

**Internal distribution code:**

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

**Datasheet for the decision  
of 5 October 2018**

**Case Number:** T 2282/17 - 3.2.07

**Application Number:** 10815762.9

**Publication Number:** 2475595

**IPC:** B65D75/00, B65D75/28,  
B65D75/56, B65D75/58

**Language of the proceedings:** EN

**Title of invention:**

FLEXIBLE CONTAINER WITH FITMENT AND HANDLE

**Applicant:**

Smart Bottle, Inc

**Headword:**

**Relevant legal provisions:**

EPC Art. 113(1)  
EPC R. 103(1)(a), 111(2)  
RPBA Art. 11, 12(3)

**Keyword:**

Substantial procedural violation - appealed decision reasoned  
(no)  
Reimbursement of appeal fee - violation of the right to be  
heard (yes)

**Decisions cited:**

T 0897/03, T 0952/07, J 0015/80, G 0003/98, T 0099/13

**Catchword:**



**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 2282/17 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 5 October 2018**

**Appellant:** Smart Bottle, Inc  
(Applicant) 825 Merrimon Ave, Unit 320  
Asheville, NC 28804 (US)

**Representative:** Barton, Matthew Thomas  
Forresters IP LLP  
Skygarden  
Erika-Mann-Strasse 11  
80636 München (DE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 28 April 2017  
refusing European patent application No.  
10815762.9 pursuant to Article 97(2) EPC**

**Composition of the Board:**

**Chairman** I. Beckedorf  
**Members:** A. Pieracci  
V. Bevilacqua

## Summary of Facts and Submissions

I. This appeal, notice of which was filed within the prescribed period and in the prescribed form, is directed against the decision of the examining division dated 28 April 2017 refusing European patent application No. 10 815 762.9, published as international application No. WO 2011/031342 A1.

II. In the course of the examination proceedings the examining division issued first, second and third communications under Article 94(3) EPC, respectively dated 9 July 2015, 22 March 2016 and 9 September 2016.

III. In its first communication the examining division referred to the following documents:

D2: JP 2004 131151 A

D7: US D 608 656 S1

In its third communication it made reference to **unidentified documents** D1 and D3, which can be assumed to be the documents identified as D1 and D3 in the European search opinion, i.e.:

D1: JP 2003 040288 A

D3: JP 2001 348065 A

In its third communication it also referred for the first time to document D8, which was sent to the appellant as an annex to that communication:

D8: US 2009/180716 A1

IV. The appellant (applicant) filed amended claims and comments on the European search opinion on 18 November

2014 and responded to the above communications with first, second and third replies respectively dated 11 December 2015, 25 July 2016 and 8 March 2017. With its second reply the appellant also filed a set of claims according to its auxiliary request.

- V. In its first communication the examining division raised the following objections:  
Claims 1, 2, 3 and 4 did not fulfil the requirement of Article 123(2) EPC.  
The subject-matter of claim 1 lacked novelty with respect to document D2.  
In general terms, claims 2 to 7 lacked novelty and inventive step, reference being made to D2 as showing the common general knowledge.  
Claim 6 lacked clarity.  
Document D7 caused the priority of the application to be invalid and therefore document D7 was part of the state of the art under Article 54(2) EPC, thus destroying the novelty of the subject-matter of claims 1 to 7.
- VI. In its reply to that communication, the appellant contested all the objections raised therein and duly presented counter-arguments.
- VII. In its second communication the examining division indicated that it maintained all the objections under Article 123(2) EPC mentioned in its first communication, as well as the objection of lack of novelty in the subject-matter of claim 1 with respect to D2. It raised a lack of clarity objection for claim 5 and maintained its lack of clarity objection for claim 6. It objected to claim 7 for lack of novelty in its subject-matter with respect to D2.

In its reply to the second communication, the appellant contested the objections raised therein and filed the set of claims according to its first auxiliary request, in which claim 1 corresponds to the combination of claims 1 and 3 of the main request and claims 2 to 6 correspond to claims 2 and 4 to 7 of the main request.

- VIII. In its third communication the examining division indicated that it maintained the objections under Article 123(2) EPC for claims 1, 2 and 4 raised in its second communication and added a further objection for claim 1. It indicated that it maintained the objection of lack of clarity for claim 6 that it had raised in its previous communication. It raised an objection of lack of inventive step for claims 1 to 6, considering either of D1 and D3 as the closest prior art in combination with the common general knowledge as represented by D8.

The examining division also argued that since claim 1 of the auxiliary request corresponded to claim 1 of the main request with the addition of the features of claim 3, which were known from D1 and D3, the objections to the main request raised in the third communication were also relevant for the auxiliary request, which was also not allowable.

- IX. By letter of 8 March 2017 the appellant withdrew its request for oral proceedings and requested a decision according to the state of the file in accordance with the Guidelines, Part E-IX, 4.4, and C-V, 15.
- X. The examining division issued the impugned decision in a standard form. The decision refers to the first, second and third communications. The full text of the grounds of the decision reads as follow:

"In the communication(s) dated 09.09.2016, 22.03.2016, 09.07.2015 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein. The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 08.03.2017. The application must therefore be refused."

- XI. The appellant claims a substantial procedural violation by the examining division, arguing that the decision under appeal was insufficiently reasoned and so contravened Article 113 EPC. The appellant's line of argument will be dealt with in detail in the reasons for this decision.
- XII. In the statement of grounds of appeal, the appellant essentially requested:
- that the decision under appeal be set aside and
  - that a patent be granted on the basis of one of the sets of claims filed as main request and first and second auxiliary requests by letter of 8 September 2017, with a description to be adapted, and
  - that the appeal fee be reimbursed due to a substantial procedural violation, and
  - that oral proceedings be arranged if the Board were minded to dismiss the appeal.

XIII. Independent claim 1 of the main request, corresponding to the main request in examination, reads as follows:

1. A flexible (10) container for resting on a surface when in a filled condition, comprising:

- a panel structure of flexible web material, defining a pouch (12) that has a top opening (24);
- a rigid fitment in the top opening (24), having a fitment opening (54) through which the pouch (12) can be filled with liquid;
- an upper handgrip (86) coupled to the pouch configured to be grasped by a hand fully about the upper handgrip (86) to suspend the pouch (12) solely by the upper handgrip (86) in an upright orientation in which the fitment opening (54) faces upward;
- a lower handgrip (90) coupled to the pouch (12) configured to be grasped by a hand fully about the lower handgrip (90) to suspend the pouch (12) solely by the lower handgrip (90) in an inverted orientation in which the fitment opening (54) faces downward for liquid in the pouch (12) to flow by gravity out of the pouch (12) through the fitment (14);
- wherein the upper and lower handgrips (86, 90) are further configured to be manually grasped for suspending the pouch (12) simultaneously by both handgrips in a partially inverted orientation in which the fitment opening (54) faces sideways for the liquid to flow by gravity out from the pouch (12) through the fitment (14); and
- wherein the upper and lower handgrips (86, 90) comprise a straight horizontal section (94) and two opposite vertical sections (96) that define a flap (67), wherein the flap (67) is configured to be bent upward about a horizontal fold line (68)



when the upper and lower handgrips (86, 90) are manually grasped.

XIV. Independent claim 1 of the first auxiliary request, corresponding to the auxiliary request in examination, reads as follows:

1. A flexible (10) container for resting on a surface when in a filled condition, comprising:

a panel structure of flexible web material, defining a pouch (12) that has a top opening (24);

a rigid fitment in the top opening (24), having a fitment opening (54) through which the pouch (12) can be filled with liquid;

an upper handgrip (86) coupled to the pouch configured to be grasped by a hand fully about the upper handgrip (86) to suspend the pouch (12) solely by the upper handgrip (86) in an upright orientation in which the fitment opening (54) faces upward;

a lower handgrip (90) coupled to the pouch (12) configured to be grasped by a hand fully about the lower handgrip (90) to suspend the pouch (12) solely by the lower handgrip (90) in an inverted orientation in which the fitment opening (54) faces downward for liquid in the pouch (12) to flow by gravity out of the pouch (12) through the fitment (14);

wherein the upper and lower handgrips (86, 90) are further configured to be manually grasped for suspending the pouch (12) simultaneously by both handgrips in a partially inverted orientation in which the fitment opening (54) faces sideways for the liquid to flow by gravity out from the pouch (12) through the fitment (14); and

wherein the upper and lower handgrips (86, 90) comprise a straight horizontal section (94) and two opposite vertical sections (96) that define a flap (67), wherein the flap (67) is configured to be bent upward about a horizontal fold line (68) when the upper and lower handgrips (86, 90) are manually grasped, and further wherein the panel structure is expandable from a collapsed, unfilled condition to an expanded, filled condition.

XV. The only claim of the second auxiliary request reads as follows:

1. A flexible container comprising:

a panel structure of flexible web material, defining a pouch that has a top opening; a rigid fitment in the top opening, having a fitment opening through which the pouch can be filled with liquid;

an upper handgrip coupled to the pouch, configured to be grasped by a hand fully about the upper handgrip to suspend the pouch solely by the upper handgrip in an upright orientation in which the fitment opening faces upward; and

a lower handgrip coupled to the pouch, configured to be grasped by a hand fully about the lower handgrip to suspend the pouch solely by the lower handgrip in an inverted orientation in which the fitment opening faces downward for liquid in the pouch to flow by gravity out of the pouch through the fitment;

the upper and lower handgrips being further configured to be manually grasped simultaneously for suspending the pouch by both handgrips in a partially inverted orientation in which the

fitment opening faces sideways for the liquid to flow by gravity out from the pouch through the fitment;

and wherein the container further comprises suspensions extending from opposite ends of the upper handgrip to the pouch for bearing the weight of the pouch when lifted in the upright orientation, and in the pouch's partially inverted orientation enabling the entire fitment to be located beyond the suspensions in a direction away from the rear handgrip.

### **Reasons for the Decision**

1. The decision is issued in written procedure.

According to Article 12(3) RPBA, the Board may, subject to Articles 113(1) and 116(1) EPC, decide the case at any time after filing of the statement of grounds of appeal.

With regard to the findings and the order of the decision, the appellant's auxiliary request for oral proceedings if the Board were minded to dismiss the appeal is no longer relevant. The case is ready for decision on the basis of the appellant's extensive written submissions and of the decision under appeal and the communications issued by the examining division.

For this reason, the issuing of the decision in written procedure without oral proceedings is in compliance with the requirements of Article 113(1) EPC.

2. The appellant submits that a standard decision form for issuing a decision on the state of the file which refers to several communications and leaves it up to the Board to construct the applicable reasons by "mosaicing" various arguments from the file, or which leaves it in doubt which argument applies to which claim version, does not meet the "reasoned" requirement of Rule 111(2) EPC.

Since the decision under appeal indicated all three communications as providing the grounds for the decision to refuse the application, it is not clear which grounds for refusal have been overcome by its replies to the communications and which ones still apply.

The appellant argues that it follows from the above that the decision does not qualify as a reasoned decision and that therefore a substantial procedural violation justifying reimbursement of the appeal fee has occurred.

The board agrees, for the following reasons.

3. Reasoned decision (Rule 111(2) EPC)
  - 3.1 It is established jurisprudence of the Boards of Appeal that a first-instance decision is reasoned in the sense of Rule 111(2) EPC if it includes, in logical sequence, the arguments justifying the order. Where a decision only refers to one or more previous communications, leaving it to the Board and the appellant to speculate as to which of the reasons given by the examining division might be essential to the decision to refuse the application, it does not meet the requirements of Rule 111(2) EPC (see T 952/07, not published in the OJ

EPO, Reasons 3, and Case Law of the Boards of Appeal, 8th edition 2016, III.K.4.2.3 c), with reference to T 897/03, not published in OJ EPO).

The "reasoned" requirement imposed by Rule 111(2) EPC aims at allowing the losing party to understand the reasons for the negative decision taken against it so that it can envisage the filing of an appeal. The same is true for the competent board of appeal which may have to deal with the appeal and has to understand why the first-instance department took the impugned decision (see Case Law of the Boards of Appeal, 8th edition 2016, III.K.4.3.2, first paragraph, last two sentences, with reference to T 952/07, not published in OJ EPO).

- 3.2 The impugned decision refers to the three communications of the examining division, in which the examining division formulates various objections to the patentability of the claims of the main request. While some of these objections are repeatedly reiterated throughout the examination proceedings, others are not pursued up to the last communication.

As indicated by the appellant, the objection of added subject-matter for claim 3 raised in the first and second communications is no longer addressed in the third (and last) communication. The same applies to the objection of lack of novelty in the subject-matter of claim 1 based on document D2, which is addressed in the first and second communications but not in the third. The objection of lack of clarity for claim 5 is raised in the second communication but not pursued in the third. Lack of novelty based on document D2 is also raised against claim 7 in the second communication but is no longer addressed in the third. The objection

presented in the first communication based on document D7 and leading the examining division to consider the priority of the application as not being validly claimed and to consider document D7 as destroying the novelty of the subject-matter of claims 1 to 7 is also not raised again in the second and third communications.

The examining division, however, did not indicate whether or not the objections which had not been pursued throughout the proceedings up to the last communication still prejudiced the patentability of the claimed subject-matter.

It is true that in its communications the examining division explicitly indicated that certain objections previously raised were maintained (see the last sentence of paragraphs 1 and 2 of the second communication and the first sentence of paragraph 1.5 and the last sentence of paragraph 2 of the third communication), but this does not allow it to be inferred that objections which are not mentioned in a later communication and are not explicitly maintained are to be considered abandoned.

In fact, it could well be that the examining division no longer upheld any of these objections, but also that it considered all or some of them still to be prejudicial to the granting of the patent.

It is therefore left to the appellant and to the Board to speculate whether any of the objections above, not pursued up to the third and last communication, are considered by the examining division to be reasons prejudicial to the granting of the patent.

By failing to clearly indicate which of the reasons are prejudicial to the granting of the patent, the examining division did not issue a reasoned decision within the meaning of Rule 111(2) EPC, and it therefore committed a substantial procedural violation.

4. Right to be heard (Article 113(1) EPC)

4.1 The right to be heard under Article 113(1) EPC requires that those involved be given an opportunity not only to present comments (on the facts and considerations pertinent to the decision) but also to have those comments considered, that is, reviewed with respect to their relevance for the decision on the matter (see Case Law of the Boards of Appeal, *supra*, III.B.2.4.1).

4.2 The Board considers that the examining division in its decision did not fully observe the appellant's right to be heard for a number of reasons which are discussed in the following.

4.2.1 Objection of lack of novelty in the subject-matter of claims 1 to 7 of the main request with respect to document D7

When entering the examination phase, the appellant filed amended claims and provided comments as to why the amended claims fulfilled the requirements of the EPC. In particular, it argued that document D7 was a US design patent and could not be seen as a first application in the sense of the Paris Convention. The priority of the application was therefore validly claimed and document D7 did not form part of the state of art in accordance with Article 54(2) EPC. The appellant cited decision J 15/80 (not published in OJ EPO) in support of its argument.

The examining division in its first communication argued that D7 was a US design patent relating to an invention defined by its drawing, showing all the features of the application and thus invalidating the claimed priority and destroying the novelty of the subject-matter of claims 1 to 7.

In its reply to the first communication the appellant further argued that the fact that D7 was a US design patent meant that it could not be considered a first application, in accordance with decision J 15/80. The appellant also argued that an applicant in Europe could not claim priority from a United States design patent but only from a United States patent or patent application. Therefore D7 did not render the priority of the application invalid.

The appellant further submitted that the drawings of D7 did not unambiguously show the features of claim 1 of (i) a fitment opening, (ii) a lower handgrip or (iii) a lower handgrip comprising a flap, wherein the flap was configured to be bent upward, and that therefore, even if the priority of the application were not validly claimed, document D7 would still not destroy the novelty of the subject-matter of claim 1.

The objection based on D7 in the first communication was not further addressed by the examining division in its later communications. However, the first communication is indicated by the examining division in its decision as being part of the grounds for the decision, and therefore, in the absence of any indication to the contrary, the Board and the party must assume that this objection is part of the reasons for the refusal.



The examining division did not comment on the arguments presented by the appellant in its first reply, in either its second or third communication. In particular, there is on file no counter-argument of the examining division with regard to the relevance of decision J 15/80 to the present case or to the appellant's argument that some features of claim 1 cannot be derived from D7.

The absence of any indication that the arguments put forward by the appellant have been considered constitutes a violation of Article 113(1) EPC.

#### 4.2.2 Objection of lack of novelty in the subject-matter of claim 1 of the main request with respect to D2

In its second communication, objecting to the novelty of the subject-matter of claim 1 with respect to document D2, the examining division argued that in D2 there was no indication that the bag therein disclosed was rigid and that since the bag of D2 was to be used as an inner bag for a bag in a box structure, it made no sense to make it rigid, since an outer box would then be superfluous.

The appellant replied to these arguments in its second reply, indicating that in D2 the bag was described as a cubic or rectangular solid (paragraphs [0012], [0013], [0024]) having firmness and strength (paragraph [0020]). It also argued that it would make sense to insert the bag of D2 into a rigid box to protect it during transport.

The objection of lack of novelty with respect to D2 was not addressed by the examining division in its third

communication. However, since the first and second communications are indicated as being part of the grounds of the decision, in the absence of any indication to the contrary the Board and the appellant must assume that this objection is part of the reasons for the refusal.

No counter-argument was provided by the examining division to the arguments provided by the patentee in its reply to the second communication. The absence of any indication that those arguments have been considered constitutes a violation of Article 113(1) EPC.

4.2.3 Objection of lack of novelty in the subject-matter of claim 7 of the main request with respect to document D2

The objection of lack of novelty for claim 7 was raised by the examining division with respect to document D2 in its second communication.

The examining division argued in particular that the portions of the parts 3/3' extending below the handgrips could be seen as suspension means. The appellant argued against that objection in its reply. It maintained that the examining division had not carried out a feature analysis of claim 7 and that in any case document D2 showed at most two suspensions and not four as required by claim 7.

The appellant's arguments were not addressed in the examining division's third and last communication, and so the absence of any indication that those arguments have been considered constitutes a violation of Article 113(1) EPC.

4.2.4 Objection of lack of clarity for claim 5 of the main request

The objection of lack of clarity for claim 5 was raised for the first time by the examining division in its second communication and rebutted by the patentee, which provided counter-arguments. The examining division maintained that the expression "the upper and lower handgrips are bounded by openings in the front and rear panels" used in claim 5 was unclear and left the reader in doubt as to the technical feature that it defined.

The appellant, referring to page 3 of the description together with figures 6 and 7, counter-argued that the verb "bounds" or "bounded" referred to providing a boundary to something else, i.e. the boundary of the upper and lower handgrips was provided by openings in the front and rear panels, and that this would be clear to a person skilled in the art.

The appellant's counter-arguments were not addressed by the examining division in its third and last communication, and so as with the previous objections there has been a violation of Article 113(1) EPC.

4.2.5 Objection of lack of inventive step in the subject-matter of claims 1 to 6 of the main request

The examining division in its third communication objected to the inventiveness of the subject-matter of claim 1 starting from D1 or D3 in combination with the common general knowledge as presented in D8. Independently of the fact that documents D1 and D3 were not identified in the examination proceedings, the examining division gave no reasons why D1 or D3 was to

be seen as the closest prior art. The communication also does not include a feature analysis indicating to the appellant where the features considered to be known from D1 or D3 are actually to be found in those documents.

Since these elements are essential in allowing the appellant to understand why the subject-matter of claim 1 is considered to lack an inventive step, the reasons for the objection of lack of inventive step are not properly formulated, and the examining division's decision is to be regarded as not reasoned in the sense of Rule 111(2) EPC in this respect too.

In the same communication the examining division raised an objection of lack of inventive step for dependent claims 2-6 as well, its only argument being that all their features could be derived from documents D1 and D3.

The examining division, however, failed to indicate in the communication where in D1 or D3 these features could be found.

The examining division's decision is therefore not properly reasoned in the sense of Rule 111(2) EPC in this respect either.

5. Further deficiencies under Rule 111(2) and Article 113(1) EPC

5.1 Objection of added subject-matter for claim 1 of the main request

Claim 1 of the main request corresponds to claim 24 as originally filed, with the following additional combination of features:

"...the upper and lower handgrips (86, 90) comprise a straight horizontal section (94) and two opposite vertical sections (96) that define a flap (67), wherein the flap (67) is configured to be bent upward about a horizontal fold line (68) when the upper and lower handgrips (86, 90) are manually grasped...."

5.1.1 The examining division contended that claim 1 had been amended in such a way that it contained subject-matter which extended beyond the content of the application as filed.

In its first communication, it maintained that the passage in paragraph 3 of page 5 of the application as filed related only to the upper handle and could not provide a basis for the amendment. It also argued that "...the figures show a lot of other features which have not been defined in claim 1. No support for the extraction of these particular features and their combination with the remaining features of claim 1 can be seen in the references cited by the applicant or in the rest of the application as originally filed....".

In its second communication, the examining division argued that none of the features added to claim 1 "...were claimed nor disclosed as essential to the definition of the invention in the originally filed

application..." and that these features "...are mentioned in the description as filed only in combination with other features and nowhere in the description as filed it is mentioned or it can be seen that these features can be used as such in combination with the subject-matter of the claims as originally filed..."

In its third communication, the examining division argued that the features added to claim 1 were "...whole to be seen in the description and the drawings as filed but only in combination with other features disclosed in the corresponding passages of the description and the figures...". It also argued that the "...subject-matter defined in claim 1 is much broader than what had been actually recited in the description and the drawings and covers embodiments which are not originally disclosed (not allowable intermediate generalization)..."

5.1.2 The appellant reacted to the examining division's objection, arguing that the passage added to claim 24 as originally filed was supported by the passage on page 7, last paragraph, relating to the lower handgrip and by the passage on page 5, paragraph 3, relating to the upper handgrip. It also argued with reference to decision G 3/98 (OJ EPO 2001, 62) that the fact that the added features were neither claimed nor disclosed as being essential for the invention in the originally filed application was not a relevant criterion for addressing the matter, since what was relevant was that the person skilled in the art was not presented with information which was not directly and unambiguously derivable from the whole content of the application as filed.

The appellant further argued that all the figures depicted the impugned features of the handgrips, to the extent that the handgrips were shown. No other kind of handgrips apart from the ones claimed was shown in the application. While originally filed claim 24 provided a general definition of the claimed apparatus, its subject-matter was limited in present claim 1 by the features of the upper and lower handgrips shown in the drawings and mentioned in the description of the embodiment of the invention. No new information had been added, since it was clear that the handgrips were part of the invention.

The appellant also made reference to decision T 99/13 (not published in OJ EPO), which he considers to provide the teaching that, where the example of a patent provides a feature, this is a clear indication to the skilled person that this feature is combinable with the disclosure of the invention without adding subject-matter.

By amending claim 24 as originally filed with the features of the specific configuration of the lower and upper handgrips recited in the original description and shown in the drawings, which are the only and preferred handgrips described in the application, no new information is presented to the person skilled in the art.

- 5.1.3 The Board considers that the appellant's arguments have not been properly taken into account by the examining division.

The appellant essentially argues that the combination of features of the upper and lower handgrips added to originally filed claim 24 have support in the

description and in the drawings, where they are shown as part of the example of the invention. A broad definition of the invention (original claim 24) was limited with a specific realisation (the claimed handgrips), and no new technical information was added.

The core of the counter-arguments provided by the examining division to contest the appellant's arguments is that the features added to claim 24 are disclosed only in combination with other features disclosed in the corresponding passages of the description and the figures.

However, the examining division did not in any of its communications specifically indicate any of the features which it considered to have been shown in combination with the features of the handgrips and whose absence in claim 1 it considered to give rise to an unallowable intermediate generalisation, and it has given no reasons why this should be the case.

By not identifying any of the features shown in combination with the lower and upper handgrips and by not giving reasons why the absence in claim 1 of such features causes the subject-matter of the claim to extend beyond the content of the application as filed, the examining division failed to properly indicate the logical chain of reasoning leading to the conclusion it reached, thereby not issuing a reasoned decision in the sense of Rule 111(2) EPC.

Moreover, by not providing detailed counter-arguments with respect to the appellant's argument that claim 1 represents an allowable limitation of originally filed claim 24 with an originally disclosed preferred realisation of the handgrips in such a way that no new



technical information is provided, the examining division failed to grant the appellant its right to be heard according to Article 113(1) EPC.

5.2 Objection of added subject-matter for claims 2, 3 and 4 of the main request

The considerations set out for claim 1 apply *mutatis mutandis* to the dependent claims.

5.2.1 The appellant indicated during examination that claim 2 was based on page 3, paragraph 1, of the published application, that claim 3 was based on the "Overview" section on page 2, on the second paragraph of page 4 and on figures 1 and 2 and the corresponding description, and that claim 4 found support on page 8, paragraph 3, in the figures and in the corresponding description.

The appellant further submitted that the features of the dependent claims were derived from the example of the invention, so that the person skilled in the art would understand that these features could be combined with the rest of the disclosure without providing any additional technical information. In particular, only one pouch was described in the example of the application, page 3, lines 1-3, and the same wording used therein was used for claim 2. From the "Overview" section on page 2 it was derivable that the invention related to an expandable container as claimed in claim 3. All the embodiments had a generally square footprint as defined on page 8, third paragraph, and claimed in claim 4.

5.2.2 The examining division argued that the passages indicated by the applicant did not support the

amendments to the dependent claims since "a lot of other features" were shown in these passages and there was no support for the extraction of the features claimed from the combination originally disclosed. As for claim 1, the examining division indicated that the features of the dependent claims were neither claimed nor disclosed as being essential to the definition of the invention in the originally filed application. The examining division also argued that not all the embodiments of the application fell within the scope of claim 2 (figures 14 and 15) and claim 4 (figures 12-15).

5.2.3 The Board is of the following opinion:

As for independent claim 1, in its reasoning the examining division fails to specifically indicate the features which are actually disclosed in combination with the features of dependent claims 2 to 4 and whose absence from the dependent claims gives rise to an unallowable intermediate generalisation, and to give reasons why this should be the case. The examining division therefore fails to show the proper chain of arguments leading to its decision, and the "reasoned" requirement of Rule 111(2) EPC is not fulfilled.

Furthermore, the examining division does not provide detailed counter-arguments to the appellant's argument that because claims 2, 3 and 4 were formulated with features taken from the example of the invention presented in the description and the drawings, the person skilled in the art was not provided with further technical information and therefore the dependent claims did not present subject-matter extending beyond the content of the application as filed. The arguments presented by the examining division, i.e. that a lot of (unspecified) other features are disclosed in

combination with the claimed features in the originally filed application, that the features introduced in the claims were not claimed or disclosed as being essential upon filing, and that not all the embodiments fall under the dependent claims, do not specifically address the appellant's arguments. Therefore, since no proper counter-arguments have been provided against the appellant's arguments, the requirements of Article 113(1) EPC are not fulfilled.

6. Remittal to the examining division (Article 11 RPBA)

Pursuant to Article 11 RPBA, when fundamental deficiencies are apparent in the first-instance proceedings, the case is remitted to the department that issued the decision under appeal for further prosecution.

In the case at hand, the examining division has infringed Article 113(1) and Rule 111(2) EPC, and no special reasons for not remitting the case are obvious and/or mentioned by the appellant.

Thus, remittal is justified.

7. Reimbursement of the appeal fee (Rule 103(1)(a) EPC)

The appeal is allowable to the extent that the decision under appeal is set aside. Since the examining division's decision clearly contravened Rule 111(2) and Article 113(1) EPC, and since the appellant had to appeal in order to obtain a fully reasoned decision, it is equitable to reimburse the appeal fee pursuant to Rule 103(1)(a) EPC.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated