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**Datasheet for the decision  
of 22 March 2019**

**Case Number:** T 0913/15 - 3.2.03

**Application Number:** 03701754.8

**Publication Number:** 1396208

**IPC:** A45D1/04, A45D1/06

**Language of the proceedings:** EN

**Title of invention:**

HAIR IRON

**Patent Proprietor:**

Panasonic Electric Works Co., Ltd.

**Opponents:**

TRUE VANTAGE LIMITED  
Offshore Incorporation Centre  
Braun GmbH  
BSH Bosch und Siemens Hausgeräte GmbH

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2), 123(3)

**Keyword:**

Amendments - extension beyond the content of the application  
as filed (yes) - inescapable trap (yes) - broadening of claim  
(yes)

**Decisions cited:**

G 0001/93

**Catchword:**



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Case Number: T 0913/15 - 3.2.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.03**  
**of 22 March 2019**

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**Decision under appeal:**      **Decision of the Opposition Division of the  
European Patent Office posted on 17 February  
2015 revoking European patent No. 1396208  
pursuant to Article 101(3)(b) EPC.**

**Composition of the Board:**

**Chairman**                    G. Ashley  
**Members:**                    C. Donnelly  
                                      G. Weiss

## **Summary of Facts and Submissions**

- I. The appeal lies from the decision of the opposition division revoking European patent no. 1 396 208.

In its decision the opposition division held that the subject-matter of claim 1 did not meet the requirements of Article 123(2) EPC since it construed the granted claim to define the electrode as being in an outlet in the grip, whereas it was originally disclosed as being near an outlet in the grip.

This reasoning was also applied to auxiliary requests 1 to 3 and 12. As regards auxiliary requests 4 to 11, the opposition division considered that amendments to claim 1 which resulted in the position of the electrode being changed from: "in an outlet" to "in the negative-ion generator" did not meet the requirements of Article 123(3) EPC.

Similarly, the subject-matter of claim 1 of auxiliary requests 13 to 15 was considered not to meet the requirements of Article 123(3) EPC.

- II. The patent-proprietor (hereinafter: the "appellant") lodged an appeal against this decision. In response, opponents I, II and III (hereinafter: respondents I, II and III) submitted their respective counter-arguments.
- III. In a communication, pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), annexed to the summons to oral proceedings, the Board informed the parties of its provisional opinion.

- IV. By letter of 24 July 2018 respondent I informed the board that it would not be attending the oral proceedings.
- V. Oral proceedings were held on 22 March 2019 in the absence of respondent I (Rule 115(2) EPC and Article 15(3) RPBA).

At the end of the debate the following requests were confirmed:

The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or that a patent be maintained on the basis of one of the auxiliary requests 1 to 15.

Respondents II and III requested that the appeal be dismissed. Respondent I had also requested in writing that the appeal be dismissed.

- VI. Claim 1 as granted reads:

"A hair iron (100,120,130,140,150,160,170,180) comprising:  
a grip (1),  
a hair-care section (2) connected to the grip (1),  
having a heater (11) for generating heat to hair for hair dressing; and  
a negative ion generator (4) which generates negative ions to emit them toward hair held by the hair-care section (2)

**characterized in that**

the negative-ion generator (4) is built in the grip (1), and the grip further comprises an outlet (9) opening to the hair-care section (2) to emit the

negative ions due to discharge around an electrode therein towards the hair-care section(2)."

*VII. Main request (Claim 1 as granted), Appellant's submissions*

*Claim 1 as granted, Extended subject-matter, Article 100(c), Article 123(2) EPC*

There is no strict rule in English grammar defining which part of the sentence the term "therein" refers to. Even if the characterising portion of claim 1 is interpreted as being formed of two separate clauses separated by a comma, the skilled person would conclude that the term "therein" referred to the grip and not to the outlet. It is also clear from the pre-characterising portion that the negative ion generator is built in the grip and that the electrode is part of the negative-ion generator since the ions are emitted from the negative-ion generator.

Therefore, a skilled person would implicitly read the feature of the negative-ion generator comprising an electrode into claim 1 as granted and effectively understand the first feature of the characterizing portion as "the negative-ion generator comprising an electrode is built in the grip".

Further, a person skilled in the art would realise that it would be unusual to provide a further electrode outside of a negative-ion generator which has already been specified as comprising an electrode that generates the negative ions for emission towards the hair held by the hair-care section.

It also does not make technical sense for safety reasons to provide an electrode operating with high voltage in the outlet of a hand-held hair-care apparatus where it could come into direct contact with the user.

Notwithstanding the above interpretation of the wording of claim 1, if it is considered that there are different ways of understanding the meaning of "therein", then the description should be taken into account. Here at paragraph [0007] of the published application, it is said that the electrode is in the negative ion generator.

The opposition division concluded that the electrode is located outside of the outlet 9, since the application discloses in paragraph [0042] that "the outlet 9 for emitting negative ions are (sic) provided near the electrode of the negative-ion generator 4." However, the term "near" means "close", or "to or at or within a short distance in space or time". Therefore, the above sentence of paragraph [0042] should be interpreted to mean that the electrode 3, 25 is either located inside or outside the neighborhood of the outlet 9. The former arrangement being the basis for the claimed subject-matter.

Paragraph [0042] also states that:

"Negative ions generated around the electrode are not liable to adhere to the inner wall of the housing extending to the outlet 9, so that the as-generated negative ions can be emitted toward hair."

Therefore, it is disclosed that the negative-ion generator 4 (along with the electrode 3, 25) is located



in the housing, that is, the negative-ion generator 4 with the electrode 3, 25 is located in the outlet 9 (also see figure 1).

It can also be taken from figure 1 of the original description that the direction of the outlet 9 is inclined by 10 to 30 degrees relative to the axial line "A" of the hair-care section and the grip. Therefore, it is clear that the part, which is inclined relative to the grip, forms the outlet. The ion-generator is therefore positioned in the outlet 9. Since the ion-generator comprises the electrode, the electrode must also be in the outlet.

In other words, the original application discloses the electrode as being both in the negative-ion-generator and in the outlet since the negative-ion generator is itself located in the outlet.

*VIII. Main request (Claim 1 as granted), Respondents' submissions relevant to the decision.*

Claim 1 should be interpreted on the assumption that it is grammatically correct. On this basis the claim is clear and is technically sensible, there is no justification to construe the claim in a different manner contrary to its proper meaning.

The characterizing portion of claim 1 as granted comprises two separate clauses which are, in addition, separated by a comma. Therefore, the term "therein" in the second clause of the characterizing portion cannot refer to the negative-ion generator which is only mentioned in the first clause and is separated by the comma from the term "therein". Consequently, on the basis of the grammar of claim 1 as granted, the term

"therein" can in principle refer to either "the grip" or to "an outlet". The structure of the second clause makes it clear that the term "therein" must refer to "an outlet" which is part of the grip, i.e., the electrode is located within the outlet of the grip.

Technical considerations are not in contradiction to this analysis of the wording of claim 1 since, assuming that the skilled person would understand the electrode to be part of the negative-ion generator, the electrode of said negative ion generator can be arranged within the outlet, which is part of the grip, because the preamble of claim 1 as granted does not allocate the negative-ion generator to any of the other constituents of the hair iron.

Thus, on both grammatical and technical considerations, the person skilled in the art would understand claim 1 as granted in such a manner that the electrode is part of the negative-ion generator which is arranged within the outlet.

The location of the outlet is explicitly defined at paragraph [0039] of the application as published where it is stated that: "The opening 28a of the case 28 plays the role of the outlet 9." and is illustrated in figures 6 and 7A. Therefore, the outlet is not that part of the device shown in figure 1 of the application which is inclined by 10 to 30 degrees relative to the axial line "A" of the hair-care section and the grip, as the appellant suggests.

The safety issues raised by the appellant would also not be a bar to placing the electrode in the outlet since this could appropriately designed. Although high voltages are under consideration these do not generate

dangerous currents which would not be tolerated in hand-held care devices in any case.

The appellant interprets the disclosure in paragraph [0042] of the application as originally filed as providing a basis for the electrode being arranged within the outlet.

However, the person skilled in the art would differentiate between the electrode being provided "close to or at or within a short distance" to the outlet on the one hand, and the electrode being provided within the outlet on the other hand. Thus, the skilled person reading the passage in paragraph [0042] of the application as originally filed will understand that the electrode is not within the outlet, but rather near or close to it.

Moreover, and more importantly, for claim 1 as granted to fulfil the requirements of Article 123(2) EPC it is not sufficient to show that the feature in question is not in contradiction to the disclosure provided in paragraph [0042] of the application as originally filed. Rather, it must be shown that paragraph [0042] of the application as originally filed provides direct and unambiguous disclosure for the very feature of claim 1 as granted. This is not the case.

In conclusion, the application as originally filed does not provide a direct and unambiguous disclosure for an electrode being arranged within an outlet. Thus, claim 1 as granted contravenes the requirements of Article 123(2) EPC, not only on purely grammatical approach, but also if technical considerations are taken into account as well.

*IX. Auxiliary requests, Appellant's submissions.*

*Auxiliary requests 1 to 3 and 12*

The same reasoning made for the main request applies mutatis mutandis.

*Auxiliary request 13*

The amendment to claim 1 clarifies that the negative ions in the characterising portion are of the negative ion generator. Therefore, it is clear that the electrode is in the negative ion generator.

As submitted with respect to the main request, there are three different interpretations to which the term "therein" may refer one of which is that the electrode is in the negative-ion generator. Therefore, the scope of protection is not extended and the requirements of Article 123(2) EPC are met.

*Auxiliary requests 4 to 11, 14 and 15*

As submitted with respect to auxiliary request 13, Article 123(3) EPC is not infringed since claim 1 as granted allowed three different interpretations.

*X. Auxiliary requests, Respondents' submissions*

The reasons given in the contested decision are correct. Any amendment to claim 1 which results in the the position of the electrode as being in the negative-ion generator as opposed to in an outlet comprised in the grip, extends the scope of protection of claim 1 and therefore is an infringement of Article 123(3) EPC.

## Reasons for the Decision

1. *Main request (claim 1 as granted), Extended subject-matter, Articles 100(c), 123(2) EPC*

1.1 The opposition division considered that the requirements of Article 123(2) EPC were not met since it interpreted claim 1 as granted as specifying that the electrode for discharging the negative ions is **in** the outlet, as opposed to being **near** the outlet, which it considered to be the originally disclosed location.

1.2 The board agrees with the respondent that the skilled person would first read claim 1 as granted on the assumption that it is grammatically correct.

1.3 The pre-characterising part of the claim defines a negative ion generator, and also a direction in which the negative ions it generates are to be emitted. However, it does not provide any further specifications as regards the location, constitution or configuration of the negative-ion generator.

1.4 The characterizing portion of the claim 1, comprises two clauses which are separated by a comma followed by the conjunction "and".

The first clause concerns the negative ion generator and specifies that "the negative-ion generator (4) is built in the grip (1)". Due to the separation of the clauses by a comma it can only be understood that there was a deliberate intention when drafting the claim to separate the specification of the second clause from the first clause.

- 1.5 Although there is a tendency to read the term "therein" in the second clause as referring to the immediately preceding object i.e to the outlet, it could, as the appellant has submitted, in principle, refer to either "the grip" or to "an outlet". However, as the appellant also indicated, the skilled person would make a technically sensible interpretation of the syntax by taking the context of the claim into account. The board considers this to be as follows.
- 1.6 The second clause is clearly set out to define the outlet (9) which is essential for emitting the negative ions (as opposed to the grip, which although a necessary feature, is of less relevance to the invention). Thus, the skilled person would interpret the specification of the second clause as defining the outlet (9) to be comprised in the grip and that an electrode for emitting negative ions is situated in the outlet. The functional aspect of the characterising portion, specifying that the outlet opens to the hair-care section to emit the negative ions towards the hair-care section, only reinforces the interpretation that an electrode for emitting negative ions is in an outlet opening to the hair-care section. Therefore, there is nothing in the construction of the second clause of claim 1 which would dissuade the skilled person from concluding that the term "therein" applies to "an outlet".
- 1.7 Consequently, the board agrees with the respondent that the structure of the second clause makes it clear, from both a linguistic and technical point of view, that the term "therein" must refer to "an outlet" which is part of the grip, i.e. the electrode is located within the outlet of the grip.

- 1.8 The skilled person would also not see any technical difficulty with such an arrangement since, by placing an electrode in the outlet, the negative ions are produced in the nearest location available for emission towards the hair-care section. The board also agrees with the respondent that the safety issues raised by the appellant would not be a bar to placing the electrode in the outlet since the outlet could be appropriately designed to take account of such issues. In any case, although high voltages are under consideration these would be produced so as not to generate dangerous currents which would not be tolerated in hand-held care devices.
- 1.9 Therefore, the board agrees with the opposition division's conclusion that the subject-matter of claim 1 as granted is clearly defined.
- 1.10 The appellant also argued that, in any case, the original application discloses the contested feature since figure 1 shows that the negative-ion generator, which comprises the electrode, is located in the outlet.

However, the board does not accept the appellant's submission that the outlet is that part of the device shown in figure 1 of the application which is inclined by 10 to 30 degrees relative to the axial line "A" of the hair-care section and the grip, since the outlet is explicitly defined at paragraph [0039] of the application as published where it is stated that: "The opening 28a of the case 28 plays the role of the outlet 9." as illustrated in figures 6 and 7A.

1.11 As the opposition division indicated in its decision, the position of the electrodes with respect to the outlet is explicitly disclosed at paragraph [0042] of the application as published, where it is stated that "Because the outlet 9 for emitting negative ions are (sic) provided near the electrode of the negative ion generator 4, the efficiency...". This configuration is clearly shown in figures 6 and 7A where the outlet 28a, 9 is shown as being located away from the needle or line electrodes 3,25 which generate the negative ions.

1.12 It is also not accepted that if the term "near" is taken to mean "close", or "to or at or within a short distance in space or time", that the above sentence of paragraph [0042] means that the electrode 3, 25 is either located inside or outside the neighbourhood of the outlet 9, and therefore that the application discloses that an electrode is in the outlet as being one of the two alternatives.

However, as observed by the respondents, it is not sufficient to show that the contested feature might be hypothetically possible according to the disclosure of paragraph [0042] of the application, but rather, it must be demonstrated that the contested feature is directly and unambiguously disclosed. Since the person skilled in the art would differentiate between the electrode being provided "close to or at or within a short distance" to the outlet on the one hand, and the electrode being provided "in the outlet" on the other hand, this is not the case.

1.13 Consequently, the subject-matter of claim 1 as granted does not meet the requirements of Article 123(2) EPC.



2. *Auxiliary requests*

2.1 *Auxiliary request 13*

During the oral proceedings before the board, the appellant confirmed its request that auxiliary request 13 be discussed first (see minutes of the oral proceedings and letter of 4 April 2016, page 1).

The characterizing portion of claim 1 of auxiliary request 13 reads:

"the negative-ion generator (4) is built in the grip (1), and the grip further comprises an outlet (9) opening to the hair-care section (2) to emit the negative ions of the negative ion generator (4) due to discharge around an electrode therein towards the hair care section (2)."

2.1.1 The board agrees with conclusion of the opposition division that claim 1 of auxiliary request 13 is clear in the sense that the term "therein" in the context of the claim again refers to the outlet, since the characterising portion still consists of two clauses separated by a comma, with the second clause essentially appertaining to characteristics of the outlet. Therefore, the same reasoning concerning Art 123(2) EPC made for the main request applies to auxiliary request 13.

2.1.2 In the hypothetical case that the term "therein" were to be considered to refer to the negative-ion generator, rather than the outlet (since the negative ion generator now immediately precedes the term "therein"), then the subject matter of claim 1 would infringe the requirements of Art 123(3) EPC, since by

changing the position of the electrode from being in the outlet to being in the negative-ion generator, the scope of protection is extended.

- 2.1.3 Also, the conditions specified in G 1/93, Headnote, point 2, do not apply, since the feature of the electrode being in the outlet clearly provides a technical contribution to the subject-matter of the claimed invention since it gives a precise indication of how to construct the device which may be advantageous. Therefore, any amendment which changes the position of the electrode from "in the outlet" to "in the negative-ion generator" would infringe the requirements of Art 123(3) EPC.
- 2.1.4 Thus, irrespective of whether the term "therein" is taken to refer to the outlet or to the negative-ion generator, the subject-matter of claim is unallowable. In the first case, the objections made under Art 123(2) EPC made for the main request still apply. In the second case, claim 1 infringes the requirements of Art 123(3) EPC since the scope of protection has been extended.

2.2 *Auxiliary requests 1 to 3 and 12*

- 2.2.1 The characterising portions of claim 1 of auxiliary requests 1 to 3 and 12 all comprise the features of the characterising portion of claim 1 as granted according to which:

"the negative-ion generator (4) is built in the grip (1), and the grip further comprises an outlet (9) opening to the hair-care section (2) to emit the negative ions due to discharge around an electrode therein towards the hair-care section (2)"

2.2.2 Therefore, the same reasoning made for the main request applies mutatis mutandis to auxiliary requests 1 to 3 and 12. Therefore, the subject matter of claim 1 of the auxiliary requests 1 to 3 and 12 infringes the requirements of Art 123(2) EPC.

2.3 *Auxiliary requests 4 to 11*

The pre-characterising part of claim 1 according to auxiliary requests 4 to 11 has been amended to read:

"a negative ion generator which generates negative ions due to discharge around an electrode therein to emit them toward hair held by the hair-care section."

2.3.1 This amendment changes the position of the electrode from "in the outlet" to "in the negative-ion generator". Therefore, as reasoned above, the scope of protection has been extended such that the requirements of Art 123(3) EPC are not met.

2.4 *Auxiliary requests 14 and 15*

2.4.1 In claim 1 of auxiliary request 14 a comma has been added in order to clarify that the term "therein" refers to the negative-ion generator. In claim 1 of auxiliary request 15 the term "therein" has been deleted and the additional specification "wherein the electrode is in the negative-ion generator" introduced. As held by the opposition division, both amendments have the effect that the electrode is no longer specified as being in the outlet.

2.4.2 Thus, the subject-matter of claim 1 of auxiliary requests 14 and 15 does not comply with the requirements of Article 123 (3) EPC for the reasons given above.

### **Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



C. Spira

G. Ashley

Decision electronically authenticated