

**Decision of Technical Board of Appeal 3.2.1 dated 25 February 1997**

**T 136/95 - 3.2.1**

(Translation)

Composition of the board:

Chairman: F. Gumbel

Members: M. Ceyte

J. Van Moer

S. Crane

B. Schachenmann

**Patent proprietor/Respondent: Justamente, Raphaele**

**Opponent/Appellant: Transordures**

**Headword: Waste compactor/JUSTAMENTE**

**Article: 54, 56, 87(1), 88(3), 88(4) EPC**

**Keyword: "Structural feature claimed in the European application, based on a more general functional feature described in the prior application" - "Priority validly claimed (yes)"**

*Headnote*

*It is necessary to give some flexibility to the requirement for identity of invention between a subsequent European application and a previous application from which*

*priority is claimed. Some features claimed in the European application need not be explicitly mentioned in the prior application, provided that the skilled person is able, purely on the basis of his knowledge or by performing simple operations to carry out the invention, to infer these features from the prior application (point 3.3 of the Reasons).*

### **Summary of facts and submissions**

I. The respondent is proprietor of European patent No. 0 251 945, claiming priority from patent application No. 86 09 412 filed in France on 25 June 1986.

II. The appellants filed notice of opposition requesting revocation in full of the European patent.

As an argument against patentability, they cited a prior use said to have occurred between the priority date and the date of filing of the European patent application.

III. By a decision posted on 8 December 1994, the opposition division maintained the European patent in amended form.

In its decision, the opposition division took the view that claim 1 was entitled to the claimed priority, and that the prior use cited by the opponents was therefore not prior art citable against the claimed invention.

IV. By a letter received on 30 January 1995, the appellants (opponents) appealed against this decision, paying the requisite fee on the same date.

The duly filed statement of grounds for appeal cited the following document, which was quoted and analysed in the contested European patent:

D1: WO-A-81/01 398.

V. In reply to a communication from the board, noting that claim 1 of the patent in suit did not meet the formal requirements of Rule 29(1) EPC, the appellants filed a claim 1 identical to claim 1 as granted.

The claim in question reads as follows:

"1. Process for automatic closure of a package comprising a container provided with flaps directed towards its interior and a lid provided with folds, characterised in that it consists in:

- placing a compressible material (5) inside the container (3);
  
- pressing the lid (1) as well as the compressible material (5) in the container (3), so that the folds (2) of the lid, cut at the corners at an angle greater than 90 °, pass the flaps or rims (4) of the container, which are continuous at the corners and discontinuous between the corners, in order to press said folds (2) elastically against the inside wall of said container;
  
- and allowing the compressed material (5) to recover its volume naturally to push the lid (1) back upwards, so that its folds (2) are definitively locked under the flaps or rims (4) of the container (3)."

VI. Oral proceedings, attended by both parties, took place on 25 February 1997.

The appellants (opponents) requested that the contested decision be set aside and the European patent in suit be revoked in its entirety.

They developed the following line of argument to support their case:

(i) Claiming priority

To be entitled to priority, the European patent had to have as its subject-matter the same invention as the previous application.

This was not so in the case in point, since the claimed feature, according to which the folds were cut at an angle greater than  $90^\circ$ , was not mentioned in the previous application, nor was it shown in the drawings. The opposition division maintained that this feature was crucial because, without it, it was impossible to fit the edges of the folds on the lid into the corners of the flaps. This feature therefore had to be considered to be implicitly contained in the priority document.

An analysis of this kind was based on a posteriori reasoning, knowledge being assumed of the contents of the European patent in suit, which specifically stated that if the angle of cutting were  $90^\circ$ , the folds would touch after folding and could not be passed under the flaps, especially in the corners.

The previous application related to an abstractly conceived invention which was therefore not completed; only when it was actually realised was the inventor able to establish that the intended result, ie the effect of automatic closure without manual intervention, could only be achieved if the angle of cutting was greater than  $90^\circ$ . The inventor therefore added this feature, which was essential to the functioning of the claimed process, in the subsequent European application. From this, it followed that the feature in question was not expressly disclosed by the previous application, nor was it directly and unambiguously inferrable from the latter document.

Claim 1 was therefore not entitled to the priority conferred by the previous French application, and the prior use occurring after the supposed priority date and before the date of filing of the contested European patent may therefore be cited as prior to the claimed invention.

(ii) Validity of the subject-matter of claim 1 in the light of D1

Document D1 was quoted and analysed in the European patent in suit. The amended claim 1, on which the contested decision was based, was limited with regard to this state of the art.

Claim 1 of the patent in suit contained no limitation of scope in respect of the fact that the automatic closure had to occur inside the compressing apparatus; it therefore covered any process for automatic closure of a package comprising a container provided with flaps directed towards its interior and a lid provided with folds.

D1 described a package of this type in which the container flaps were continuous at the corners and discontinuous between the corners, the folds of the lid being, for a hexagonal package, cut at an angle greater than  $60^\circ$ ; for a four-sided package, this angle would obviously have been greater than  $90^\circ$ .

This essentially disclosed the claimed process for automatic closure of the lid, apart from the fact that the lid in D1 (Figs. 22 to 24) corresponded to the claimed container and the container in D1 to the claimed lid, and that there was no mention of the presence of a compressible material inside the package.

The mere inversion of lid and container was an operation that could easily be carried out by a skilled person, who would be bound to hit upon the claimed process if he wished to package a compressible material.

The subject-matter of claim 1 did not therefore show the required inventive step.

VII. The respondent (patent proprietor) argued that all the features of claim 1 were disclosed almost verbatim in the prior application, apart from the value of  $90^\circ$  for the

angle. In the case of a rectangular lid, the cuts could not fulfil their function, specifically defined on page 4, lines 10 to 12, of the prior application, unless their angle at the top was greater than  $90^\circ$ . The value for the angle of cutting was therefore clearly apparent from the content of the prior application.

The respondent also submitted that the lack of an inventive step with regard to the subject-matter of claim 1 had not been cited by the appellants in the opposition proceedings. In the notice of opposition, it was said that the subject-matter of claim 1 lacked novelty vis-à-vis the cited prior use, and the notice indeed only mentioned lack of an inventive step in connection with the subject-matter of claim 3. The appellants cited D1 for the first time in the appeal.

The lack of an inventive step therefore constituted a fresh ground for opposition within the meaning of the opinion of the Enlarged Board of Appeal in G 10/91 (OJ EPO 1993, 420). It was not a purpose of appeal proceedings to examine grounds for opposition on which the decision of the opposition division was not based. This would be the case if the question of inventive step were to be examined with regard to D1. The respondent (patent proprietor) was therefore opposed to such examination, which would be contrary to the spirit of the Convention and to the case law of the Enlarged Board of Appeal.

The respondent requested that the appeal be dismissed and the European patent maintained on the basis of the claims filed by letter of 17 November 1995 (main request) and subsidiarily on the basis of one of the requests annexed to its letter of 20 January 1997.

### **Reasons for the decision**

1. The appeal is admissible.

## *2. Admissibility of amendments*

It is established that the amendments to claim 1 fulfil the requirements of Article 123(2) EPC. In particular, the feature concerning the angle of cutting as greater than 90° is based on page 4, lines 5 to 10, and on Fig. 7, showing an angle of 180°. The further features of claim 1 are found notably in claims 1 and 2 as originally filed.

Claim 1 is identical with the granted claim 1. It therefore fulfils the requirements of Article 123(3) EPC.

## *3. Claimed priority*

3.1 The European patent in suit claims priority from French patent application No. 86 09 412, filed on 25 June 1986. Since the alleged prior use, according to the appellants, took place between the priority date and the date of filing of the contested European patent, it is necessary to determine whether the priority was validly claimed. If this is the case, then the alleged prior use does not constitute prior art citable under Article 54(2) EPC.

3.2 As the Enlarged Board of Appeal pointed out in its opinion in G 3/93 (OJ EPO 1995, 18), a subsequent European patent application can only derive priority from a previous first application if the two applications concern exactly the same invention (see also Article 87(1) EPC).

Under Article 88(4) EPC or Article 4, Section H, of the Paris Convention, priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, provided that the application documents as a whole specifically disclose such elements.

The right of priority only covers those elements of the European patent application which are included in the previous application whose priority is claimed (Article 88(3) EPC).

3.3 Article 87(1) EPC does not specifically state that the question whether two applications concern exactly the same invention ("identity of invention") has to be assessed by reference to the skilled person. However, this must be the case: identity of invention is established between two patent applications, the one previous and the other subsequent, and a patent application is a technical document, addressed to the skilled person, not a work intended for the general reader (see *P. Mathély* , *Le droit européen des brevets d'invention*, p. 210).

The skilled person to whom reference must be made for the purpose of assessing identity of invention is the same as the person whose point of view forms the basis for assessing inventive step or deciding whether the description discloses the invention in a sufficiently clear and complete manner (Art. 83 EPC). He possesses a general knowledge of the technical area in question. However, as with the assessment of inventive step, he is not familiar with all the prior art, but only with those elements of it which form part of his general knowledge, and it is on the basis of this knowledge, or by carrying out simple operations derived from it, that he may infer whether or not there is identity of invention.

For the assessment of identity of invention, it cannot be required that every feature claimed in the European patent application be found in identical form in the previous application whose priority is claimed. It is necessary to give some flexibility to the requirement for identity of invention between the two applications (see *G.H.C Bodenhausen* , *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967*, BIRPI, 1969, Article H, Section 4, observation (b)).



Consequently, some features claimed in the European application need not be explicitly mentioned in the previous application whose priority is claimed, provided that the skilled person is able, purely on the basis of his knowledge or by performing simple operations to carry out the invention, to infer these features from the prior application.

3.4 It is necessary to assess whether, in the light of the principles stated above, claim 1 of the European patent in suit is entitled to the claimed priority.

Claim 1 of the patent includes a structural feature according to which the lid of the container is "provided with folds cut at the corners **at an angle greater than 90** °".

The appellants have correctly argued that the highlighted part of this structural feature does not appear in the prior application. Nor does the prior application contain a drawing showing a cut angle greater than 90 ° (Fig. 7 was added to the European patent application). But the prior application does define this structural feature in a more general way, as a functional feature, or, to put it another way, in terms of the desired result, the angle of the cut being selected so as to make the flaps independent of one another and not to keep them folded in a position perpendicular to the base surface of the lid (see page 4, lines 6 to 12, of the previous French application).

As the above passage and the drawings show (Fig. 3), the folds of the lid cut in this way have to be able to assume a position perpendicular to the base surface of the lid within the compacting apparatus.

In the present case, a skilled person familiar with the contents of the original French application but knowing nothing whatever of the European patent in suit would nevertheless have no difficulty in identifying the structural feature concerning the value for the angle of cutting. The skilled person wishing to realise the package according to the original French application would be guided by the functional

feature disclosed therein; he would therefore know that the angles of the folds would have to be cut in such a way that the folds could assume a position perpendicular to the bottom of the lid inside the compacting apparatus. From this general idea he could easily infer that, in order to achieve this effect, the angle of cutting would have to be greater than  $90^\circ$  if the lid were rectangular.

3.5 The appellants have essentially argued that the previous French application contains only the main outlines of the invention, whereas the subsequent European patent was supplemented by a realisation element making it possible to carry out the invention. However, as has already been noted, the skilled person, in the light of his professional knowledge and in particular of simple operations for carrying out the invention, especially - as in the present case - simple operations of folding and cutting a sheet of cardboard, would have no difficulty in identifying this realisation element under the guidance of the teaching in the previous French application.

3.6 Under Article 88(3) EPC, the right of priority can only be accorded in respect of elements in the European patent application which are "included in the application ... whose priority is claimed". This means that the subsequent European patent application is only entitled to the priority of the previous application for those elements which are common to both applications.

All the elements of claim 1 of the European patent in suit, including the features relating to the angle of cutting and the flaps on the container, which are continuous at the corners and discontinuous between the corners (see claim 2 of the prior application), are present in the previous French application, even if the two documents are not identical.

From this, it can only be concluded that the elements of claim 1 are entitled to the claimed priority, and therefore that the alleged prior use, said to have occurred after the priority date of the previous first application, is not to be taken into consideration

in assessing the patentability of the claimed invention.

#### *4. Problem - solution*

4.1 The discussion shows that the closest prior art consists in the process for closing packages described in connection with Fig. 2 of the European patent in suit. The package used is an "American box" of the classic type, made of corrugated cardboard and including upper and lower flaps. First, the lower part is closed with the aid of a self-adhesive strip, then the upper flaps are folded outwards, and the package is placed in a waste compactor fitted with a piston for compressing the waste material inside the box.

At the end of the operation, it is necessary to remove the full container from the compacting apparatus by opening the main aperture, then to fold the upper flaps back on themselves and place a self-adhesive strip over the join between the flaps so as to seal the contents and thereby isolate the compacted waste from the environment.

The technical problem addressed by the European patent in suit consists in remedying this inconvenience, ie in providing a system for automatic closure of the container filled with compressible material without having to remove the container from the compacting apparatus.

4.2 The problem is essentially resolved, in accordance with claim 1, by the following characteristic elements:

(i) the body of the container includes flaps directed towards the interior of the container, the flaps being continuous at the corners and discontinuous between the corners;

(ii) the lid is provided with folds directed outwards, the corners of which are cut at an angle greater than  $90^\circ$ ;

(iii) the process consists in pressing the lid as well as the compressible waste in the container, so that the folds of the lid pass the flaps of the container;

(iv) and in allowing the compressed material to recover its volume naturally to push the lid back upwards, so that its folds are locked under the flaps of the container.

#### *5. Novelty*

The subject-matter of claim 1 is clearly new vis-à-vis D1, since the latter document, as explained below, does not describe any of the features (i) to (iv) listed above.

From this, it follows that the subject-matter of claim 1 is new vis-à-vis this state of the art.

#### *6. Question of whether the board is authorised to examine for lack of an inventive step*

The respondent (patent proprietor) has argued that the allegation that the subject-matter of claim 1 lacked an inventive step, raised for the first time by the appellants in their statement of grounds for appeal, constitutes a fresh ground for opposition within the meaning of the opinion of the Enlarged Board of Appeal in case G 10/91. Moreover, D1, the basis for the allegation of lack of inventive step, had not been cited by the appellants (opponents) during the opposition proceedings.

This being said, it must be remembered that the notice of opposition explicitly claimed that the subject-matter of the European patent was not patentable because it lacked an inventive step.

In the notice, the opponents said that the subject-matter of claim 1 was not new, and the issue of inventive step was indeed only raised in connection with claim 3.

However, it is obvious that the question of inventive step could not be raised in connection with claim 1, since the question cannot arise if the claimed subject-matter is not new.

From this, it follows that the lack of an inventive step cannot constitute a fresh ground for opposition.

7. D1 was quoted and analysed in the European patent in suit. There, it is considered to form part of the closest state of the art, providing the basis for the wording of claim 1 of the patent. In accordance with decision T 536/88 (OJ EPO 1992, 638), this document has to be taken into consideration in the appeal proceedings, even if it was not expressly cited within the opposition period.

#### *8. Inventive step*

Contrary to the appellants' view, the subject-matter of claim 1 does not obviously follow from the teaching of D1.

The latter document describes a package comprising a container and a lid; the body of the container is provided in its upper part with folds directed towards the exterior of the container and cut at certain angles; the lid is provided with flaps directed towards the interior of the lid. Manually fitting the lid on the container produces automatic closure, the flaps of the lid being locked behind the folds of the container.

It must be noted that none of the above-listed features (i) to (iv) of claim 1 are to be found in D1. In particular, none of these features could have suggested themselves to the skilled person, since D1 evidenced no intention whatever of utilising the compressibility of a material placed in the container, such compressible material

enabling the lid to be pushed back upwards so that its folds are locked under the flaps of the container.

The appellants maintain that the lid in D1 corresponds to the claimed container and that the container in D1 corresponds, in turn, to the claimed lid. To derive the claimed invention, it would suffice merely to invert the functions of lid and container.

This being said, it must be noted that the suggested inversion does not make it possible to arrive at the claimed invention, since there is no question in D1 of using a compressible material enabling the lid to be pushed back upwards so that its folds are locked under the flaps of the container. Moreover, nothing in D1 would lead the skilled person to make the suggested inversion. According to the consistent case law of the boards of appeal, the proper question is not what the skilled person might do, but what he definitely would do (see, in particular, T 2/83, OJ EPO 1984, 265). In the absence of a compressible material, the skilled person would have no objective reason for proceeding to such an inversion.

From this, it follows that the subject-matter of claim 1 shows the required inventive step (Article 56 EPC).

This conclusion also applies to claims 2 and 3, which concern particular ways of carrying out the closure process according to claim 1.

9. It must therefore be concluded that the grounds cited for opposition do not prejudice the maintenance of the European patent as amended.

**Order**

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

1. The contested decision is set aside;
2. The case is remitted to the department of first instance with the order to maintain the European patent on the basis of claims 1 to 3 annexed to the letter of 17 November 1995 and of the description and drawings as originally filed.