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D E C I S I O N
of 4 June 2003

Case Number: T 1056/01 - 3.2.2

Application Number: 93909037.9

Publication Number: 0634922

IPC: A61J 9/04

Language of the proceedings: EN

Title of invention:

Drinking vessel suitable for use as a trainer cup or the like

Patentee:

HABERMAN, Mandy Nicola

Opponents:

Playtex Products, Inc.
OMSA Marketing & Sales B.V.

Headword:

-

Relevant legal provisions:

PARIS CONVENTION Art. 4B, C4 and D3
EPC R. 38(3)

Keyword:

"Priority requirements - burden of proof - standard of proof"

Decisions cited:

T 0219/83

Headnote:



Case Number: T 1056/01 - 3.2.2

DECISION
of the Technical Board of Appeal 3.2.2
of 4 June 2003

Appellant: HABERMAN, Mandy Nicola
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 18 July 2001
revoking European patent No. 0634922 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: R. T. Menapace
Members: U. J. Tronser
D. Valle
S. S. Chowdhury
M. G. Noel

Summary of Facts and Submissions

- I. The appeal was lodged by the Patentee (henceforth: appellant) against the Opposition Division's decision to revoke the European patent No. 0 634 922 for lack of novelty over document US-A-5,186,347 (henceforth "D1").
- II. The application underlying the patent in suit was filed on 7 April 1993 claiming priority from UK application 920 77 66 filed on 7 April 1992 which in turn was preceded by UK application 910 73 81 filed on the appellant's behalf with the UK Patent Office on 8 April 1991. A copy of its specification (description and figures) was submitted by the appellant as Exhibit "MJPD.3". Said previous application was mentioned in the list of "Applications Withdrawn, Taken to be Withdrawn, Treated as having been Withdrawn, Refused, or Treated as having been Refused, before Publication under Section 16(1)" as published on 13 May 1992 in The Official Journal (Patents), Number 5382, of the UK Patent Office. That list, which contained only the number of each application concerned, did not state the actual date of withdrawal of the application in question.
- III. Nevertheless during the opposition proceedings the appellant contended that the previous UK application had been withdrawn by a letter filed by her then representative before or on 7 April 1992 with the UK Patent Office.

The Opposition Division found that all the arguments put forward by the appellant in defence of her right of priority, which was contested by two of the three

Opponents, consisted in a series of reasons why her then representative must inevitably have taken the right measure for withdrawing said first application before or on 7 April 1992. The appellant had not been able to provide any concrete proof that her then representative did actually take said measure in time. On the contrary, the only available documents carrying a reference to the withdrawal of said previous UK application 910 73 81 were the copy of a letter of withdrawal dated 9 April 1992 of her then representative (filed as "Exhibit MJPD.2") and the copy of her representative's register folio No. 51604, which shows the entry:

"Case abandoned withdrawn on 9/4/92" (Exhibit MPJD.12).

Thus the available evidence rather pointed in the direction that the UK application 910 73 81 was not withdrawn in time for the purposes of Article 87(4) EPC. Therefore, the subsequent application UK 920 77 66, which was for the same invention as the previous one, could not be considered as the first application as required by Article 87(1) EPC and the priority claimed from the later application was not valid. As a consequence Document D1 published on 16 February 1993, i.e. before the filing date of the application underlying the patent in suit, namely on 7 April 1993, constituted prior art pursuant to Article 54(2) EPC. It was evident that the beverage container described in D1 disclosed all the features of claim 1 of the patent in suit as granted, which therefore lacked novelty; the same was held true for the appellant's auxiliary request which was based on the same unamended claim 1.

IV. In support of its appeal the appellant essentially argued as follows:

The allegation of the invalidity of the priority claim was made first by Opponent 01, who withdrew its opposition after having lost infringement litigation in the UK.

If a material fact is not or cannot be proven, a decision must be taken on the basis of the relevant burden of proof, with the result that the fact that the real position cannot be established operates to the detriment of the party which carries the burden of proof for this fact. The appellant referred to decision T 219/83 which held that as a matter of principle the patent proprietor is given the benefit of the doubt if the parties made contrary assertions regarding facts barring patentability, which they cannot substantiate and the EPO is unable to establish the facts of its own motion. Furthermore, it followed from decision T 382/93 that the opponents should bear the burden of proof in this respect both in the first and the second instance, with the result that the same principles should be applied in the present case where the relevant official file at the UK Office has been destroyed (as is usual five years after withdrawal of an application).

At any event, the following conclusive proof was provided by her that UK application 910 73 81 had been withdrawn in due time:

The copy of the extract from the Official Journal of Patents dated 13 May 1992 is evidence that UK application No. 910 73 81 was withdrawn before publication.

As regards the date of the withdrawal, her then representative, his secretary, and an employee of the representative's office had explained, in their written statements, the relevant practice in preparing letters and filing them with the UK Patent Office and the circumstances prevailing during the critical period. More specifically it was entirely possible that the letter of withdrawal was post-dated to 9 April 1992 for signature by the representative who was presumably absent from the office on 8 April 1992, after his return, but actually prepared by the representative's secretary already on 7 April 1992, so that this letter could have been filed with the UK Patent Office on 7 April 1992 as a "late filing "together with the appellant's new UK application (the one she claims priority for the patent in suit). The entry on the front cover of the representative's file relating to the previous UK application was not inconsistent with such a course of events because the marked date of withdrawal 9/4/92 was a reproduction of the date indicated on the file copy of the withdrawal letter.

Under these circumstances and in view of the principle that all factual questions are to be decided by balancing the evidences and weighing up the alternatives the Opposition Division had applied the wrong standard of proof in deciding that the appellant had not been able to provide any concrete proof that the withdrawal was filed in due time.

As to the subject matter of the applications in question the appellant contended that D1 could not prejudice the novelty of the patent in suit also for the reason that the disclosure in that document was not enabling with regard to the described self-closing slit valve. Furthermore, that document teaches the use of a flat membrane as the basis of the slit valve whereas the patent in suit in the versions proposed in the three further auxiliary requests filed with letter of 7 April 2003 requires a dome shaped region.

Even if the appellant's right to priority is denied, that could only be for subject matter disclosed in the earlier UK application. That application disclosed only the embodiments using a self-closing slit valve in a dome-shaped region whereas the subsequent UK application contains both the dome-shaped and the flat end embodiment. Thus the only subject matter which could lose priority is the dome-shaped region subject matter, because Article 87(4) EPC cannot apply to the alternative flat end subject matter which was not in the earlier application but only in the subsequent UK application. Hence, for the flat end embodiment the priority date of 7 April 1992 must be valid.

- V. The respondent (opponent 02) submitted that in its view the decision of the Opposition Division is correct for the reasons given by the Opposition Division, both as to the issue of loss of priority and as to lack of novelty of at least claim 1 over D1. It was self-evident that the two UK applications of the appellant were for the same invention because application 910 73 81 contained most of the drawings present in

application 920 77 66. The appellant wrongly submitted that if Article 87(4) EPC applied with the result that the earlier UK application was a relevant earlier application, priority was lost from the second UK application only for embodiments common to both of these applications. The appellant was wrong, because Article 87 EPC referred to the "same invention" not to the "same embodiments" and Article 87(4) EPC applies to the broad statements of invention and any broad inventive concept in the earlier UK application as well as to its embodiments.

VI. Oral proceedings, at the end of which the decision of the Board was announced, took place on 4 June 2003.

VII. The appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for patentability to be examined based on the priority date of 7 April 1992; that if the decision denying the appellant's priority right is upheld, the decision on the issue of novelty over D1 be set aside either on the basis of the two requests underlying the decision under appeal (named main and first auxiliary request) or the three further auxiliary requests filed by letter of 7 April 2003 (named second, third and fourth auxiliary request) and in that event the further examination of the opposition be remitted to the first instance; that insofar as the consideration of this matter raises important points of law, the Board consider a referral to the Enlarged Board of Appeal pursuant to Article 112 EPC.

The respondent (opponent 02) requested that the appeal be dismissed and the case be remitted to the first instance

- in the event that the Board reaches a different opinion to that of the Opposition Division on the issues of the priority date and novelty over D1, or
- in the event that the Board reaches an opinion that any of the auxiliary requests has novelty over D1.

Opponent 03, who did not attend the oral proceedings although duly summoned, requested in writing, without making further submissions, that the appeal be dismissed.

Reasons for the Decision

1. *Admissibility*

The appeal is admissible.

2. *Priority*

- 2.1 In view of document D1 which discloses relevant subject matter (see point 3 below) and was published less than one year before the filing date of the application underlying the patent in suit, the validity of the priority claimed from (the second) UK application 920 77 66 filed on 7 April 1992 needs to be established. As said application was preceded by a related

application of the appellant, namely UK 910 73 81 filed on 8 April 1991, the validity of the priority in question depends on whether these three applications were in respect of the same invention (Article 87(1) EPC) and if so, whether the previous UK application had been withdrawn in time (Article 87(4) EPC).

2.2 The patent in suit concerns the same invention as the second UK application 920 77 66. This is uncontested by the parties.

2.3 That same invention is also disclosed in the earlier UK application 910 73 81. Support for this is found at page 2, last paragraph; page 5, second paragraph, first sentence; page 6, second paragraph, lines 7 to 10; and Figures 1 and 2 of that previous application as filed. Contrary to the appellant's contention, that application contains the general disclosure of a slit valve which is not necessarily associated with a dome-shaped region. At page 2, last paragraph and page 2(a) of the earlier application the invention is described in its broadest context as having valve means operated by suction. A slit valve is one of the commonest valve means operated by suction. At page 3 it is said further that such valve means "may" comprise a dome-shaped region. It follows that slit valves are not necessarily associated in the disclosure of the earlier document with a dome-shaped region.

2.4 That being so, the priority claimed for the patent in suit is valid only on condition "that, at the date of filing of the subsequent application [7 April 1992], the previous application [UK 910 73 81] has been withdrawn" (Article 87(4) EPC). Thus the

validity of the priority depends on whether the earlier application had been withdrawn in due time or not.

2.5 As the number of the previous application appears in the list of withdrawn (or otherwise lapsed) applications published on 13 May 1992 in The Official Journal (Patents), Number 5382, of the UK Patent Office, it is a proven fact that said application was withdrawn before that date. But the list is silent regarding the actual date of (legal effect of) the withdrawal. This date, however has to be established in order to decide whether the withdrawal was in time for the purposes of Article 87(4) EPC.

2.6 The appellant could provide only two documents directly related to the date of filing of the letter of withdrawal (Exhibits MJPD.2 and MJPD12 - see point III, above). However, both indicate/mention 9 April 1992 and hence, taken on their own, rather point in the direction of a withdrawal at that (late) date, as was correctly found in the decision under appeal.

2.7 Neither do the three written statements presented by the appellant constitute conclusive evidence of the actual date of filing of the withdrawal:

The employee (see point IV, above) was not involved in the applications in question and merely described the usual practice of the record department in the representative's office.

The secretary of the then representative stated that she could not remember the facts underlying proceedings concerning this application and merely presented some suppositions of what might have happened.

The appellant's then representative similarly stated that he could not remember much of what occurred, but had done his best to set out what he believed had occurred, based on the documents which were available to him and on what his own working practices were at the time the said application was filed. So, while in his view a filing of the letter of withdrawal after 7 April 1992 was most unlikely, he could not definitively rule it out (point 28 of his statement) and the only way of verifying it for certain would be to determine the date of receipt stamped by the UK Patent Office on the original letter. However, this was not possible because of the UK Patent Office's standard practice of destroying the files relating to abandoned applications after five years and because in 1992 the Patent Office kept no other record of the date on which the letter was actually received by them.

- 2.8 The Board can accept, on the basis of the evidence submitted, in particular the written statements concerning the practice at the representative's office and the correspondence between himself and the appellant, that it was the intention of both to replace the first UK application by a new one and to make use of the exception from the first application principal provided by Article 87(4) EPC. This is corroborated by the fact that the first application was actually withdrawn. The new application was filed on 7 April 1992, and it was presumably known to the attorneys

working on the case, in particular the appellant's then representative, that a withdrawal after that date would be useless for the purposes of Article 87(4) EPC. It is also true that the date on a (unsigned) file copy is not definitive and thus not hard evidence of signature, dispatch or filing of the original on that date.

Moreover, in the present case the representative's secretary, if she prepared the letter of withdrawal late on 7 April, might have had a good reason, namely the representative's absence on the following day, to postdate the letter of withdrawal to 9 April 1992, and it can be conceded that the representative, if the letter of withdrawal had been submitted to him for signature only on 9 April 1992, when it was too late, would have taken appropriate countermeasures, e.g. by simply filing the second UK application again on 10 April 1992. However, all this concerns the general circumstances prevailing during the critical period, but does not constitute direct and cogent evidence as to the precise day on which the withdrawal was received by the UK Patent Office. In the absence of any direct and positive evidence (point 2.6 and 2.7 above), and on the basis of this circumstantial evidence it can at best be concluded that a filing on 7 April 1992 is not to be ruled out despite the two documents "pointing in another direction".

- 2.9 As to the applicable standard of proof it is pointed out that because of the crucial effect a valid priority date has on patentability (limitation of the state of the art to be taken into account for the assessment of novelty and inventive step - Article 89 EPC, Article 4D Paris Convention), the date of filing of the application whose priority is claimed must be proven in

a formal way, namely by a certificate issued by the authority which received that application (Rule 38(3) EPC, cf. Article 4D3 Paris Convention). Even if no such formal proof is prescribed for the timely withdrawal of a previous application pursuant to Article 87(4) EPC (cf. Article 4C4 Paris Convention) it appears appropriate to require an equally high standard of proof, for once there existed a previous application concerning the same invention both dates are equally relevant for establishing the validity of the claimed priority. However, in the present case, where priority is claimed from a subsequent application, a corresponding certificate of the date of the withdrawal of the previous application could not be obtained from the UK Patent Office. Nor was the appellant able to produce any evidence of comparable evidential strength, e.g. a certificate of receipt of the letter of withdrawal by the UK Patent Office.

The evidence and arguments put forward only allow the conclusion that a withdrawal of the previous application with effect on 7 April 1992 cannot be ruled out (point 2.8, above). As a consequence, the timely withdrawal of UK application 910 73 81 for the purposes of Article 87(4) EPC cannot be established.

- 2.10 This fact operates to the detriment of the appellant, because she carries the relevant burden of proof. Unlike facts barring patentability (see e.g. decision T 219/83 cited by the appellant) a timely withdrawal of a previous application is a positive precondition for claiming a valid priority from a subsequent application for the same invention. Hence, the date of (effect of the) withdrawal is a fact which can act in the applicant's favour and she relied on it just as she

relied on the filing date (and the content) of the subsequent UK application. The application of the principle that the burden of proof for a particular fact is to be borne by the party alleging it is even more justified in the present situation, where the alleged fact was a purposive act by the appellant ('s representative).

- 2.11 For these reasons the decision under appeal correctly held that the priority claim of the patent was invalid because, under the terms of Article 87(4) EPC, UK Patent application No. 9 207 766 could not be considered to be the first application for the purpose of claiming priority, and that, as a direct consequence the patent US-A-5 186 347 (document D1 published on 16 February 1993) is a prior art document according to Article 54(2) EPC.

3. *Novelty*

- 3.1 Claim 1 of the two requests underlying the decision under appeal, which are now the main and the first auxiliary request are identical and read:

A drinking vessel suitable for use as a trainer cup or the like, comprising: an open-mouthed generally cup-shaped container; (2, 2', 60,54; a lid (5, 5', 31, 31', 61, 49) for the open mouth of said cup-shaped container, the lid (5, 5', 31, 31', 61, 49) having a mouthpiece (6, 32, 4, 51) associated therewith; a valve means (1, 1' 31, 31', 42, 58) associated with the lid and adapted to prevent flow of liquid from the interior of the container through the mouthpiece and to enable a user to draw liquid through the mouthpiece, the

configuration of the valve means (1, 1' 31, 31', 42, 58) being such that said valve means is adapted to open upon no more than a predetermined difference of pressure, greater within the vessel than outside, being present across the said valve, whereby said valve means (1, 1' 31, 31', 42, 58) prevents flow from the interior unless a predetermined level of suction is applied to the mouthpiece, and a user is enabled to draw liquid through the mouthpiece (6, 32, 45, 51) by the sole application of suction thereto to provide said difference pressure; characterised in that said valve means (1, 1' 31, 31', 42, 58) comprises a self-closing slit valve (18, 35, 58)

- 3.2 Document D1 discloses a spill-proof closure mounted on a beverage container (see in particular Figures 1 to 3), i.e. a drinking vessel certainly suitable for use as a trainer cup or the like (see its title). More specifically, the drinking vessel shown in D1 comprises an open-mouthed, generally cup-shaped container ["beverage container" 11]; a lid ["closure" 10] for the open mouth of said container, the lid having a mouthpiece ["spout" 12] associated therewith ["an integral part of the closure"]; and valve means ["thin membrane" 13, "slit" 14] associated with the lid ["attached to the ... spout"] and adapted to prevent flow of liquid from the interior of the container through the mouthpiece ["denying communication between the interior and the exterior of the beverage container"] and to enable a user to draw fluid through the mouthpiece, the configuration of the valve means being such that said valve means is adapted to open upon no more than a predetermined difference of pressure, greater within the vessel than outside, being

present across the said valve, whereby said valve means prevents flow from the interior unless a predetermined level of suction is applied to the mouthpiece, and a user is enabled to draw liquid through the mouthpiece, by the sole application of suction thereto to provide said difference of pressure (see column 1, lines 37 to 41; column 2, lines 55 to 57); whereby said valve means consists in a self-closing slit valve (see column 2, lines 26 to 39, lines 53 to 59, and paragraph bridging columns 2 and 3).

3.3 Thus, all the features of the subject matter of the claim in question (point 3.1, above) are derivable directly and unambiguously from document D1. The appellant contends that the disclosure in D1 is not enabling because a flat membrane after moulding or otherwise attaching the flat thin membrane to the inner surface of the spout will have internal stresses created therein, which would cause the membrane to deform and hence the slit to open or at least no longer close in a liquid tight manner. The Board does not accept his argument in view of the fact that the form and size of the spout and its inner surface, the position of the membrane on said inner surface and the way it is attached thereto, the materials the membrane is made of and its thickness, and the form of the slit can be widely varied. All these interacting parameters can be combined so as to make the slit self-closing, and a person skilled in the art would have achieved this by applying its general knowledge on the basis of the teaching of D1.

3.4 For these reasons the decision under appeal correctly found that the subject matter of claim 1 according to the main and auxiliary requests, which were maintained in the appeal proceedings as the appellant's main and first auxiliary request, lacks novelty.

4. *Request for referral to the Enlarged Board of Appeal*

Neither has the appellant formulated any question for referral to the Enlarged Board, nor does the Board see that in the present case a decision of the Enlarged Board is required in order to ensure uniform application of the law or because an important point of law has arisen, for all relevant issues, in particular the evaluation of the evidence concerning the date of withdrawal of the previous application and the related standard and burden of proof could be decided on the basis of the provisions of the EPC in the light of generally acknowledged principles of law and in conformity with the relevant, uniform jurisprudence of the Boards of Appeal.

5. *Remittal to the first instance*

In contrast to the content of the two UK applications, which cannot be restricted *a posteriori* in order to comply with Article 87(1) and (3) EPC, the appellant has submitted further sets of claims as her second, third and fourth auxiliary request in order to take due account of D1 in case the invalidity of the claimed priority should be confirmed on appeal. That issue being prejudicial for the question of whether D1 constitutes prior art, the submission of such further requests for the first time in the appeal proceedings

is acceptable. In line with the parties' wishes and in order to preserve the possibility of having the outstanding matters decided upon by two instances, a remittal to the first instance for further prosecution on the basis of said new requests is appropriate in the circumstances of the present case.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the second, third or fourth auxiliary request filed with letter of 7 April 2003.

The Registrar:

The Chairman:

V. Commare

R. Menapace