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**Datasheet for the decision
of 21 October 2016**

Case Number: T 0648/15 - 3.2.06

Application Number: 09775309.9

Publication Number: 2373188

IPC: A41D13/015, A41D13/018,
A41D13/05, A42B3/04

Language of the proceedings: EN

Title of invention:

GARMENT ADAPTED TO BE ASSOCIATED TO A DEVICE FOR THE PERSONAL
PROTECTION OF A USER

Patent Proprietor:

DAINESE S.p.A.

Opponent:

ALPINESTARS Spa

Relevant legal provisions:

EPC Art. 84, 123(2)
RPBA Art. 12, 13(1)
EPC R. 106

Keyword:

Main request - claim 1 not clear;

Auxiliary requests 1 to 4 - filed at the oral proceedings -
not admitted;

Objection under Rule 106 EPC - dismissed

Decisions cited:

G 0001/99, T 0974/10



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Case Number: T 0648/15 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 21 October 2016

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Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
22 January 2015 concerning maintenance of the
European Patent No. 2373188 in amended form.

Composition of the Board:

Chairman M. Harrison
Members: G. de Crignis
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. By way of its interlocutory decision, the opposition division found that European Patent No. 2 373 188 as amended according to the proprietor's main request met the requirements of the European Patent Convention (EPC).
- II. With letter of 20 March 2015, the appellant (opponent) filed an appeal against this decision and paid the appeal fee. Its grounds of appeal were filed on 26 May 2015. The appellant requested revocation of the patent.
- III. The respondent (patent proprietor) replied to the grounds with letter of 25 September 2015 and filed fourteen auxiliary requests.
- IV. With letter of 23 October 2015, the respondent requested information as to when a communication could be expected and when "a time frame for the next steps" would be supplied.
- V. The Board replied with letter of 8 December 2015 that (at that moment) the last appeals originating from 2011 were being handled and also made reference to the possibility of acceleration of the appeal procedure according to the Notice of the Vice President of 17 March 2008 (OJ EPO 2008, 221).
- VI. With letter of 28 June 2016 the appellant requested accelerated processing of the appeal and enclosed cover pages dated 23 December 2015 of an action in the district Court of Munich concerning alleged infringement of the German part of the European patent of the present appeal proceedings. With a further

submission bearing the same date, the appellant filed further alleged prior use references.

- VII. Taking into account the request for accelerated examination, the Board summoned the parties to oral proceedings for 21 October 2016 with communication dated 13 July 2016.
- VIII. In its communication dated 15 September 2016, sent in preparation for the oral proceedings, the Board indicated its provisional opinion that, in regard to the clarity requirement of Article 84 EPC, the Board had serious doubts as to whether the main request was allowable. In particular, in regard to the use of the terms "occupy" and "therefore" reference was made to claim 1 and the absence of a definition of the positional relationship between the elastic insert and the inflatable member, apart from the insert necessarily being comprised in the covering member which itself was located outside the inflatable member. Regarding the wording "therefore", reference was made to the lack of a clear indication as to the way in which the location of the insert "at a perimetral zone of the covering surface" should be understood and that the causal relationship could not be understood between the foregoing features in the claim and the resulting structure. With respect to the terminology "such that", in the context of "the insert surrounds at least partially the inflatable member", the structure defined by the latter expression could not be understood.

Additionally, the Board stated that no arguments or comments had been submitted in support of the auxiliary requests and that it was also not clear in which way any of the auxiliary requests overcame the objections made by the appellant against the main request and that

the respondent's complete case in response to the grounds of appeal on the issue of clarity relied on arguments.

- IX. In its submission of 7 October 2016, the respondent filed comments in reply to the communication together with amended first to sixth auxiliary requests. The respondent also stated that the request for acceleration of the appellant and the allowance of the request by the Board had not been received.
- X. In its letter of 7 October 2016, the appellant also filed further comments together with additional documents.
- XI. Oral proceedings were held before the Board on 21 October 2016 as scheduled.

The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested that the appeal be dismissed, or that the patent be maintained according to any one of auxiliary requests 1 to 4 filed during the oral proceedings. It further requested the remittal of the case to the department of first instance.

At the end of the oral proceedings (see the minutes of the oral proceedings), the respondent additionally raised an objection under Rule 106 EPC which reads as follows:

"The Patent Proprietor raises an objection under R. 106 EPC for violation of the application of the right to be heard A. 113 EPC, due to the new clarity objections and continuous changing in the objections

being raised during the Appeal Proceedings and particularly the Oral Proceedings.

The Patent Proprietor, in conjunction with Art. 113 EPC, objects incorrect application of the principles of G 1/99 in terms of equity.

The Patent Proprietor also objects in view of the Decision of the Board not to remit to first instance."

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

"Garment (10, 110, 1010) comprising an inflatable member (12, 1012, 2002) and a portion (16, 1016) suitable for being combined with the inflatable member (12, 1012) for protecting a user, wherein said portion (16, 1016) of the garment (10, 110, 1010) includes a covering surface (18, 181, 182, 20, 1018, 1018a, 1018b, 1050) suitable for forming a covering for said inflatable member (12, 1012), wherein the inflatable member (12, 1012, 2002) is positioned hidden from view and in contact with an inner side (14, 1014) of said covering surface (18, 181, 182, 20, 1018, 1018a, 1018b, 1050) and said covering surface (18, 181, 182, 20, 1018, 1018a, 1018b, 1050) comprises at least one insert (20, 80, 1020, 1080) made of elastic material, characterized in that the insert (20, 80, 1020, 1080) occupies a perimetral zone of the covering surface (18, 181, 182, 20, 1018, 1018a, 1018b, 1050) and therefore a perimetral zone of the inflatable member (12, 1012, 2002), such that the insert (20, 80, 1020, 1080) surrounds at least partially the inflatable member (12, 1012, 2002)."

Claim 1 of auxiliary request 1 includes additionally the following feature in the characterising part of the claim:

"characterized in that wherein said insert (1020, 1080) made of elastic material has a strip or band-like form".

Claim 1 of auxiliary request 2 differs from claim 1 of auxiliary request 1 in that the following feature is deleted:

"and therefore a perimetral zone of the inflatable member (12, 1012, 2002), such that the insert (20, 80, 1020, 1080) surrounds at least partially the inflatable member (12, 1012, 2002)".

Claim 1 of auxiliary request 3 differs from claim 1 of auxiliary request 2 in that the feature

"the insert (20, 80, 1020, 1080) occupies a perimetral zone of the covering surface (18, 181, 182, 20, 1018, 1018a, 1018b, 1050)"

is also deleted and in that the following feature is added:

"and said insert made of elastic material extends at least partially along a perimetral zone of said covering surface," .

Claim 1 of auxiliary request 4 differs from claim 1 of the main request in that the characterising part reads: "characterized in that wherein said insert (1020, 1080) made of elastic material has a strip or band-like form and has the form of a closed loop and that the insert (20, 80, 1020, 1080) occupies a perimetral zone of the covering surface (18, 181, 182, 20, 1018, 1018a, 1018b, 1050) and a perimetral zone of the inflatable member (12, 1012, 2002), and the insert (20, 80, 1020, 1080) surrounds the inflatable member (12, 1012, 2002), when the inflatable member is combined with the garment."

In all auxiliary requests, claims 6 to 13 of the main request were deleted and the subsequent claims renumbered.

XIII. The arguments of the appellant may be summarised as follows:

The objections made in the grounds of appeal under Article 84 EPC related to the entirety of the amendments made to claim 1 during opposition; specific aspects of the lack of clarity were emphasised. The appellant was not required to specify the lack of clarity objections in precise detail, nor to explain what amendments would make the claim clear. It was sufficient to explain why the lack of clarity arose. As lack of clarity had already been objected to and the opposition division had found the amendments clear, there was no reason to remit the case as it was this same finding of the decision of the opposition division which was being challenged again in the appeal.

Lack of clarity of claim 1 existed at least due to the words "occupy", "therefore", "such that" and "at least partially" in the amended features. This lack of clarity made the entire amendment unclear. In the drawings there was also no cross-sectional view provided which could explain how these terms should be understood. Even assuming that the verb "occupy" should be intended to mean "to cover", as argued by the respondent, instead of merely "to be located at", no relationship of parts was shown in the cited Figures to allow the skilled reader to understand what "cover" should then mean in the context claimed. No direct correlation between the perimetral zone of the covering surface and of the inflatable member could be established; thus an elastic insert which occupied a

perimetral zone of the covering surface in one sense could not be stated to occupy a perimetral zone of the inflatable member in the same sense, so that no clear meaning could be ascribed to the word "occupy" even if it did mean "to cover". The use of the terms "therefore" and "such that" presupposed that the subsequent feature was the purpose, consequence or the result of preceding features. Since however no causal link existed between the feature defined and the preceding features, the terms were unclear in the way used. None of these possibilities could be derived from the originally filed description in order to assist clarity in some way.

The reference in claim 1 to the elastic insert surrounding "at least partially the inflatable member" was not further explained. The normal understanding of "surround" implied a complete encirculation of an object. Accordingly, the term "at least partially" lacked clarity in that no indication for a minimum size/length of the surrounding was provided in the claim or in the specification. In what way "surround" was supposed to be understood in the context used was thus unclear, while the expression "at least partially surround" made matters worse. To exemplify the problem, an elastic insert somewhere along a straight line of some perimetral portion might, or might not, be understood to "at least partially surround" that perimetral portion, even though it surrounded nothing in recognisable terms, always depending on what might be understood. Although the proprietor argued with reference to different parts of the description, none of these described what positional relationship of elements was being claimed. The dependent claims, e.g. claims 3 and 4 showed that certain positional and structural relationships of the various elements

alleged to be present by the respondent were not derivable from claim 1.

For all these reasons, the entire amendment introduced into claim 1 was unclear, whereby claim 1 itself lacked clarity.

The first to fourth auxiliary requests filed during the oral proceedings should not be admitted. They should have been filed earlier because all objections had been raised in the statement of grounds of appeal and were based on the amendments made in claim 1 of the request maintained by the opposition division. The proprietor had elected not to file amendments with its response to the appeal, instead it had waited until the Board had given its preliminary opinion. The four auxiliary requests were still further amendments compared to what had been filed in response to the Board's opinion and were anyway not clearly allowable.

The amendments made in the auxiliary requests were at least contrary to the principle of the prohibition of *reformatio in peius*. A precondition for applying the exceptional options given in decision G1/99 was that the objection which was to be overcome by amendment had not already been raised in the first instance proceedings. This was clear from G1/99, Reasons, item 12 and from T974/10. The clarity objection had certainly already been raised before the opposition division. A main request to reject the opposition, or a request without the unclear features before the opposition division could have been maintained; it was the proprietor's deliberate choice not to do this.

In claim 1 of the first auxiliary request, the added feature did not overcome the lack of clarity.

Concerning the second auxiliary request, the feature added in claim 1 had never been discussed before and the deletion of part of the amended feature which had been inserted in the main request broadened to a certain extent the scope of the claim. This resulted in a new case which could not be dealt with without adjournment of the proceedings.

The third auxiliary request led to clear wording in claim 1 being deleted, without any reasoning in this regard being given and the Board had specifically indicated that this particular wording was regarded as clear *per se*. Concerning the added feature including a new use of the wording "at least partially" a further clarity objection arose.

The fourth auxiliary request was not convergent with previous requests, so even on this basis the request should not be admitted. Also, the features in claim 1 were not clear at least with regard to the terminology "when the inflatable member is combined..." which implied some sort of condition, and accordingly the clarity requirement of Article 84 EPC was not met. Also this combination of features had not been present before in any claim and its introduction caused numerous problems with Article 123(2) EPC at least in regard to the dependent claims which were at least not *prima facie* compliant with this Article's requirement.

XIV. The arguments of the respondent may be summarised as follows:

The objections relating to the expressions "such that" and "surrounds at least partially" in claim 1 were raised for the first time in the grounds of appeal.

These objections should be disregarded since they were not dealt with in the contested decision. Should the Board intend to take a decision based on these clarity objections, the case should be remitted to the opposition division pursuant to Article 111(1) EPC in order to guarantee the respondent's right to be heard according to Article 113 EPC.

Additionally, the communication of the Board had raised a new objection of lack of clarity based on a different interpretation of the amended feature in claim 1. There had not been sufficient time to prepare the case after receipt of the Board's communication, as only twelve days had been available to supply a response. The new objection concerned the fresh case of whether there was a lack of clarity with respect to the positional relationship not being defined in the claim between the elastic insert and the inflatable member. This issue had not been discussed in the opposition proceedings. Accordingly, also for this reason the case should be remitted in order to discuss these aspects in two instances and thus to respect the right to be heard according to Article 113(1) EPC. If remittal were refused by the Board, the respondent intended to file an objection under Rule 106 EPC.

Claim 1, when read as a whole, was clear. It defined that the elastic insert was located at, i.e. in correspondence with, a perimetral zone. This meant it was at the location of the perimetral zone, and it also covered it. The insert was part of the covering surface such as shown in Figures 1, 2, 4, 5, 19, 20, 23 and 24. The term "occupy" was then clear in relation to the covering surface. The covering surface also had to be above the inflatable member.

The use of the term "therefore" did not affect the clarity of claim 1, as it was merely used as a link to the previous feature. A skilled person clearly understood that the perimetral zone of the covering surface could at least partially overlap with the perimetral zone of the inflatable member, such that the insert was then located in a perimetral zone both of the covering surface and also of the inflatable member.

The wording "such that" was to be understood in the sense of "in such a way that" and the skilled person would know that the wording "surrounds at least partially" meant that the profile of the elastic insert had at least partially to follow the profile of the inflatable member. How much it followed the profile did not have to be defined. The originally filed description on page 5, lines 37 to 39 provided a basis for this interpretation. Also, the information given in paragraphs 45, 47, 49, 61 and 117 of the patent in suit confirmed this understanding and, moreover, indicated to the skilled person that it was essentially a function which was being defined.

The feature of the inflatable member being positioned "hidden from view" was a functional feature which was not structurally related to the covering surface, but could be related to a further structural element even though this was not defined in claim 1. Thus, the covering surface did not necessarily completely cover the inflatable member, for example in the sense that it might also be a mesh structure, but the structural relationship one to the other was clear. What was stated in the dependent claims did not affect the understanding of claim 1.

The first to fourth auxiliary requests should be admitted. As already argued with regard to the objections concerning clarity of the main request, the respondent did not receive the information about the request for acceleration of the proceedings in due time and so the respondent did not have the chance to give its comments on the acceleration request. It did not matter if it had anything to submit concerning the request for acceleration, but it was simply that its right to be heard was absolute. The receipt of the communication of the Board in preparation of the oral proceedings had left too little time to prepare the case properly - in particular in relation to the clarity objection and preparing further requests to meet this. Only during the oral proceedings before the Board, could the clarity objections really be understood. The auxiliary requests included limitations and clarifications and corresponded in sequence to the sequential options given in G 1/99.

Claim 1 of the first auxiliary request was limited to the insert being made of elastic material in a strip or band-like form. This limitation made it clear that the elastic insert could cover the perimetral zone of the covering surface and of the inflatable member. This limitation was in line with the first possibility given in G 1/99 and was taken from the claims as filed as well as being derivable from the description, from where the other features of the amendment had been taken.

The second auxiliary request was filed in order to follow the second possibility given in G 1/99. The deletion of the objected feature was compensated by the insertion of the additional feature.

Also the third auxiliary request was filed in order to overcome the clarity objection within the limitations which were possible. It provided an alternative but equivalent wording ("extends at least partially along") to the amendment which had been accepted during the opposition proceedings ("surrounds at least partially").

The fourth auxiliary request was filed when having ultimately understood the objections raised. The wording "therefore" and "such that" had notably been removed. The combination of features thus overcame the raised clarity objections. There had to be a possibility to file a request which dealt with the clarity issues - at least for reasons of equity, because the proprietor had been successful before the opposition division. In overall substance the auxiliary requests were convergent, because all were aimed at overcoming the clarity objection. Similar requests had already been filed before the oral proceedings, namely with auxiliary requests 11 and 12 filed in reply to the grounds of appeal and with auxiliary request 6 in reply to the communication of the Board. The expression "when the inflatable member is combined with the garment" was clear wording used on page 6, such that no objection under Article 84 EPC arose. The amendment followed page 6, lines 1 to 4. Article 123(2) EPC was also fulfilled and the dependent claims had not changed.

An objection under Rule 106 EPC applied concerning violation of Article 113 EPC, an incorrect application of principles in G 1/99 and in that the Board had not remitted the case to the department of first instance. This objection was set out in the written objection filed at the end of oral proceedings.

Reasons for the Decision

1. Request for remittal

1.1 According to Article 111(1) EPC, second sentence, the Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution. An absolute right for the parties to have each objection decided upon by two instances does not follow from this provision of the EPC. Rather it confers discretionary power to the Boards of Appeal, under due consideration of all circumstances of the case, whether or not to remit the case to the department of first instance.

1.2 Nevertheless, according to Article 11 of the Rules of Procedure of the Boards of Appeal (RPBA), a Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise. No fundamental deficiencies have been identified by the Board.

1.3 The respondent argued however that the absence in the opposition proceedings and in the appealed decision of a specific and distinct reference to the terms "such that" and "surrounds at least partially" gave rise to a fundamental deficiency when discussing and deciding on the issue of clarity. Contrary thereto the appellant argued that it was always the whole wording of the amendment which was objected to, even if particular parts of the amendment had been focussed upon in order to explain the lack of clarity.

- 1.4 From point 4.3 of the appealed decision it is apparent that clarity of the amended feature was discussed during the oral proceedings before the opposition division. In the decision, the opposition division refers in particular to the terms "occupy" and "therefore" in the amended wording. That it was the whole amended feature which was scrutinized for lack of clarity is apparent at least from the reference, under this item of the decision, to page 5, lines 37 - 39 of the application as filed which states that "the insert made of elastic material surrounds at least partially the inflatable member when the latter is combined with the garment". The opposition division interpreted this in the sense that "the two components need not be exactly the same size, rather it suggests that the covering surface should be larger than the inflatable member, nor is it necessary that the elastic insert must completely surround the inflatable member".
- 1.5 In view of this statement in the appealed decision, there can be no doubt that it was the whole amended feature which was considered in the first instance proceedings. In fact, the question of whether the amended feature is clear is not only linked to isolated terms within the wording but is related to the whole feature in which these terms are present. Accordingly, the issue has always been the clarity of the amended feature as a whole (Article 84 EPC). An appellant must be given the means to show in which way the decision under appeal is, in its view, wrong. In this respect the specific explanations given with regard to the words "such that" and "at least partially" do not constitute a new objection, but merely serve to give reasons why the decision was ill-founded.

- 1.6 The interpretation of terminology which is subject to an objection is invariably part of the normal tasks performed by the parties and by the Board in opposition-appeal proceedings. The opposition division held the amended feature to be clear. For the opponent, having already objected to lack of clarity before the opposition division without success, the appeal proceedings are consequently the only and appropriate step for it to again forward its arguments concerning the clarity objection when desiring the decision to be reversed. All the facts and arguments presented in the opposition proceedings can remain valid in the appeal proceedings and the Board finds that the appellant has simply elaborated on them. The underlying objection to lack of clarity made against the entire amendment has however not changed.
- 1.7 The features in the amended wording cannot simply be taken individually, but it is the entirety of the amendment which has to be considered. Accordingly, the Board does not see any justification for a remittal based on the arguments brought forward in this respect.
- 1.8 Further, the respondent argued that the time after receipt of the Board's communication was insufficient and that, therefore, it had not been given appropriate opportunity in the appeal to defend its case. Moreover, it considered that the Board had set out a "fresh case" when indicating that the causal relationship between the foregoing features in the claim and the resulting structure of "the insert surrounds at least partially the inflatable member" could not be understood.
- 1.9 Concerning the time for defending its case, the Board finds that the respondent had ample opportunity after receipt of the grounds of appeal to prepare the case.

Initially, a four-month period in which to respond to the appeal was given. Within this time, the respondent is expected to supply its complete case in response (see Article 12(2) RPBA). The Board then summoned the parties to oral proceedings in July 2016, observing indeed far more than the two months provided for in Rule 115 EPC, such that the parties were already forewarned a long time in advance. The Board's subsequent communication pointed out certain important issues for preparing the oral proceedings. No reply was required from the parties, since the parties had already made, or, at least, should have made, their complete case. Further arguments supporting their respective cases can of course be taken up and explained in oral proceedings. Nevertheless, the Board indicated to the parties in its communication that any further submissions following the Board's communication should be made within two weeks of the oral proceedings (such that all parties and the Board would have a chance to study any such submissions). As regards lack of clarity, the Board explained in its communication the way in which it understood the lack of clarity of the amended features in the given context, noting particularly that the respondent had seemingly elected not to file auxiliary requests meeting the clarity objection, but merely to supply argument, albeit it had filed fourteen auxiliary requests.

- 1.10 The respondent has not convincingly explained why an earlier communication would have been required for the respondent to prepare more appropriate or differently worded auxiliary requests - in particular arguing only near the end of the oral proceedings that the extent of the clarity issues had only then become fully apparent. So, the Board does not accept that the respondent had either insufficient time at its disposal for preparing

auxiliary requests or insufficient possibility to submit its comments and/or requests. It may also be noted at this juncture that the respondent was given still further time during the oral proceedings to prepare and file further requests, having been informed that the Board intended to apply the criteria set out in G 1/99 when considering amendments on the basis that they had to comply with the order of amendments given therein, in order to permit an exception to the principle of prohibition of *reformatio in peius*.

- 1.11 Since, as set out above, the interpretation of the amended feature introduced during opposition proceedings was the issue contested under the heading "clarity" in the opposition proceedings and decided upon in the contested decision, the Board does not see how there could be a "fresh case" and does not accept, as accurate, the respondent's contention in this respect. For the same reasons there was no need for more time.
- 1.12 The respondent's argument that it had not really understood the clarity objection being made until close to the end of the oral proceedings before the Board is also not persuasive. First, the opposition division had decided on the objection and given its own reasons (albeit that it relied on an interpretation of clarity based on "a problem to be solved" (see e.g. item 4.3 page 5 of the decision). The clarity objection had then been made by the appellant in its grounds of appeal, with specific reference to particular wording contained in the amendment. The respondent had replied to this in its letter of 25 September 2015. The Board, in its communication before the oral proceedings, then explained its provisional view on the the lack of clarity objection made. The Board also stated why it

understood the particular wording highlighted by the appellant to be the cause of a lack of clarity. The arguments of the respondent also show that it was aware of the clarity objection, but merely that it had a different opinion on what and how the features of the claims should be understood. Sufficient opportunity thus existed for the respondent to understand the objection before it; the fact that it disagreed with the appellant's objection and ultimately was unable to convince the Board that it was correct cannot be taken to mean that it did not fully understand the clarity objection.

1.13 The Board therefore finds, on the basis of the foregoing, that remittal of the case to the department of first instance is neither appropriate nor necessary.

1.14 The respondent-proprietor's request for remittal must therefore be rejected.

2. *Main Request - Amendments - Clarity*

2.1 Claim 1 has been amended, compared to the form as granted, *inter alia* by adding the characterizing feature:

"the insert (20, 80, 1020, 1080) occupies a perimetral zone of the covering surface (18, 181, 182, 20, 1018, 1018a, 1018b, 1050) and therefore a perimetral zone of the inflatable member (12, 1012, 2002), such that the insert (20, 80, 1020, 1080) surrounds at least partially the inflatable member (12, 1012, 2002)."

2.2 The amendment is (broadly) taken from page 5, lines 35 to 39 of the application as filed which reads:

"... the insert made of elastic material occupies a perimetral zone of the covering surface and therefore a

perimetral zone of the inflatable member. Basically, the insert made of elastic material surrounds at least partially the inflatable member when the latter is combined with the garment."

- 2.3 The respondent has also argued that the claim is clear per se, even without reference to this part of the description.
- 2.4 The Board however finds otherwise. The claim is directed to a garment and the main issue is whether the structure of the garment, as now defined, is clear, in particular here with respect to the positional relationship between the elastic insert and the inflatable member. The following structural information is given in the claims:
- 2.5 According to claim 1, the inflatable member is defined in the preamble as being positioned "hidden from view", "in contact with an inner side of said covering surface", and that the covering surface itself "comprises" the elastic insert by the wording "said covering surface comprises at least one insert made of elastic material". Accordingly, the elastic insert is a part of the covering surface. The meaning of the terminology "hidden from view" was discussed extensively in oral proceedings, in relation to whether this provided further information about the relationship of parts, beyond merely that (some part of) the cover member was above the inflatable member.
- 2.6 It is not defined in claim 1 that it is the covering surface which leads to the inflatable member being "positioned hidden from view", but merely that "it is positioned hidden from view", nor is the extent of the covering surface defined in claim 1; the inflatable

member can be smaller and within the periphery of the covering surface or larger and extend beyond its periphery. This is also confirmed by claim 3, where a suitability for "covering completely" is first defined (i.e. not in claim 1). Thus, no relative positional information of the position of the perimetral zones of these can be gleaned.

2.7 No further positional relationship between the elastic insert and the inflatable member is defined in the claims.

2.8 The word "occupy" in the term "the insert occupies a perimetral zone of the covering surface" can be understood by a skilled person in the meaning of for example "being positioned at" or possibly in some way "covering" in relation to the insert and covering surface, because the inflatable member is defined as positioned hidden from view and in contact with the inner side of the covering surface and, importantly, because the covering surface itself "comprises" the elastic insert (this view was already indicated in the Board's communication). Therefore, although the extent of covering or the positioning of the insert is not precisely defined, this does not by itself lead to a lack of clarity.

2.9 However, the next clause in the claim is formulated such that the insert occupies "... therefore a perimetral zone of the inflatable member". The word "therefore" implies a causal relationship with the preceding features defined in the claim, yet none can be derived. The claim thus lacks a positional relationship of the elastic insert with regard to the inflatable member as a result of the previous features. In other words, merely because the insert occupies a

perimetral zone of the covering surface (which itself comprises the insert) does not lead to any derivable positional relationship resulting between the insert and a perimetral zone of the inflatable member. The word "therefore" is not clear in the given context in which it used.

- 2.10 Subsequent to the feature "and therefore a perimetral zone of the inflatable member" in claim 1 is the feature "such that the insert surrounds at least partially the inflatable member". The wording "such that" in this context could possibly mean the same as "as a consequence of". In the same way as the terminology "therefore" is used (see above), the causal relationship between the foregoing features in the claim and the resulting structure (i.e. such that "the insert surrounds at least partially the inflatable member") is not based upon any structural relationship of elements, and hence lacks clarity.
- 2.11 The respondent considered the objection to the terminology "such as" in its context and "at least partially" to be due to an (over)formalistic approach by the appellant and the Board. In particular, Figures 1, 2, 4, 5, 19, 20, 23 and 24 were argued by the respondent to be evidence for the meaning of the amended feature in that they showed the raising of the inflatable member in such a way that the elastic insert was part of the covering surface which had to be in contact with the inflatable member.
- 2.12 Whilst the Board does not doubt that the garment functions and that the Figures show certain elements of a raised and non-raised position, the reference to the Figures lacks relevance since none of the cited Figures shows a cross-sectional view, as also argued by the

appellant. Hence, the position of the elastic insert, the covering surface and the inflatable member and their positional relationship cannot be established from the Figures. Additionally, as also indicated in the oral proceedings, the Figures concern particular embodiments including many further features which are not defined in claim 1. Thus, reference to a specific embodiment with particularly shaped and sized elements, which are not defined in claim 1, does not serve as a basis on which to assert that claim 1 (where the garment features are defined far more generally) is clear.

2.13 Additionally, it has to be taken into account that the subject-matter of claim 1 is not even limited to the feature of the perimetral zone of the covering surface being for example immediately along or co-extensive with the perimeter of the inflatable member and/or to the feature of the inflatable member being "exactly" or "only" in contact with the inner surface of the covering surface. Likewise due to this, there is also no general understanding for a skilled person, even when taking the description into account, of establishing where the perimetral zone of the covering surface necessarily lies in relation to the perimeter of the inflatable member, or with regard to the extent to which it would e.g. be in line with or along or co-extensive with the perimeter of the inflatable member. Accordingly, it also cannot be established by the skilled person how to understand the feature of "such that the insert surrounds at least partially the inflatable member".

2.14 The reference of the respondent to the passage on page 5, lines 37 to 39 does not overcome this objection. First, it is the claim itself which must be clear, not

the description of an embodiment which might possibly fall under the claim. Second, the passage to which reference is made concerns a preferred embodiment where the elastic insert is a strip and this passage anyway does not explain further what should be understood by "surrounds at least partially". Still further, the information given in the cited paragraphs 45, 47, 49, 61 and 117 of the patent in suit concerns preferred embodiments and thus also does not provide a basis for any general understanding of the structural relationship of the various elements. Paragraphs 45, 47 and 49 refer to the insert surrounding an undefined part of the inflatable member and paragraphs 61 and 117 refer to particular embodiments wherein a covering surface is positioned "opposite the inflatable member so as to cover/close entirely the latter". Hence, specific features, in a specific context are referred to, which are not suitable for clarifying the features objected to which are of a general nature in the context of claim 1.

- 2.15 Also the reference of the respondent in its written submissions filed with letter of 7 October 2016 to the passages in paragraphs 129, 133 and 134 as defining the positional relationship between the elastic insert and the inflatable member in an alternative wording, e.g. "situated along a perimetral zone" and "follows a perimetral profile" does not overcome this objection. These terms do not further clarify a positional relationship between the elastic insert and the inflatable member as claimed, and anyway these partly concern particular embodiments including further specific features not claimed. Thus, the disclosure in these paragraphs is not suitable to clarify the positional relationship which is defined in the claim. In its letter, the respondent also considered that no

ambiguity was introduced by the use of the term "perimetral". Although the term itself may be clear *per se*, the word "perimetral" in claim 1 is linked to the word "zone". Therefore, it is not the perimeter *per se* which is to be considered but an undefined perimetral zone.

2.16 Concerning the respondent's reference to the corresponding functional characteristic, it is correct that the Figures and the description show and refer to the raising of the inflatable member. In view of no cross-sectional view being provided however, it cannot be established in a clear manner where the insert is to be located to fulfil the conditions "therefore a perimetral zone of the inflatable member" based on previous features "such that the insert surrounds at least partially the inflatable member".

2.17 When considering the respondent's argument that the function should be taken into account when trying to understand the claim, it should be noted that, claim 1 is directed to a garment and hence any functional understanding should be based on clear structural features. In particular in relation to the "perimetral zones" and the surrounding "at least partially", a clear definition of the structures would be necessary to enable a clear understanding of the function. Absent further information, the skilled person could neither derive a clear structural characteristic nor a clear functional characteristic of the garment from these features.

2.18 Hence, claim 1 lacks clarity and the main request is not allowable (Article 84 EPC).

3. *Right to be heard - Applicability of G 1/99 concerning auxiliary requests*

3.1 Concerning the request for acceleration of the proceedings, the Board notes that the acceleration of the proceedings is a matter of internal organisation entirely for the Board to decide upon. This possibility exists in order for example to circumvent the drawbacks which would result for a case if it were to be treated in the chronological order of the entering appeals. The Board may accelerate any case, even without a request for acceleration, if it finds it appropriate for particular reasons. In the present case however there was a specific request for acceleration made by one of the parties. Even if it were the case, as argued by the respondent, that it had not become aware of the request for acceleration, the Board had anyway set the oral proceedings, which thus made the respondent fully aware of the timetable which *de facto* was an acceleration in reaction to the request for acceleration which had been filed together with copies of the lawsuit underlying it. Nevertheless, the decision to accelerate did not introduce any exceptional procedural step and is in full compliance with Articles 113 EPC and 12 RPBA. This means that *per se* the acceleration of the proceedings, as a mere administrative measure, cannot infringe the right to be heard. The respondent anyway does not have any right to delay the case.

3.2 The fact that the Board's communication in preparation for the oral proceedings may have left only 12 days for a reply by the respondent after receipt thereof, has not infringed the respondent's right to be heard. When having received the summons to oral proceedings there were several months for preparation. The subsequent communication of the Board is only for information and

is, notably, only a preliminary, non-binding view. No reply was requested or necessary.

3.3 A respondent should make its complete case in reply to the grounds of appeal (Article 12(2) RPBA). The case has to be prepared anyway and all the objections including the clarity objections were on file with the statement of grounds of appeal. It may be noted at this juncture that according to Article 12(3) RPBA subject to Articles 113 and 116 EPC the Board may decide the case at any time after filing of the expiry of the time limit in Article 12(1)(b) RPBA, i.e. for the reply to the statement of the grounds of appeal. During the oral proceedings the parties had the opportunity to present all their arguments and the respondent was given the opportunity to prepare and file amended requests, which opportunity was indeed taken.

3.4 Auxiliary requests 1 to 4 were filed only in the course of the oral proceedings and hence after the time limit for filing the response to the appeal grounds of the appellant (Article 12(1) and (2) RPBA). According to Article 13(1) RPBA, it lies within the discretion of the Board to admit any amendment to a party's case after it has filed its grounds of appeal or reply. In order to be admitted at such a late stage of proceedings, it is established case law of the Boards of Appeal that a request should normally be *prima facie* allowable at least in the sense that it overcomes the objections raised and does not give rise to new objections, not least for reasons of procedural economy (Article 13(1) RPBA).

3.5 The intention expressed by the respondent when submitting its auxiliary requests was to apply the exceptions to the prohibition of *reformatio in peius* as

set out in the decision of the Enlarged Board of Appeal G 1/99. As a reason for not filing these requests earlier, the respondent argued that it had only understood the clarity objections during the course of the oral proceedings before the Board - although they were already raised in the grounds of appeal and followed up in the communication of the Board. It is nevertheless noted that the respondent had already referred to G 1/99 in its reply to the Board's communication.

3.6 According to G 1/99, in the first place, a non-appealing patentee is essentially bound to defending the form of the patent as found allowable by the opposition division, or to adopt fallback positions from that. The form of the patent as found allowable by the opposition division being held to lack clarity by the Board, the exceptions to the prohibition of *reformatio in peius* in G1/99 are applicable in regard to any further request filed.

3.7 The headnote in G 1/99 reads:
"In principle, an amended claim, which would put the opponent and sole appellant in a worse situation than if it had not appealed, must be rejected. However, an exception to this principle may be made in order to meet an objection put forward by the opponent/appellant or the Board during the appeal proceedings, in circumstances where the patent as maintained in amended form would otherwise have to be revoked as a direct consequence of an inadmissible amendment held allowable by the opposition division in its interlocutory decision.

3.8 In such circumstances, in order to overcome the deficiency, the patent proprietor/respondent may be allowed to file requests, as follows:

- in the first place, for an amendment introducing one or more originally disclosed features which limit the scope of the patent as maintained;
- if such a limitation is not possible, for an amendment introducing one or more originally disclosed features which extend the scope of the patent as maintained, but within the limits of Article 123(3) EPC;
- finally, if such amendments are not possible, for deletion of the inadmissible amendment, but within the limits of Article 123(3) EPC."

3.9 The three options given in G 1/99 were set out with regard to the requirement of Article 123(2) EPC. However, these options can be applied in a similar way when dealing with the requirement of Article 84 EPC (see also T1380/04, Reasons 1.3). In the current case, the Board is of the view that in particular the first option is readily applicable and requires an amendment introducing one or more originally disclosed features which clarify the relationship between the perimetral zones of the covering surface and the inflatable member with regard to the position of the elastic insert and thus would provide a limitation of the scope of the patent as maintained. In the description - and additionally shown in the Figures - there are several specific embodiments where a clear relationship of these structural elements can be ascertained.

3.10 The appellant referred to point 12 of G 1/99 in order to show that all the options given in the headnote therein would not be applicable. It is correct that the clarity objection was already raised in the opposition

proceedings, but it is also noted that the amended form of the patent found allowable by the opposition division was the main request of the proprietor.

3.11 Point 12 of G 1/99 reads as follows:

"It results from the case law of the Enlarged Board of Appeal (see supra point 6), that reformatio in peius should be prohibited because it is the principal task of the Boards of Appeal to review the decision under appeal, not to re-examine the case from scratch. This is not in contradiction with the fact that, with respect to the allowability of amendments made during the opposition procedure, the appeal proceedings are not restricted to the legal and factual background of the proceedings before the Opposition Division. Indeed, objections raised in the first instance may be supported by new facts and new objections may be raised in appeal proceedings with the consequence that the basis on which limitations have been made may still change and it would not be equitable to allow the opponent/appellant or the Board to present new attacks and to deprive the proprietor/respondent of a means of defence. As stated in G4/93, the proprietor/respondent is primarily limited to defending the version of the patent held allowable by the Opposition Division. However, in particular if the patent cannot be maintained for reasons which were not raised at the first instance, the non-appealing proprietor deserves protection for reasons of equity."

3.12 From the foregoing it is clear that the Enlarged Board considered the requirement of equity in appeal proceedings between a non-appealing party and an appellant. In the present case, the proprietor could anyway not have filed an appeal, since its main request was found allowable by the opposition division. The

present Board sees that, as a reason of equity, the respondent must be able to defend itself against a decision of the opposition division which, as the Board has now determined, found wrongly in its favour. For the respondent to artificially maintain higher ranking requests merely in order to provide it the possibility of defending itself against possible similar attacks in the appeal proceedings would seem not to have been the purpose envisaged by the Enlarged Board, particularly when it stated that "... in particular if the patent cannot be maintained for reasons which were not raised at the first instance", since it is these "reasons" rather than the underlying arguments which have led the Board to find the main request not allowable.

3.13 The appellant cited T974/10 to support its argument that no request improving the position of the respondent should be allowed if the objection (here, the clarity objection) had been raised during opposition proceedings. The Board notes that in the present case, the patent proprietor could not file an appeal and at the appeal stage is thus faced with the arguments challenging the decision. Not allowing it to file any further requests would amount to denying it the right to fully defend itself against the clarity objection made in the appeal proceedings.

3.14 Accordingly, the principles in G 1/99 are applicable for the present case and the respondent was therefore permitted by the Board to file requests, as long as these were in accordance therewith.

4. *Auxiliary request 1 - Admittance*

4.1 Support for the added feature "said insert made of elastic material has a strip or band-like form" can be

found in claim 13 as filed (corresponding to granted claim 13).

- 4.2 The insertion of the feature in claim 1 was made with the intention, according to the respondent, that the resulting limitation should correspond to the first option set out in G 1/99. The first option in G 1/99 however has to be considered in the context of a limitation of the scope of the patent as maintained by the introduction of one or more originally disclosed features whereby the underlying objection can be overcome. In the current case the underlying objection concerns clarity.
- 4.3 However, the insertion of the additional feature in no way overcomes the clarity objection set out for the main request. The additional feature concerns exclusively the form of the elastic insert and thus is not capable of clarifying any of the objected structural, causal or functional relationships of and between the different features of the claim (covering surface, inflatable member and elastic insert).
- 4.4 Although it is understood from its arguments that the respondent had chosen this feature due to the discussion of the basis for the wording (of the amended feature) emanating from page 5, lines 24 *et seq*, of the description in the application as filed, this does not alter the objection of lack of clarity, since the strip or band-like portion is not further defined in relation to the other portions of the garment in a way which allows the relative positions to be clearly established.
- 4.5 Accordingly, the objection concerning lack of clarity set out above for the main request (Article 84 EPC)

applies equally to claim 1 of auxiliary request 1. Hence, the Board exercised its discretion under Article 13(1) RPBA not to admit the request into the proceedings.

5. *Auxiliary Request 2 - Admittance*

5.1 Claim 1 was filed, in accordance with the explanation given by the respondent, in an attempt to meet the second option in G 1/99. To this avail, the features held to lack clarity ("and therefore a perimetral zone of the inflatable member (12, 1012, 2002), such that the insert ((20, 80, 1020, 1080) surrounds at least partially the inflatable member (12, 1012, 2002))" were deleted and the feature inserted in claim 1 of auxiliary request 1 ("said insert made of elastic material has a strip or band-like form") was maintained.

5.2 The three options given in G 1/99 however do not apply independently of one another and cannot be chosen *ad libitum*. Indeed, they are set up in a way to indicate a particular sequence of options for overcoming the deficiency presented by a claim. The first option concerns a limitation of the scope of the claim and is indicated in the wording of the headnote of G 1/99 as applying "in the first place" with the meaning that - should this option exist, this first option has to be chosen. The second and third options, in a consecutive manner, should only be considered when the first option is not applicable. However, the Board is convinced that in the current case, the first option is applicable - an amendment introducing one or more originally disclosed features which limit the scope of the patent as amended and which clarify the relationship between the covering surface, the inflatable member and the

elastic insert - and accordingly has to be chosen. Accordingly, already for this reason the second and third options given in G 1/99 are not applicable options here. Indeed, in several embodiments both shown and described, the garment comprises an elastic insert located at and forming the outer periphery of the entire cover member in which it is comprised, so as to form a closed loop (for example such as stated on page 6, lines 1 to 4 of the description, albeit this is mixed in with seemingly unclear terminology such as "at least partially" and a conditional clause about when the insert is combined rather than it specifically forming a certain part of the garment).

5.3 Since the request was not allowable at least for this reason, the Board exercised its discretion under Article 13(1) RPBA not to admit the request into the proceedings.

6. *Auxiliary Request 3 - Admittance*

6.1 Claim 1 of auxiliary request 3 differs from claim 1 of auxiliary request 2 in that the feature "the insert occupies a perimetral zone of the covering surface"

is deleted and and in that the following feature is added:

"and said insert made of elastic material extends at least partially along a perimetral zone of said covering surface".

Thus, in fact, the word "occupies" has been replaced by "extends at least partially along".

6.2 Concerning the deleted feature, the Board had already indicated in its communication for preparing the oral proceedings, and in the oral proceedings itself, that

this feature was understood to be clear. No justification for removing a clear feature, which provides a limitation, albeit a very minor one, has been given.

6.3 Even if the inserted definition was intended to limit this deleted terminology, it is not certain that it does, as argued by the appellant, since extending along may not be the same as occupying. The respondent's contention that the additional feature was an equivalent wording with regard to the deleted feature is thus not agreed. Also, the added wording concerns a relationship of the elastic insert and the covering surface which itself is not clearly defined - in particular in view of the term "at least partially", which had notably already been the discussion of one aspect of the main request.

6.4 Also, the complete deleted wording included a relationship of the elastic insert with regard to the covering surface and with regard to the inflatable member, albeit one which was not clear in the context of the claim (e.g. the insert occupied "therefore" a perimetral zone of the inflatable member). This latter relationship is entirely removed, without any form of replacement.

6.5 Hence, the Board exercised its discretion under Article 13(1) RPBA not to admit the request into the proceedings.

7. *Auxiliary Request 4 - Admittance*

7.1 Claim 1 of auxiliary request 4 differs from claim 1 of auxiliary request 3 in that the feature of "the insert occupies a perimetral zone of the covering surface" is

re-inserted, the words "therefore", "such that" and "at least partially" which were objected under clarity in regard to the main request, are now deleted and concerning the elastic insert it is added that it "has the form of a closed loop" and as a final feature it is added that the insert surrounds the inflatable member "when the inflatable member is combined with the garment".

7.2 From these deletions and additions it follows that the request is at least not convergent with regard to the previous auxiliary request(s). The specific combination of features was never before presented in opposition or in appeal proceedings. The respondent's reference to auxiliary requests 11 and 12 filed in reply to the grounds of appeal and to auxiliary request 6 in reply to the communication of the Board is not persuasive since claim 1 in none of these requests includes the feature of the insert having the form of a closed loop or the feature of "when the inflatable member is combined with the garment". Likewise, the respondent's argument that all requests were convergent since the requests progressively tried to deal with the matter of clarity is not convincing. The requests are simply divergent attempts to deal with the same issue. Thus, due to the lack of convergency, the proceedings were not taking a clearly defined path allowing an economy of procedure to be identified. At the very late stage of proceedings when this request was filed, together with the lack of convergency involved (and thus the lack of procedural economy) are factors which were considered by the Board when exercising its discretion under Article 13(1) RPBA.

7.3 Additionally, the added terminology "when the inflatable member is combined with the garment" is

prima facie not clear, contrary to Article 84 EPC. It is a garment which is claimed in the opening line of the claim; the inflatable member is then normally understood as comprised in the garment. The added terminology "when..." however renders the features concerning the inflatable member and its relationship to the covering surface and the elastic insert in some way conditional and thus obscure in context, and therefore adds a new lack of clarity issue (as also argued by the appellant). The respondent argued that it had taken the complete wording from page 6, but this fact does not alter the underlying *prima facie* lack of clarity which has been introduced. Indeed, while page 6 of the description may even have been referring to some step in combining the parts (or possibly some other issue), the claim itself as explained above is directed to a garment, such that the concrete features of a garment need to be defined to provide clarity, and this has not been done.

7.4 Accordingly, a new clarity objection *prima facie* arises due to the amendments introduced. As already set out under point 3.3 above, in order to be admitted at such late stage of proceedings, a request should normally be *prima facie* allowable at least in the sense that it overcomes the objections raised and does not give rise to new objections.

7.5 It may be further added that claim 1 now defines (due to the deletion of the words "therefore" and "such that") that the insert occupies a perimetral zone of the inflatable member, rather than being some feature resulting from the relationship of other parts, but at the same time the claim states that the insert surrounds the inflatable member, which gives rise to a whole new issue of clarity of the term "occupy" which

now remains in the claim in relation to two different parts and thus, which appears to have two different meanings. Thus the claim is *prima facie* not clear also as a result of this amendment. The respondent's argument that removal of the perceived causal relationship in the claim has made the claim clear is thus not agreed.

7.6 Since the amendments in claim 1 are at least *prima facie* not clear, the Board exercised its discretion not to admit the request into the proceedings with regard to Article 13(1) RPBA.

7.7 Since the request is not admitted into proceedings at least for the foregoing reasons, it is not necessary to deal with the further objections of the appellant under Article 123(2) EPC as to why the request should not be admitted.

8. *Objection under Rule 106 EPC*

8.1 After the Board not having admitted auxiliary request 4, and after the Chairman had asked the parties to confirm their requests, the respondent filed an objection under Rule 106 EPC (see point XIII above).

8.2 According to the objection attached to the minutes the objections were raised as follows:

- (1) "for violation of the application of the right to be heard due to the new clarity objections and continuous changing in the objections being raised during the appeal proceedings and particularly the oral proceedings",
- (2) under Article 113 EPC due to "uncorrect application of the principles of G 1/99 in terms of equity", and finally

(3) the respondent objected in view of the decision not to remit the case to the department of first instance.

8.3 The objection was dismissed for the following reasons.

8.4 As to the newly raised/changing clarity objection (1) and the refusal to remit the case (3) the Board refers to paragraph 1 and its subparagraphs above where it is explained that there was no fresh case and the arguments and discussion correspond to what an appellant is allowed to put forward in order to show that the decision under appeal is wrong. It should be noted that the clarity objection to the main request was first discussed, including individual terminology leading to that lack of clarity. For the further requests, either certain clarity objections still remained or further objections resulted due to amendments made by the respondent. The respondent was given the opportunity to comment on, and did so, on the clarity of claim 1 of all requests. It was clear that the respondent was in full disagreement with the approach adopted by the appellant and the position taken by the Board. However the respondent was able to express its disagreement on both accounts and the Board took into consideration its arguments as apparent from the reasons for the decision; these arguments proved simply not to be persuasive. The only possible "change" in the exchange of arguments that the Board can see concerns the discussion of the auxiliary requests and the fact that arguments of the appellant or comments from the Board were adapted to the changing wording of the claim. This is simply part of the normal progression of an appeal case when such requests are filed.

8.5 As regard the application of the principles of G 1/99 (2), reference is made to the application of the exceptions given by the Board *supra*. The Board could not identify how the right to be heard was violated in so far as the right to be heard only means that the Board has to hear and then decide on the arguments put forward which the the Board has done as should be fully apparent from paragraphs 3.5 to 3.14. It is self-evident that the Board does not have to accept the respondent's arguments. In regard to the respondent's link between "equity" and G 1/99 stated in its objection under Rule 106 EPC, this is not further explained. The only "equity" aspect in G 1/99 relevant to the present proceedings concerns whether or not the non-appealing proprietor should be allowed to make requests allowing it to use the exception to the prohibition of *reformatio in peius* given by G 1/99. This was considered by the Board. The auxiliary requests were not admitted into proceedings for reasons which concerned exercise of the Board's discretion, not for reasons of equity.

8.6 Accordingly, the objection under Rule 106 EPC was to be dismissed.

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:



M. H. A. Patin

M. Harrison

Decision electronically authenticated