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File Number: T 204/90 - 3.2.2
Application No.: 85 901 128.0
Publication No.: WO 85/03880
Title of invention: Breathing Apparatus

Classification: A61M 16/00, A61M 15/00, A61M 16/10

D E C I S I O N
of 30 July 1991

Applicant: Lindholm, Nore

Headword:

EPC Article 84

Keyword: "Functional features" - "Interpretation of the Guidelines C-III,
4.7"

Headnote



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Boards of Appeal

Chambres de recours

Case Number : T 204/90 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 30 July 1991

Appellant : Lindholm, Nore
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Decision under appeal : Decision of Examining Division 128 of the
European Patent Office dated 13 September 1989
refusing European patent application
No. 85 901 128.0 pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : G. Szabo
Members : P. Dropmann
M. Schar

Summary of Facts and Submissions

- I. European patent application No. 85 901 128.0 filed on 22 February 1985 as an international application No. PCT/SE 85/00088 and published under the international publication No. WO 85/03880 was refused by the Examining Division in a decision dated 13 September 1989. The decision was based on Claim 1 filed with the letter of 12 June 1989.

- II. The reason given for the refusal was that Claim 1 offended against Article 84 EPC in that it lacked clarity. In this respect it was in particular pointed out that the subject-matter of Claim 1 was partly defined not in terms of structural features but merely by the result to be achieved, and partly defined by reference to an external element, i.e. the mouth. As to the definition of features by the result to be achieved, reference was made in the decision to part C-III, 4.7 of the Guidelines for Examination in the European Patent Office.

In the decision, no opinion as to patentability under Article 52(1) EPC was given.

- III. A Notice of Appeal was filed against this decision on 10 November 1989, the appeal fee being paid on the same day. The Statement of Grounds of Appeal was received on 19 January 1990.

- IV. Following a telephone conversation between the Appellant's Representative and the Rapporteur, the Appellant filed an amended Claim 1 with his letter of 25 July 1991.

This claim reads as follows:

"Breathing device (10) which is intended to be placed and held in the mouth of a person and which comprises a tubular casing (13) and positioned therein a plurality of parallel channels (12) open at each end, the casing having a proximal open end opposite to a distal open end, the proximal end of the casing being concave and being provided thereon with two outwardly and laterally jutting gripping flanges (15, 16) extending in opposite directions, the gripping flanges extending at such an angle from the casing and being so dimensioned as firstly to enable the device to be moved by the facial muscles and/or the tongue from an operative position, in which the flanges are located inwardly of the jaws or teeth relatively far back in the oral cavity, to a speaking or swallowing position, in which the device is held forwardly of the jaws or teeth, and to be returned to the operative position by the facial muscles and alternatively also the teeth; secondly to enable the person to hold the device firmly in the speaking or swallowing position by an interaction between the gripping flanges and the soft parts of the mouth, such as the cheeks or lips; and thirdly to permit the jaws to be substantially closed when the device is in the speaking or swallowing position."

- V. The Appellant requests that the decision under appeal be set aside, on the basis of amended Claim 1. In addition, he requests that the case be remitted to the Examining Division for further prosecution.

Reasons for the Decision

- 1. The appeal is admissible.

2. **Amendments**

The basis for the features of the amended Claim 1 is to be found on page 2, line 9 to page 3, line 4 and pages 5 to 8 of the description as originally filed, in the original Claim 1 and in the figures. In particular, the feature that the proximal end of the casing is concave is disclosed in Figures 1 and 3.

There is therefore no objection to Claim 1 under Article 123(2) EPC.

3. **Clarity**

3.1 Claim 1 comprises structural features (e.g. tubular casing, channels, gripping flanges on the proximal end of the casing) as well as features defined in terms of a result to be achieved, i.e. functional features (e.g. the gripping flanges being so dimensioned as firstly to enable the device to be moved between two positions ...; secondly to enable ...; and thirdly to permit ...).

There cannot be any doubt that the structural features are now clear in the sense of Article 84 EPC. Thus, the question is whether or not the functional features meet the requirement of this Article in this respect.

3.2 According to the established case law of the Appeal Boards of the European Patent Office, technical features may be defined functionally in appropriate cases. In the basic decision T 68/85, "Synergistic herbicides", OJ EPO 1987, 228 (cf. in particular points 8.4.1 to 8.4.3), it has been held that functional features defining a technical result are permissible in a claim if

(i) from an objective viewpoint, such features cannot otherwise be defined more precisely without restricting the scope of the invention, and

(ii) these features provide instructions which are sufficiently clear for the expert to reduce them to practice without undue burden, if necessary with reasonable experiments.

Of course, it stands to reason that such claim drafting is only allowable if

(iii) the state of the art does not stand in the way of using such functional and therefore general and broad terminology.

As far as criterion (iii) is concerned, it should be borne in mind that functional features represent a generalization of the teaching, since the scope of protection is extended to all means providing the same effect, whilst the specifically disclosed means within its scope only represent examples.

3.3 In the present case, the Board is satisfied that condition (i) mentioned above is fulfilled.

3.3.1 Indeed, the Board does not see how the variations in shape and size of the gripping flanges and the angle at which the flanges extend from the casing could be defined more precisely than has been done in Claim 1 without unduly restricting the scope of protection and thereby excluding many cases where the device is needed.

3.3.2 In the decision under appeal the Examining Division was of the opinion that the flanges could be defined by their form, their relative dimensions and their position on the

casing and that, for instance, they could be defined as being planar, forming an angle with respect to the direction of the channels of x to y degrees and having a length proportional to the width of the casing at the end adjacent the flanges.

In this respect, the Examining Division referred to the Guidelines C-III, 4.7 which state that claims which attempt to define the invention, or a feature thereof, by a result to be achieved may be allowed if the invention can only be defined in such terms and if the result is one which can be directly and positively verified by tests or procedures adequately specified in the description and involving nothing more than trial and error.

- 3.3.3 The Board takes the view that the above mentioned part of the Guidelines is to be interpreted in the light of the above quoted principles of decision T 68/85 (ibid.) when deciding on the permissibility of functional features. This means that full attention is to be paid to the aspects of not restricting the scope of the invention unfairly and of proper protection. It is the legitimate desire to couch the invention in the most general terms possible in order to secure adequate and reasonable protection (cf. point 8.4.1 of said decision).
- 3.3.4 The definition of the form, dimensions and position of the flanges in the way suggested in the decision under appeal would limit the scope of the invention and restrict its protection in an unjustifiable manner. Having regard to the nature of the present invention, and to give it a fair protection, it is only possible to define the invention by using functional features in the claim.
- 3.4 Furthermore, the Board is of the opinion that the second clarity requirement (ii) mentioned above is met in the present case.

3.4.1 The functional features of Claim 1 provide instructions as to the angle, size and shape of the gripping flanges, which instructions are sufficiently clear for the expert to reduce them to practice without undue burden, e.g. if necessary by means of reasonably simple experiments. According to these features the gripping flanges, on the one hand, must not be so large as to render impossible the movements from a position of the flanges inwardly of the jaws or teeth to a position forwardly of the jaws or teeth and vice versa and, on the other hand, must not be so small that the device cannot be held firmly in the speaking or swallowing position defined in Claim 1.

The shape of the device shown in Figures 1 and 3 of the drawings, as well as other apparent details thereof, give an adequate starting point for the skilled person to adjust dimensions in order to satisfy various requirements. There is no difficulty therefore to provide a wide range of variants falling within the scope of the functional requirements and of Claim 1. There is no lack of clarity on the basis of insufficiency of disclosure.

3.4.2 The Examining Division also raised the objection that the movement between the two positions merely depended on the action and the skill of the user rather than on the shape and dimensions of the flanges. Of course, the skill of the user plays a certain role when moving the device without using the hands. However, the claim, which contains the functional features and thus defines the size and shape of the flanges in general and broad terms, is directed at any person. If, therefore, there is a device in the prior art which has the structural features of Claim 1 and can be moved and held as specified in the claim by any person at all, then such a device would fall within its scope. This is the risk the applicant takes when defining the subject-matter partly by using the functional features set out in Claim 1.

- 3.5 Criterion (iii) mentioned above does not concern clarity. It will have to be considered by the Examining Division during further prosecution of the case.
- 3.6 In the decision under appeal the Examining Division furthermore objected to the features that the channels have an end opening outside the oral cavity when the device is in use, that the channels are co-directional with the direction of the inspiration and expiration gases engendered by the user and that one end of the casing obtains a shape complementary to the front portion of the jaws.

These features no longer appear in the amended Claim 1. The claim accordingly does not lack clarity in this respect.

- 3.7 It follows from the preceding statements that, in the view of the Board, Claim 1 as filed on 25 July 1991 is clear and accordingly meets the requirements of Article 84 EPC in this respect.

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 on the basis of the amended Claim 1 and the dependent claims, description and figures as on file.

The Registrar:



N. Maslin

The Chairman:



G. Szabo