

Internal distribution code:

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

**Datasheet for the decision
of 2 May 2022**

Case Number: T 1615/20 - 3.2.07

Application Number: 12006457.1

Publication Number: 2647488

IPC: B29C51/14, B29C51/34,
B29C70/04, A45C5/02

Language of the proceedings: EN

Title of invention:

Process for making a plastic component from self-reinforced thermo-plastic material and plastic component produced by this process

Applicant:

Samsonite IP Holdings S.à r.l.

Headword:

Relevant legal provisions:

EPC Art. 83, 113, 116

EPC R. 100(2)

RPBA 2020 Art. 12(8)

Keyword:

Decisions cited:

T 2196/15

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 1615/20 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 2 May 2022

Appellant: Samsonite IP Holdings S.à r.l.
(Applicant) 13-15 Avenue de la Liberté
1931 Luxembourg (LU)

Representative: J A Kemp LLP
80 Turnmill Street
London EC1M 5QU (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 9 December 2019
refusing European patent application No.
12006457.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman I. Beckedorf
Members: S. Watson
A. Pieracci

Summary of Facts and Submissions

I. An appeal was filed by the applicant (appellant) in the prescribed form and within the prescribed period against the decision of the examining division refusing European patent application No. 12 006 457.1.

II. In its decision the examining division found that claims 1 and 18 of the main request as well as claim 1 and the independent product claims of the then four auxiliary requests did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 83 EPC).

III. The final requests of the appellant are

that the decision under appeal be set aside and
that a patent be granted on the basis of the set of claims according to either the main request re-filed with the statement setting out the grounds of appeal, or one of the sets of claims of the first to fifth auxiliary requests filed with the statement setting out the grounds of appeal, whereby the second to fifth auxiliary requests correspond to the first to fourth auxiliary requests decided upon in the decision were first submitted with letter dated 22 July 2019;
alternatively, if the Board finds the requirements of Article 83 EPC are fulfilled,
that the case be remitted to the examining division for further prosecution.

IV. In response to a communication from the Board pursuant to Rule 100(2) EPC, the appellant clarified with letter of 25 April 2022 that its request to hold oral proceedings was subordinate to its request to remit the case to the examining division for further prosecution.

V. Independent claim 1 of the main request reads as follows:

"A process for producing a plastic luggage shell, said luggage shell comprising areas of high degree of form change, such as integrally formed corner regions, curves or bends at an intersection between main surfaces of the luggage shell, said process comprising:

- providing a lamina (4) of self-reinforced thermoplastic material,
- tensioning the lamina or areas thereof by controlling gripping means (31, 32) which grip edges (8) of the lamina (4) to pull and move the gripped edges (8), and
- press-forming the lamina (4) to form the luggage shell."

VI. Independent claim 18 of the main request reads as follows:

"Luggage shell manufactured from self-reinforced thermoplastic material according to the process of any one of the preceding claims, said luggage shell comprising a nominal thickness of 0.8 mm to 3.0 mm and/or comprising a pattern of alternating concave and convex shapes (5a, 5b)."

VII. In light of the decision taken, it is not necessary to reproduce the independent claims of the auxiliary requests here.

VIII. The lines of argument of the appellant are dealt with in detail in the reasons for the decision.

Reasons for the Decision

Decision in written proceedings

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 and with Articles 113 and 116 EPC.

The appellant clarified in its response to the Board's communication pursuant to Rule 100(2) EPC that oral proceedings pursuant to Article 116(1) EPC are requested as an auxiliary measure only in the event that the Board orders neither a grant of a patent nor a remittal of the case to the examining division on the basis of the appellant's main request, decided upon in the decision under appeal and re-filed with the statement setting out the grounds of appeal.

Since the appellant's main request is followed by the Board, the aforementioned auxiliary request for oral proceedings remains procedurally inactive.

Main request - sufficiency of disclosure - (Article 83 EPC)

2. The current application is a divisional application of European patent application No. 05 731 027.8 (parent). After grant, the parent was opposed and revoked by an opposition division on the basis of lack of sufficiency. The decision of the opposition division

was confirmed by a technical Board of Appeal in decision T2196/15.

3. The examining division found that the current application did not fulfil the requirements of Article 83 EPC as the step of "press-forming the provided lamina of self-reinforced thermoplastic material to form the luggage shell" could not be carried out by the skilled person (see the decision under appeal, points 26 and 27).
According to the examining division, the only example of press-forming of self-reinforced thermoplastic materials given in the application was deep-drawing and this example did not form part of the common general knowledge of the relevant skilled person, according to decision T2196/15.
The skilled person would have to exercise inventive skills in carrying out the step of press-forming "otherwise than via deep drawing" because it was not known how to "effectively press-form an oriented/self-reinforced complex structure such as the claimed lamina in order to provide areas with high degree of form change" in particular as the lamina was made of already drawn thermoplastic material.

4. It is established case law that a finding of lack of sufficient disclosure should be based on serious doubts, substantiated by verifiable facts (CLB, 9th edition, 2019, II.C.9.). In ex-parte cases it is up to the examining division to substantiate the objection raised (CLB, *supra*, III.G.5.1.2.c)).

In the present case, the Board agrees with the appellant that the examining division has not substantiated its doubts relating to lack of sufficiency of disclosure with verifiable facts.

5. The examining division's first finding, that deep drawing does not form part of the skilled person's common general knowledge was based entirely on decision T2196/15. The examining division cited only one passage of the decision, namely Reasons 2.4.

In this section of its decision, the Board of Appeal found that it had not been established by the patent proprietor that deep-drawing of self-reinforced thermoplastic composite (SRTC) materials formed part of the common general knowledge of the skilled person.

The Board notes that it is established case law that the procedure concerning a divisional application is, in principle, independent from the procedure concerning the parent application. From this also follows that evidence filed in the parent procedure does not automatically form part of the divisional procedure (see Case Law of the Boards of Appeal (CLB), *supra*, II.F.4.1.). The examining division did not base its decision on any of the evidence given in the parent appeal case.

- 5.1 As argued by the appellant (statement of grounds of appeal, point 6.), as neither claim 1 nor claim 18 in the present case includes the feature of "deep-drawing" the findings of decision T2196/15 do not directly relate to the present application.

The examining division reasoned (see decision under appeal, points 21 to 25) that as the only example of press-forming provided in the application documents was deep-drawing, that the finding of the technical Board of Appeal in T2196/15 applied also to the subject-matter of claims 1 and 18.

The Board, however, agrees with the appellant (see statement of grounds of appeal, point 6.3), that press-forming is an expression known to the skilled person from their common general knowledge and is not synonymous with deep-drawing.

As the appellant argues (see statement of grounds of appeal, point 6.4), the skilled person when reading claim 1 does not consider that any particular depth of deformation must be achieved in press forming the lamina, whereas deep drawing would require the finished component to have a significant depth.

- 5.2 The examining division reasoned that "deep drawing" was the "core" of the invention (see decision under appeal, point 25) and indicated passages of the description where deep-drawing and press-forming are mentioned.

The Board however agrees with the appellant that only features which are found in the claims are to be considered for the purpose of sufficiency of disclosure (see statement of grounds of appeal, point 9). The passages of the description cited by the examining division may show that one of the intended effects of the process was to be able to produce deep drawn luggage shells. However, neither claim 1 nor claim 18 includes this effect. It is established case law that lack of sufficiency of disclosure cannot be based on an argument that the skilled person cannot achieve a technical effect, if this effect does not form part of the claim (see CLB, *supra*, II.C.3.2).

6. The examining division's second finding, that the skilled person did not know how to "effectively press-form an oriented/self-reinforced complex structure such

as the claimed lamina in order to provide areas with high degree of form change" in particular as the lamina was made of already drawn thermoplastic material (see decision under appeal, point 26), is unsubstantiated.

The Board follows the arguments of the appellant, that the step of press-forming as such is a conventional production step, well known to the skilled person (see statement of grounds of appeal, point 10).

In the absence of verifiable facts, the examining division has not shown that the skilled person was unable, on the basis of the application documents and their common general knowledge, to press-form self-reinforced thermoplastic material.

7. Thus the appellant has convincingly shown that the examining division's findings relating to lack of sufficiency regarding the step of press-forming of lamina of self-reinforced thermoplastic material were incorrect.
8. As the Board finds the decision can be set aside on the basis of the main request it is not necessary to consider the auxiliary requests.

Remittal

9. The Board notes
 - that no further requirements for patentability were mentioned or examined in the contested decision;
 - that the appellant has not presented any arguments relating to the further requirements for patentability;and

- that the appellant explicitly requested that the case be remitted to the examining division (see statement of grounds of appeal, 3.4).

As there are no substantive arguments present in the appeal proceedings relating to any patentability issues other than Article 83 EPC, the Board cannot come to a decision regarding further patentability requirements on the basis of the current appeal case alone.

10. The Board is aware that, according to Article 11, first sentence, RPBA 2020, a remittal for further prosecution should only be undertaken, exceptionally, when special reasons apply.
11. Against this background, after considering all the relevant circumstances of the case at hand, the Board comes to the conclusion that the issues relevant to patentability in the present case, including but not limited to, the examination of added subject-matter, novelty, inventive step and clarity, could not be decided upon without undue burden (cf. explanatory notes to Article 11 RPBA 2020, Supplementary publication 2 - OJ EPO 2020, 46, 54).
12. Consequently, the Board is convinced that there are special reasons within the meaning of Article 11, first sentence, RPBA 2020 that apply, and that it is appropriate to remit the present case to the examining division for further prosecution and examination of the further patentability requirements, in accordance with Article 111 (1) 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.**

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated