Summary of Facts and Submissions

I. The Appellant-Opponent lodged an appeal, received on 7 August 2014, against the decision of the opposition division of the European Patent Office posted on 18 June 2014 rejecting the opposition filed against European patent No. 2043494 pursuant to Article 101(2) EPC, and simultaneously filed the statement setting out the grounds of appeal and paid the appeal fee.

II. Opposition was filed under Article 100(a) EPC based on lack of novelty and of inventive step. In its decision the opposition division held that granted claim 1 was new.

III. The present decision also makes reference to the following documents:

(D12) WO 2004/069021 A1 - filed by the Respondent-Proprietor with letter of 18 December 2014.

(D21) KR 10-0577679 (including a translation into English language) - filed by the Appellant-Opponent with letter of 10 December 2014.

IV. The Appellant-Opponent requests that the decision under appeal be set aside and that the European patent be revoked.

The Respondent-Proprietor requests that the appeal be dismissed, in the alternative that decision under appeal be set aside and that the case be remitted to the first instance, or that the patent be maintained based on one of Auxiliary Requests III or IV, both filed during oral proceedings. Previously filed auxiliary requests I and II were withdrawn.

V. Oral proceedings before the Board were duly held on 19 December 2018.

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

(a) Main request - claims as granted

"A handheld cleaning appliance (10) comprising a main body (12) which houses a motor and fan unit for drawing an airflow along an airflow path between a dirty air inlet (18) and a clean air outlet (24), an electrical power source (14) arranged to power the motor, and a separating apparatus located in the airflow path leading from the air inlet to the air outlet for separating dirt and dust from an airflow, the separating apparatus comprising a cyclonic separator (100) having at least one first cyclone (102), characterised in that the cyclonic separator further comprises a plurality of second cyclones (130) arranged in parallel with one another and located downstream of the or each first cyclone (102)".

(b) Auxiliary request III

Claim 1 reads as in the main request, with the addition of the features of granted claim 2 at the end of the claim:
"...~~.~~, wherein the appliance further comprises a handle (16) and the cyclonic separator (100) lies between the handle (16) and the dirty air inlet".

(c) Auxiliary request IV

Claim 1 reads as in the main request, with the addition of the features of granted claim 3 at the end of the claim:
"...~~.~~, and wherein the cyclonic separator (100) has a longitudinal axis (X-X) that lies substantially parallel to the handle (16)".

VII. The Appellant-Opponent argued as follows:

New document D21 should be admitted as its late filing is justified and the document is highly relevant. Remittal to the first instance is not appropriate for reasons of procedural economy, public interest and legal certainty. The subject-matter of granted claim 1 is anticipated by D21. Auxiliary requests III and IV of the Respondent-Proprietor, filed during the oral proceedings, should not be admitted.

VIII. The Respondent-Proprietor argued as follows:

Late filed document D21 should not be admitted and if admitted, remittal of the case to the first instance is appropriate and justified. The subject-matter of granted claim 1 is new over D21. Auxiliary requests III and IV are a reaction to the development of the proceedings and are admissible.

Reasons for the Decision

1. The appeal is admissible

2. The invention is concerned with hand-held cleaning appliances of the cyclonic type. According to the patent hand-held cleaners have only one cyclonic separating unit that separates coarse dust and debris. In those apparatuses, downstream of the main cyclone, further barrier means such as a filter or a bag filter out finer debris not caught by the cyclone. Instead of such barrier means, the claimed invention provides a plurality of second cyclones arranged in parallel downstream of the first cyclone to separate fine dirt and dust particles, requiring less maintenance, see patent specification paragraph [0004].

3. Main request (as granted)

3.1 Admissibility of document D21

With letter of 10 December 2014, shortly after the statement of grounds, the Appellant-Opponent cites new evidence D21 in relation to novelty and inventive step. The admission of such late evidence at this stage of the appeal is at the discretion of the Board pursuant to Article 13(1) RPBA.

In this regard, the main issues to consider are the justification for the late filing and the relevance of the new evidence.

3.1.1 As for justification, the Board notes that the opposition division decided the case without issuing a communication or summoning to oral proceedings little

over four and a half months after communicating the Proprietor's reply to the Opponent. Though the division was in principle entitled to do so, it meant that the then opponent had a limited opportunity to respond to what was eventually the critical issue in the division's view. The Board does see some justification in an appealing opponent in such a situation in appeal at the earliest opportunity, adducing new evidence that might rebut the decision's finding on a critical point. Though D21 was not filed with the statement of grounds, it was sent shortly afterwards with letter of 10 December 2014 (where it is cited as D6). The Board is unable to see an abuse of procedure, or a clear lack of due diligence on the part of the losing party, that might have militated against admission.

3.1.2 In respect of relevance, the further document D21 describes *prima facie* the application of a dual stage cyclone in hand-held vacuum appliances, according to the opposition division's interpretation of the term "hand-held". This feature, the only basis for the opposition division's positive finding of novelty, was according to the decision not described in any other document on file. D21 thus prima facie appears to be more relevant than any of the documents on file.

3.1.3 In particular in view of the very high relevance of the document, the Board during oral proceedings decided to admit D21 into the proceedings.

3.2 Request for remittal if document D21 is admitted

3.2.1 The Respondent-Proprietor requests remittal to the department of first instance under Article 111(1) EPC in the case that document D21 is admitted so that the document can be examined at two levels of jurisdiction.

As variously stated in case law, there is no absolute right to have an issue decided by two instances, see CLBA, IV.E.7.6.1. Nor is it mandatory to remit a case every time a fresh case is raised, CLBA, IV.E.7.6.5. Various decisions, see CLBA, IV.E.7.2.1, 7.2., 7.2.4 and 7.2.6, and the decisions cited therein, e.g. T1913/06, T1060/96, T402/01, T111/98,and T1600/06, when deciding remittal or not, take into account such factors as public interest, procedural efficiency, complexity of the matter, whether the right to be heard is observed, and whether the legal and factual framework is fundamentally changed.

3.2.2 In weighing up the various aspects, the Board notes that in the present case the relevant contents of D21 are not particularly complex. Moreover, D21 was filed with letter of the Appellant-Opponent of 10 December 2014 soon after the statement of grounds, at an early stage in the appeal procedure together with a fully reasoned analysis of the document, thus affording the Respondent-Proprietor ample time (almost four years) to familiarize themselves with its contents and formulate an appropriate response. Indeed they have done so by addressing the contents of D21 and in response filing auxiliary requests 1 and 2 with letter of 15 August 2018, addressing *inter-alia* the filing of D21, see section 6 of the Respondent-Proprietor's letter.

The Board thus concludes that the Respondent-Proprietor has had sufficient opportunity to react to the introduction of document D21.

3.2.3 Given that the new document can be seen as a response to the finding of the contested decision regarding the interpretation of "hand-held", the Board does not also consider that the introduction of the new document raises a fundamentally different case from that on which the contested decision was based.

3.2.4 Finally, as the Appellant-Opponent observes, it is in the interest of the public and of legal certainty to have a final decision within a reasonable time frame. A remittal in an appeal being heard at the end of 2018 for a patent filed in July 2007 might mean, assuming a further appeal, that the case might not be finally decided until shortly before its expiry.

3.2.5 Weighing all these factors, the Board in application of its discretionary power under Article 111(1) EPC decided not to remit the case to the department of first instance as the more appropriate course of action.

3.3 Novelty of claim 1 against D21

It is undisputed that document D21 describes a dual stage cyclone separator 100, having a first cyclone 120 and a plurality 140 of second cyclones 142 arranged in parallel with one another and located downstream of the first cyclone 129, see figures 2 and 3 of D21, and page 4, 1st, 9th and 11th paragraphs, of the English translation. The main embodiment described in that document, as depicted in figure 4, is however an upright type vacuum cleaner.

3.3.1 In contrast, granted claim 1 calls for a hand-held appliance, including further features that, in the Board's view, merely recite implicit characteristics of a hand-held vacuum cleaner, namely a main body which houses a motor and a fan unit and an electrical power source.

3.3.2 The Board considers, as also submitted by the Appellant-Opponent, that the further statement on page 5, last paragraph of (the translation of) D21:

> "...it will be understood by those skilled in the art that the cyclone dust collection device of the present invention may also be applied to canister type vacuum cleaners and *handy type vacuum cleaners*,"

amounts to a disclosure of the remaining features of granted claim 1, notably to a hand-held vacuum cleaner as claimed, by the mere citation of a hand-held vacuum cleaner in that paragraph.

3.3.3 The argument of the Respondent-Proprietor that the expression "handy type" does not unambiguously disclose the claimed hand-held type, has not convinced the Board. The cited passage refers to three vacuum cleaner *types*, namely "upright" (the main described embodiment of the document D21), "canister" and the aforementioned "handy" type vacuum cleaners. The first two terms indisputably correspond to recognized terminology in the field, it is only the third, "handy" - a possible inaccurate translation from the original Korean - that is somewhat unconventional. Given however that there are only three different types of (household) vacuum cleaners and the term "handy" is close to the correct term "hand-held" used in the field, the Board has no doubt that it can but refer to the third type of vacuum cleaners, namely hand-held ones, in the normal sense of

that term as discussed above. No other types of vacuum cleaners that might fit the qualification "handy" are known to the Board, nor has any been put forward by the Respondent-Proprietor. The Board thus finds that the "*handy"type* vacuum cleaner mentioned on page 5 of the translation of D21 refers to hand-helds in the sense of granted claim 1, so that D21 also directly and unambiguously discloses that feature.

3.3.4 The Respondent-Proprietor also submits that the disclosure of D21 in respect of the hand-held type is a non-enabling disclosure, i.e. the skilled person could not practise, at the relevant date of the cited disclosure, the corresponding technical teaching in respect of hand-held cleaners. D21 should thus, according to the argument of the Respondent-Proprietor, not be considered part of the prior art in so far as it concerns hand-held vacuum cleaners. Thus, any detail concerning size, weight balance, manoeuvrability, ducting arrangement, is lacking in D21 for hand-helds, and the skilled person would therefore not have been able to realize a hand-held incorporating a dual stage cyclone separator as shown in figure 1 to 4 of D21 using only their common technical knowledge at the relevant date. Particularly, considering figure 4, the separator assembly shown was far too large for a hand-held, while the position of inlet and outlet could not be easily accommodated in an average hand-held.

3.3.5 It was certainly not in dispute that the skilled person is to be considered an engineer involved in the design and development of vacuum cleaners and able to solve the related mechanical, electrical or pneumatic design requirements for new models. The Board is convinced that for such a skilled person the cited technical problems are far from insurmountable; rather, their

solution lies well within their routine design skills and abilities at the relevant date. Thus in the Board's view, the skilled person would immediately realise as a matter of routine design that if they are to apply the dual stage cyclone separator to a hand-held, which is typically more compact and may have a different internal layout, both its size and the arrangement of inlet and outlet must be adapted accordingly. Thus at the relevant date the skilled person was capable of realising the teachings of D21, which is therefore an enabling disclosure belonging to the state of the art as defined in Article 54(2) EPC.

3.3.6 The Board adds that in any case claim 1 as granted is only directed at the general concept of a dual stage cyclonic separator in a hand-held vacuum cleaner, without any detail of how that application might be specifically adapted to that use. That concept is clearly and unambiguously disclosed in D21.

3.3.7 The Board thus concludes that the subject-matter of granted claim 1 is anticipated by document D21 and lacks novelty in the sense of Article 54(2) EPC.

4. Auxiliary requests III and IV - admissibility

During the oral proceedings before the Board, the Respondent-Proprietor, after withdrawing previously filed auxiliary requests I and II, filed new auxiliary requests III and IV. They submit that these new auxiliary requests are to be regarded as a legitimate reaction to the admission of D21 into the proceedings and the finding of lack of novelty over D21 during the oral proceedings, and therefore admissible.

The admission of these late filed requests is at the discretion of the Board under Article 13(1) and (3) RPBA. Following established case law claims that are not clearly allowable will normally not be admitted, see CLBA, IV.E.4.2.6 a). "Clearly allowable" means that it must be immediately evident to the Board, with little or no investigative effort on its part, that the amendments successfully address the issues raised without giving rise to new ones.

4.1 Even if D21 was only admitted into the proceedings before the Board, the document and supporting arguments why it would destroy novelty have been on file at least four years. The Respondent-Proprietor has thus had ample opportunity to react, and indeed has done so in its reply dated 15 August 2018. That as a contingency in the event D21 was admitted, they at that stage chose not to file auxiliary requests which would also address D21 must be imputed to themselves. In any case the Board in the admission of D21 cannot see an unforeseen development that justifies the late submission.

4.2 Regardless of the question of justification the Board finds neither of the auxiliary requests to be clearly allowable. Claim 1 of auxiliary request III is a combination of granted claims 1 and 2. The amendment adds the features that the appliance further comprises a handle and that the cyclonic separator lies between the handle and the dirty air inlet. It is immediately apparent that these features define the common layout of a hand-held vacuum cleaner. They are for instance readily identifiable in D12, cited by the Respondent-Proprietor in appeal and which the patent itself, see paragraph [0003] identifies as forming the basis of the preamble of granted claim 1. Thus, the patent itself already acknowledges that the features are known from

the self-cited closest prior art. Such commonly known features, only meant to establish novelty over D21, will clearly fail for lack of inventive step. The Board thus found auxiliary request III to be not clearly allowable and decided not to admit it into the proceedings.

4.3 Claim 1 of auxiliary request IV combines granted claims 1 and 3, without incorporating the subject-matter of granted claim 2. Granted claims 2 and 3 correspond to originally filed claims 2 and 3. In both the original and the granted version, claim 3 is directly dependent on claim 2. Thus, the omission of the subject-matter of granted (or originally filed) claim 2 into the new claim 1 raises the new issue of unallowable intermediate generalization. Fulfilment of the criterion of clear allowability requires *inter alia* that the new claims at least do not raise new issues not already on file. As it therefore also held auxiliary request IV not to be clearly allowable, the Board decided not to admit it into the proceedings.

5. In summary, the only admissible request on file is maintenance of the patent as granted. However, as at least one ground for opposition prejudices the maintenance of the European patent as granted, it must be revoked pursuant to Article 101(2) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chairman:

G. Magouliotis A. de Vries

Decision electronically authenticated