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Datasheet for the decision of 1 July 2020

Case Number: T 0942/18 - 3.2.07

Application Number: 11158576.6

Publication Number: 2371495

IPC: B26B19/38

Language of the proceedings: EN

Title of invention:
Electric shaver

Patent Proprietor:
Panasonic Intellectual Property Management Co., Ltd.

Opponent:
THE PROCTER & GAMBLE COMPANY

Headword:

Relevant legal provisions:
EPC Art. 83, 100(b), 111(2) sentence 1, 113(1), 116(1)
EPC R. 111(2), 103(1)(a)
RPBA 2020 Art. 11, 12(8)

Keyword:
Remittal to the department of first instance - fundamental deficiency in first instance proceedings (yes)
Substantial procedural violation - appealed decision reasoned (no)

Decisions cited:
T 0063/06

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 0942/18 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 1 July 2020

Appellant: (Patent Proprietor)	Panasonic Intellectual Property Management Co., Ltd. 7 OBP Panasonic Tower, 1-61, Shiromi 2-chome, Chuo-ku, Osaka-shi, Osaka 540-6207 (JP)
Representative:	Appelt, Christian W. Boehmert & Boehmert Anwaltspartnerschaft mbB Pettenkoferstrasse 22 80336 München (DE)
Respondent: (Opponent)	THE PROCTER & GAMBLE COMPANY One Procter & Gamble Plaza Cincinnati, Ohio 45202 (US)
Representative:	Elkington and Fife LLP Prospect House 8 Pembroke Road Sevenoaks, Kent TN13 1XR (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 15 February 2018 revoking European patent No. 2371495 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	I. Beckedorf
Members:	V. Bevilacqua
	K. Poalas

Summary of Facts and Submissions

I. The patent proprietor lodged his appeal in the prescribed form and within the prescribed time limits against the decision of the opposition division revoking the European patent EP 2 371 495.

The grounds of opposition invoked were those according to Article 100(a) EPC (lack of novelty, lack of inventive step), as well as those according to Article 100(b) and (c) EPC.

II. The patent was revoked based on the ground according to Article 100(b) EPC because of a lack of sufficiency of disclosure.

III. The independent claims 1 of the main request at the basis of the impugned decision (as granted) reads as follows:

"An electric shaver (1), comprising:
an outer blade (8) including blade holes (50) defined by bars (40); an inner blade (13) which is provided inside of the outer blade (8) and moved relative to the outer blade (8) to cut a body hair inserted into one of the blade holes (50), wherein the bars (40) include a hair raising bar (45) having a hair raising portion (45g) raising the body hair, the hair raising bar (45) includes a skin contact surface (45a) facing skin (70), a flat-bottom surface (45b) formed on the inner blade (13) side, an inner side surface (45c) facing the blade holes (50) or the inner blade (13), and a hair raising surface (45d) connecting the skin contact surface (45a) and the inner side surface (45c), characterized by a

profile shape of a cross section of the hair raising portion (45g) is formed by connecting a blade hole side edge (45e) in a cross-sectional line of the skin contact surface (45a) and a blade hole side edge (45f) in a cross-sectional line of the inner side surface (45c) with one linear connecting element (81a), and the linear connecting element (81a) and the cross-sectional line (45h) of the skin contact surface (45a) are connected so that the angle between the linear connecting element (81a) and the cross-sectional line (45h) of the skin contact surface (45a) is not less than 90 degrees but less than 180 degrees, and the linear connecting element (81a) and the cross-sectional line (45i) of the inner side surface (45c) are connected so that the angle between the linear connecting element (81a) and the cross-sectional line (45i) of the inner side surface (45c) is not less than 90 degrees but less than 180 degrees, wherein the inner side surface (45c) is inclined."

The independent claims 2 of the main request at the basis of the impugned decision (as granted) reads as follows:

"An electric shaver (1), comprising:
an outer blade (8) including blade holes (50) defined by bars (40); an inner blade (13) which is provided inside of the outer blade (8) and moved relative to the outer blade (8) to cut a body hair inserted into one of the blade holes (50), wherein the bars (40) include a hair raising bar (45) having a hair raising portion (45g) raising the body hair, the hair raising bar (45) includes a skin contact surface (45a) facing skin (70), a flat-bottom surface (45b) formed on the inner blade (13) side, an inner side surface (45c) facing the blade holes (50) or the inner blade (13), and a hair raising

surface (45d) connecting the skin contact surface (45a) and the inner side surface (45c), a profile shape of a cross section of the hair raising portion (45g) is formed by connecting a blade hole side edge (45e) in a cross-sectional line of the skin contact surface (45a) and a blade hole side edge (45f) in a cross-sectional line of the inner side surface (45c) with a plurality of connecting elements (80), characterized by the plurality of connecting elements (80) are one line segment (81) and one arc line (82), wherein the inner side surface (45c) is inclined."

The independent claims 3 of the main request at the basis of the impugned decision (as granted) reads as follows:

"An electric shaver (1), comprising:
an outer blade (8) including blade holes (50) defined by bars (40); an inner blade (13) which is provided inside of the outer blade (8) and moved relative to the outer blade (8) to cut a body hair inserted into one of the blade holes (50), wherein the bars (40) include a hair raising bar (45) having a hair raising portion (45g) raising the body hair, the hair raising bar (45) includes a skin contact surface (45a) facing skin (70), a flat-bottom surface (45b) formed on the inner blade (13) side, an inner side surface (45c) facing the blade holes (50) or the inner blade (13), and a hair raising surface (45d) connecting the skin contact surface (45a) and the inner side surface (45c), a profile shape of a cross section of the hair raising portion (45g) is formed by connecting a blade hole side edge (45e) in a cross-sectional line of the skin contact surface (45a) and a blade hole side edge (45f) in a cross-sectional line of the inner side surface (45c) with a plurality of connecting elements (80), characterized by the

plurality of connecting elements (80) include a plurality of line segments (81) and/or a plurality of arc lines (82), wherein angles formed by connecting pairs of any two of the line segments (81), the cross sectional line (45h) of the skin contact surface (45a), and the cross-sectional line (45i) of the inner side surface (45c) are all not less than 90 degrees but less than 180 degrees, and any two of the arc lines (82) connected to each other have the centers of curvature positioned different from each other, wherein a top portion (T1) is formed in the skin side of the hair raising surface (45d), and the inner side surface (45c) is inclined."

IV. The appellant (patent proprietor), while requesting that the appeal fee be reimbursed, initially defended the patent as granted and, in the alternative, in amended form on the basis of one of auxiliary requests submitted with the statement setting out the grounds of appeal.

The respondent (opponent) initially requested the dismissal of the appeal.

V. In order to prepare for the oral proceedings scheduled at the request of both parties, the Board issued a communication pursuant to Article 15(1) RPBA dated 20 April 2020.

The Board's preliminary assessment of the case was, following a corresponding objection raised in the statement setting out the grounds for appeal, that the issue of sufficiency of disclosure, on the basis of which the patent in suit was revoked, did not appear to be sufficiently reasoned in the impugned decision.

As a consequence of the above the reimbursement of the appeal fee and a remittal to the opposition division for further prosecution were to be expected as likely outcome of the appeal procedure.

VI. In a letter dated 28 May 2020 the appellant reacted to the Board's communication by modifying their requests, namely

(1) to set aside the decision under appeal and to remit the case to the opposition division;
(2) in case the request under (1) is not granted in writing, to set aside the decision under appeal and reject the opposition;
(3) in case the request under (2) cannot be granted in writing, to schedule oral proceedings;
(4) in case the request under (2) cannot be granted, and further auxiliary, to maintain the patent on the basis of one of auxiliary requests 1 to 4 subject to the decision under appeal, and auxiliary requests 5-7 and 1'-7' attached to the statement setting out the grounds of appeal; and
(5) to reimburse the appeal fee.

VII. In a letter dated 10 June 2020 the respondent confirmed its original main request, namely

that the appeal be dismissed.

Should a decision remitting the case to the opposition division for further prosecution be issued, the respondent additionally requested (supplementary request)

that the order thereof contained the following statements:

- that the Board had formed no view about the substantive issue of whether any of the appellant's requests met the requirements of Article 83 EPC;

- that the opposition division be prevented from reopening the debate and from appointing further oral proceedings on this particular issue.

The respondent withdrew their previous request for oral proceedings and instead requested oral proceedings before any decision is taken by the Board that any of the requests of the appellant meets the requirements of Article 83 EPC.

The respondent noted that they understood that the Board would be able to allow the request (1) of the appellant in their letter of 28 May, without hearing the parties at oral proceedings. However, the Board would have to hold oral proceedings before allowing request (2) of the appellant.

VIII. Insofar as relevant to the present proceedings, the appellant argued as follows.

The appealed decision did not contain any explanation on why the claimed cross-sectional geometry of the hair raising bar had microscopical dimensions in the range of some µm.

This unsubstantiated allegation was taken as basis for a further unsubstantiated allegation, namely that the known manufacturing techniques were unsuitable for achieving the claimed geometry, and that therefore the invention was not sufficiently disclosed.

The appealed decision was therefore not reasoned within the meaning of Rule 111(2) EPC.

Moreover, the opposition division also disregarded the appellant's central argument that conventional manufacturing techniques also included laser cutting, sintering and deburring, and that these allowed manufacturing of the claimed outer blades at the time of priority without any undue burden.

IX. In relation to the above issue, raised by the appellant, that the appealed decision was not reasoned, the respondent argued as follows.

The appealed decision was not only correct in substance but also reasoned.

A more extensive reasoning was not necessary, because, following T 63/06 (not published in the OJ EPO) the burden of proof on sufficiency of disclosure was on the proprietor-appellant, who failed to offer any evidence of the existence of a suitable process that was both common general knowledge and capable of making the claimed outer blades.

As there was no reasonable doubt that the claimed geometrical features of the outer blades had very small dimensions, in spite of the fact that no dimensions were mentioned in the claims, the opposition division did not need to address this issue in detail in its decision.

The absence, in the appealed decision, of a statement that the appellant failed to discard his burden of proof by explaining how the manufacturing techniques they mentioned could be used to put the invention into

practice, was not to be considered as a fundamental deficiency.

Remittal only because of such a minor defect, limited to the formulation of the reasons appealed decision, would be seriously detrimental to procedural economy.

Even if the impugned decision contained this defect, still it was taken on a sound procedural basis, because the opposition division heard the parties, closed the debate and deliberated before the decision was announced, and correct in substance.

In the eventuality that the case was to be remitted for further prosecution, the opposition division should be only permitted to complete the reasons by adding the missing statements, and be prevented from re-opening the discussion on sufficiency of disclosure, because this would give an unfair procedural advantage to the appellant, who would be heard at three instances.

Reasons for the Decision

1. The case is ready for decision which is taken in written proceedings without holding oral proceedings in accordance with Article 12(8) RPBA 2020. The parties' rights under Articles 113 and 116 EPC are observed.

The principle of the right to be heard pursuant to Article 113(1) EPC is observed since that provision only affords the opportunity to be heard and the parties’ submissions are fully taken into account.

1.1 The appellant's request for oral proceedings pursuant to Article 116(1) EPC is auxiliary to their main request (1) that the decision under appeal be set aside and that the case be remitted to the opposition division.

1.2 The respondent's request for oral proceedings is auxiliary to their main request that the appeal be dismissed and to their auxiliary request that the Board when remitting the case to the opposition division does not take any decision on the compliance with the requirements of Article 83 EPC of any of the sets of claims relied upon or filed by the appellant.

1.3 Thus, since the case is remitted to the opposition division for further prosecution in accordance with the appellant's main request (see point 1.1 above) and because this decision does not deal with the issue of compliance with the requirements of Article 83 EPC on the merits, as requested by the respondent (see point 1.2 above), both parties' auxiliary requests for oral proceedings remain inactive.

2. The impugned decision

2.1 The relevant passages of the decision under appeal related to the issue of sufficiency of the claims of the patent as granted, corresponding to the then main request, read as follows:

"The subject-matter of the patent in suit is directed to an outer blade for an electric shaver having hair raising bars with a very specific cross-sectional geometry, in particular the shape of the connection between the skin contact surface (45a) and the inner side surface (45c).

The description provides detailed description of embodiments for any combination disclosed in the claims, i.e. the skin contact surface (45a) being connected to the inner inclined surface (45c) by a single line or a plurality of line segments or by a line and an arc or by a plurality of lines and arcs or by a plurality of arcs wherein the line segments have certain angles with the respective connecting surfaces (45a and 45c) and/or the arcs have different centers and/or curvatures. The patent in suit as a whole is however silent about how any of the claimed cross-sectional geometries of the hair raising bar could be achieved either experimentally or by mass production.

Bearing in mind the special cross-sectional geometry of the hair raising bar and the actual size thereof (µm) none of the common metal processing procedure at the date of the priority, like stamping, grinding, punching, die casting, coining or etching appears suitable for achieving the geometry with the specific parameters as set forth in the claims.

The Opposition Division is therefore of the opinion that the patent in suit is not disclosed sufficiently clear and complete for a skilled person to carry out at least one of the embodiments covered by the claims."

The negative decision on the then auxiliary requests was based on the above assessment related to the then main request and was formulated as follows:

"The auxiliary requests 1 to 4 filed with letter of 03.02.2017 do not address the issue relating to Article 83 EPC and thus none of these auxiliary requests overcomes the insufficiency of disclosure of the patent as a whole.

The auxiliary requests 5 to 7 were submitted during the oral proceedings, in response to the decision of the Opposition Division with respect to Article 83 EPC.

The ground of opposition relating to the insufficiency of disclosure (Art. 83 EPC) was present on file as from the Notice of Opposition and thus requests 5 to 7 filed during the oral hearing and addressing Article 83 EPC are considered as late filed and thus not allowed into the proceedings (Art. 114(2) EPC).

Furthermore, it is to be noted that the insufficiency of disclosure issue concerns the patent/application as a whole and not the disclosure of the claims alone. Thus, amending the set of claims cannot be considered as an appropriate measure for overcoming an issue relating to the insufficiency of disclosure."

2.2 The conclusion of the opposition division, that the claimed invention was not sufficiently disclosed, was based on the hypothesis that no known manufacturing technique was suitable for achieving the features specified in the claims (see point II above).

Said unsuitability was justified by a further hypothesis, namely that the claimed features had very small dimensions (in the range of some µm, see again point II above).

3. Lack of reasoning - Rule 111(2) EPC

3.1 The Board fully concurs with the view of the appellant that the impugned decision was not reasoned within the meaning of Rule 111(2) EPC.

This is because no explanation was given in relation to the following crucial points:

(i) why the cross-sectional geometry of the claimed hair raising bars necessarily had very small dimensions (in the range of some µm), **in spite of the fact that no dimensions were given in the claims,**

(ii) why the manufacturing techniques identified in the appealed decision as "conventional" were unsuitable for achieving the allegedly microscopical features specified in the claims.

3.2 According to the established jurisprudence (see the Case Law of the Boards of Appeal, 9th edition 2019, III.K.3.4.3 and III.K.3.4.4) a decision should consider the essential facts, evidence and arguments in detail and contain the logical chain of reasoning which led to the conclusion drawn.

Even if "reasoning" does not mean that any argument submitted by any party should be dealt with in detail, as a rule, the reasons for a decision are inadequate if a reader had to reconstruct or even speculate as to why a negative decision was taken.

This is presently the case, because the "logical chain of reasoning" of the appealed decision is based on two hypothetical considerations which had to be motivated by the opposition division, because are not self-evident, and were not.

3.2.1 The respondent argues in its letter dated 10 June 2020 that the statement that the claimed features had very small dimensions (in the range of some µm) was self-evident to a skilled person, **in spite of the fact that no dimensions were given therein**, and did not therefore need any further explanation in the appealed decision.

This was because larger geometrical features would necessarily have resulted in a thicker outer blade, which would then have prevented the shaver from fulfilling its function of cutting the hair close to the skin.

The opposition division also did not need to give detailed reasons explaining why the geometrical features have very small dimensions, because it was not contested by the appellant that these were the typical dimensions in this technical field.

3.2.2 The Board disagrees, because the rejected claims are not formulated in a manner as to be restricted to such microscopical embodiments, and also because there is no evidence on file supporting the allegation that increasing the dimensions of the claimed geometrical features would have prevented the claimed electric shaver from providing an acceptable shaving performance (see the statement setting out the grounds of appeal, point 2.2.3 d).

3.3 Furthermore, the opposition division's conclusion that no manufacturing technique at all was available at the priority date for achieving the features specified in the claims being a "negative" claim, can also not be taken for self-evident, because the indication of concrete examples of unsuitable techniques cannot demonstrate that no suitable techniques exist at all.

3.4 As the appealed decision does not contain any motivation on the above identified crucial points, and these points were disputed between the parties (see the minutes of oral proceedings) the reasons thereof are not in line with the general principle of good faith and fair proceedings, and therefore deficient.

3.5 The respondent puts forward that the impugned decision was reasoned because it contained the following statement:

"The patent in suit as a whole is however silent about how any of the claimed cross-sectional geometries could be achieved either experimentally or by mass production." (see point 2.1 above).

In such a situation, it was upon the patentee-appellant to show that the common general knowledge of the skilled person was sufficient to put the invention into practice.

According to the *ratio decidendi* of T 63/06 (*supra*), so the respondent, the burden of proof on sufficiency was on the appellant, who failed to offer any evidence of the existence of a suitable process that was both common general knowledge and capable of making the claimed outer blade.

3.6 This position of the respondent cannot be shared by the Board for the following reasons.

The *ratio decidendi* of T 63/06 (supra, Reasons point 3.3) provides guidance for examining whether an opponent arguing lack of sufficiency has discharged its burden of proof.

According to this decision there could be circumstances in which a weak presumption exists that the invention is sufficiently disclosed. In such a case, the opponent can discharge his burden by plausibly arguing that common general knowledge would not enable the skilled person to put this feature into practice. It is then up to the patent proprietor to prove the contrary, *i.e.* that the skilled person's common general knowledge would enable him to carry out the invention.

T 63/06 does not therefore lift or relax in any way the requirement, set out in Rule 111(2) EPC, that decisions of the departments of the EPO should be reasoned.

As already discussed, the opposition division failed to provide any discussion to support the two hypotheses on which the impugned decision was based (see point 1 above).

The statement, identified by the respondent, according to which the impugned patent alone does not explain how the claimed cross-sectional geometries could be achieved, does not explain why these features have dimensions in the range of some µm or why no known manufacturing technique was suitable for achieving them.

4. The reasoning of the appealed decision is additionally considered deficient because the appellant's argument that there were further manufacturing techniques (e.g. laser cutting, sintering and deburring) with wich manufacturing of the claimed geometrical shapes would have been possible, was discussed during oral proceedings, as reflected in the minutes thereof (see

page 2, second paragraph), but was not dealt with in the reasons.

5. Procedural violation - Main request of the respondent

Having reviewed the impugned decision the Board finds that the appellant has convincingly demonstrated that the appealed decision on the issue of sufficiency of disclosure is not reasoned in accordance with Rule 111(2) EPC.

This amounts to a substantial procedural violation because a fundamental procedural right of the appellant has been violated.

Because of this substantial procedural violation the appealed decision has to be set aside, and the main request of the respondent, namely that the appeal be dismissed, cannot be allowed.

6. Reimbursement of the appeal fee

As a further consequence of the above assessed substantial procedural violation, the Board also decides that the reimbursement of the appeal fee, as requested by the appellant, is equitable, according to Rule 103(1)(a) EPC.

7. Remittal

Rule 111(2) EPC gives parties to EPO proceedings a fundamental procedural right to be provided with the reasons for a decision.

Lack of compliance therewith is considered by the Board as a fundamental deficiency occurred during opposition

proceedings within the meaning of Article 11, second sentence, RPBA 2020.

Such a fundamental deficiency is considered by the Board as "special reason" within the meaning of Article 11 RPBA 2020, which justifies a remittal to the opposition division for further prosecution, in accordance with Article 111(1) EPC.

The Board whishes to clarify that such a fundamental deficiency is not a minor defect, limited to the formulation of the reasons appealed decision, which was taken on a sound procedural basis and correct in substance, as argued by the respondent.

Furthermore, the fundamental deficiency in the decision under appeal as discussed in points 3 and 4 above also prevented the Board from any meaningful review of the opposition division's findings on the merits of the case as to whether or not the requirements of Article 83 EPC are met by any of the appellant's requests.

8. Further requests of the respondent

8.1 By way of supplementary requests (see page 4 of the respondent's letter dated 10 June 2020 and point VI above), the respondent requested specific terms of the order of the present decision.

8.2 These requests cannot be allowed for the following reasons:

8.2.1 In accordance with Article 111(2), first sentence, EPC the opposition division to which the case is remitted

shall be bound by the *ratio decidendi* of the present decision in so far as the facts are the same.

8.2.2 For the reasons given in point 6 above, it is for procedural reasons that the case is to be remitted to the opposition division for further prosecution in accordance with Article 11 RPBA 2020. The present decision only establishes that a fundamental procedural right of the appellant has been violated because the decision settling the first instance proceedings was not reasoned. Since the case is to be remitted to the department of first instance **without consideration of the substantive issues**, the *ratio decidendi* of the present decision neither concerns the substantive aspects of sufficiency of disclosure, nor any issue of patentability. Therefore, the present decision does not have any binding effect so far as substantive issues are concerned.

8.2.3 Hence, the opposition division cannot be ordered to limit the prosecution on substantive issues or to follow specific procedural steps.

8.2.4 Further, since the decision of the opposition division is to be set aside, the opposition division will not be bound by it.

8.2.5 The Board also does not see how, by remitting the case to the opposition division, which will then have to take a **reasoned decision** on the requests of both parties, the appellant may be given an unfair procedural advantage over the respondent.

8.3 The respondent's supplementary requests are therefore refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the opposition division for further prosecution.

3. The reimbursement of the appeal fee is ordered.

The Registrar: The Chairman:

G. Nachtigall I. Beckedorf

Decision electronically authenticated