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**Datasheet for the decision  
of 17 March 2011**

**Case Number:** T 1129/09 - 3.2.07

**Application Number:** 05753046.1

**Publication Number:** 1761435

**IPC:** B65D 1/02

**Language of the proceedings:** EN

**Title of invention:**

A container for liquid with a lightweight bottom

**Applicant:**

Nestlé Waters Management & Technology

**Headword:**

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**Relevant legal provisions:**

EPC Art. 108

EPC R. 99(2)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Admissibility of the appeal (no)"

**Decisions cited:**

T 0844/05, T 1011/01, T 0226/85, T 1055/92, T 0220/83,  
T 0809/06, T 0729/90, T 0105/87, T 0563/91

**Catchword:**

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Case Number: T 1129/09 - 3.2.07

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.07  
of 17 March 2011

**Appellant:** Nestlé Waters Management & Technology  
12, Boulevard Garibaldi  
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**Representative:** Rupp, Christian  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 9 March 2009  
refusing European application No. 05753046.1  
pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** H. Meinders  
**Members:** K. Poalas  
I. Beckedorf

## Summary of Facts and Submissions

- I. The appeal is directed against the decision of the examining division to refuse European patent application 05 753 046.1.
- II. The impugned decision concerns lack of sufficiency (Article 83 EPC), lack of essential features and lack of inventive step (Article 56 EPC).
- III. With its letter dated 29 April 2009 the appellant lodged an appeal against this decision and requested that it be set aside and that a patent be granted on the basis of the main request or of the auxiliary request, both filed with the same letter.
- IV. Oral proceedings before the Board took place on 17 March 2011.

At the oral proceedings the appellant requested that

1. the appeal be admitted and
2. the decision under appeal be set aside and that a patent be granted on the basis of one of the sets of claims filed as main and auxiliary request with letter of 17 February 2011.

- V. The appellant argued essentially as follows:

### *Admissibility of the appeal*

The impugned decision, which is one "according to the state of the file", only refers to the examining division's prior communications dated 27 April 2007, 28 January 2008 and 30 January 2009. Although the

Articles 83 and 84 are mentioned in said communications the arguments presented in sections 2.2 and 2.2.1 of the last, most relevant, communication are mainly directed to the issue of inventive step. For example, the last sentence of section 2.2 contains a comparison between the container according to claim 1 and the container known from D1 (US-A-5 427 258). There is no requirement in the EPC or established by case law of the Boards of Appeal that the assessment of insufficiency of disclosure has to be based on the difference between the subject-matter of claim 1 and the known prior art. Such an argumentation was regarded by the appellant as a reasoning for an objection under Article 56 EPC. Furthermore, in section 2.2.1 of that same communication the examining division raises on the one hand an objection due to the absence of essential features in claim 1, and on the other hand it compares the hemispherical bottom of the container of the present invention with the bottoms of the containers known from D1 and D2 (US-A-5 714 111).

The substance of the arguments presented in said sections is decisive for the appellant's response, not the labelling of said sections with "insufficiency of disclosure" or "lack of essential features". In substance they only concerned inventive step.

The appellant, considering therefore the arguments presented by the examining division in the above-mentioned sections 2.2 and 2.2.1 as objections directed to the issue of inventive step tried to overcome these objections by filing amended claims in that respect, accompanied by arguments focusing only on said issue. Said claims involve according to its conviction an

inventive step and constitute therefore with the supporting argumentation an admissible appeal.

In any case, with the new sets of claims not only the ground of lack of inventive step but also the grounds of insufficient disclosure and of lack of clarity by missing essential features are overcome.

According to the case law of the Boards of Appeal, when filing an amended set of claims, the appellant does not need to address every single objection of the impugned decision.

- VI. In its annex to the summons to oral proceedings dated 9 December 2010 the Board had given its preliminary opinion on the admissibility of the appeal, as in its opinion the appellant had not addressed all the impugned decision's grounds.

## **Reasons for the decision**

### *Admissibility of the appeal*

1. In section 3.1 of its last communication dated 30 January 2009 the examining division informed the appellant that "*[i]f the applicant is interested in a speedy appealable decision, he can ask for a "decision according to the state of the file" and withdraw his request for oral proceedings. Then the examining division will issue a decision of a standard form referring to the previous communications (see Guidelines C-VI, 4.5) this decision is appealable like any decision announced after an oral proceedings"*.

2. With its fax of 2 March 2009 the appellant withdrew its request for oral proceedings and requested a decision to be "rendered according to the state of the file".
3. In the resultant decision of standard form, reference is merely made to the communications of the examining division dated 27 April 2007, 28 January 2008 and 30 January 2009.
4. The first communication only made a novelty objection based on D1, which after reply of the appellant was subsequently withdrawn. In the second communication an objection for lack of clarity (definition by the result to be achieved) and lack of sufficiency was raised. In the reply thereto the appellant traverses these objections by reference to the examples in the description.

In the last communication again an objection for lack of clarity is raised, this time for absence of features in the main claim which are essential for solving the problem posed (section 2.2.1), as well as a further elaboration of the sufficiency objection already made (section 2.2). The earlier objection for lack of clarity is apparently dropped as it is not repeated nor referred to. In section 2.3 an objection of lack of inventive step is raised (Article 56 EPC), based on the object to be achieved by the invention, as seen by the examining division.

5. With its appeal the appellant filed amended claims requests and supplied the statement of grounds of

- appeal in respect of novelty and inventive step of the subject-matter of claim 1 of each of these requests.
6. In its communication the Board observed that the appeal appeared to concern only the issues of novelty and inventive step in respect of the newly filed claims, but not the other issues (Article 83 and 84 EPC) of the decision under appeal. The amendments to claim 1 of the main and the auxiliary request neither seemed to address these issues. Regarding the possible inadmissibility of the appeal the Board referred also to decision T 844/05.
  7. In its letters of 4 and 17 February 2011 the appellant did not address the issue of admissibility of the appeal as raised by the Board, other than by asking that the appeal be "permitted" and by supplying arguments, now regarding sufficiency of disclosure and clarity of the claims.
  8. During the oral proceedings before the Board the discussion therefore concentrated on the admissibility of the appeal and focused on the content of the examining division's last communication, the appellant's statement of grounds of appeal and the amended claims filed with the appeal.
  9. Article 108, third sentence, EPC provides that "[w]ithin four months of notification of the decision, a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations". Pursuant to Rule 99(2) EPC, "[i]n the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the

- extent to which it is to be amended, and the facts and evidence on which the appeal is based".
10. Under the established case law the grounds for appeal should specify the legal or factual reasons on which the case for setting aside the decision is based. If the appellant submits that the decision under appeal is incorrect, **the statement setting out the grounds of appeal must enable the Board to understand immediately why the decision is alleged to be incorrect** and on what facts the appellant bases its arguments, without first having to make investigations of its own (see T 220/83, OJ EPO 1986, 249, point 4, followed by numerous decisions, such as T 809/06, point 2 and T 844/05, point 1, both not published in OJ EPO).
  11. As it is the statement of grounds of appeal which has to fulfil by itself these requirements the supplying of reasons regarding grounds of the impugned decision, for the first time with the letter of 4 February 2011, outside of the applicable time-limit cannot remedy the deficiency that they have not been supplied with the statement of grounds.
  12. The admissibility of the appeal therefore depends in the present case on whether the letter of 29 April 2009, together with the two sets of claims and description page 6 annexed to said letter, can be regarded as a valid statement of grounds of appeal.
    - 12.1 It is therefore to be examined whether the impugned decision is based in substance **only** on inventive step. If that is not the case, it must be apparent from the arguments presented in the statement of grounds and/or



from the attached amended claims that the reasons for refusal based on lack of sufficiency (Article 83 EPC) and lack of essential features (clarity/support, Article 84 EPC) are implicitly addressed or that at least the amended claims clearly overcome them. The Board is of the opinion that this requirement is not met in the present case, for the following reasons.

12.2 The communication of 28 January 2008 already contains a very brief objection under Article 83 EPC that the skilled person only receives vague indications on how to achieve a plastic which is highly stretched and on how the geometry allows a uniform repartition of the forces.

In the communication of 30 January 2009 this objection is expanded in that explanation is considered lacking in the patent as to how a further reduction in wall thickness and weight of the bottom is achieved (for arriving at a weight ratio of more than 4:1 for the wall: bottom, as claimed) while at the same time maintaining/improving the mechanical properties of the container.

Both are clear objections under Article 83 EPC, insufficiency of disclosure.

In the latter communication, based on the same deficiencies as the information contained in the patent, an objection for lack of essential features in claim 1, to define the invention, was made. It is consistent case law of the Boards of Appeal that such an objection is one for lack of clarity/support, see Case Law BoA, 6th edition 2010, Chapter II.B.1.1.4.

12.3 The appellant's statement of grounds of appeal does not contain any arguments regarding the lack of sufficiency

(Article 83 EPC) or the lack of essential features (clarity/support, Article 84 EPC) but only arguments in respect of lack of novelty and inventive step. This fact was not disputed by the appellant.

The appellant was also not in a position to identify any part of the two sets of claims and amended description page 6 annexed to said letter which related to these objections and clearly overcame them.

12.4 The appellant argued that even if sections 2.2 and 2.2.1 of the last communication of the examining division were to be seen as objections under Articles 83 and 84 EPC, due to the fact that said sections also refer to comparisons between the subject-matter of claim 1 and the disclosure of D1 and/or D2, the appellant was led to believe that the only issue at stake was a lack of inventive step and that by filing, together with the corresponding arguments, new sets of claims overcoming in its opinion this ground an admissible appeal had been filed.

12.5 The Board cannot follow said argument for the following reasons:

12.5.1 In the first place, both for sufficiency of disclosure as well as for lack of clarity/support, there is an arguable case for taking account of the features by which the claimed invention distinguishes itself from the prior art, being D1 or D2. These are the features which are important for the invention, as it is the invention as claimed which needs to be sufficiently disclosed, if not in the claim, then with the help of the description and the general technical knowledge of

the skilled person, see T 1011/01 and T 226/85 cited in Case Law of the BoA, Chapter II.A.1.

The same applies even more for distinguishing features, essential to the invention so as to comply with the requirement of clarity in/support for the claims, see Case Law of the BoA, Chapter II.B.4.2, in particular T 1055/92 cited therein.

12.5.2 In the second place the appellant should have made its position on the issue clear, by at least submitting that lack of sufficiency and lack of clarity/support have nothing to do with the "distinguishing features", or that by filing arguments and amended claims as a response to the issue of inventive step it assumed that it automatically responded also to the objections raised under Articles 83 and 84 EPC. Both are not the case.

13. The appellant argued further that according to the case law of the Boards of Appeal by filing an amended set of claims the appellant does not need to address every single objection of the impugned decision and that therefore in the present case it did not need to address the objections concerning lack of sufficiency of disclosure (Article 83 EPC) and lack of clarity/support (Article 84 EPC) explicitly.

The Board cannot follow said argument for the following reasons:

13.1 The Board establishes that, other than this general statement, the appellant did not put forward any supporting case law. Also the present Board is not

aware of any case law supporting such a general statement. In the present case, without arguments directed to the amended features when compared with the objections under Articles 83 and 84 EPC, it would require anyway that the Board performs further investigations on its own to examine the possibility whether the amended claims evidently address these issues, which goes, in the present case, beyond its duties, see point 10 above.

13.2 The cases cited in the Case Law of the Boards of Appeal of the EPO, 6th edition 2010, Chapter VII.E.7.6.2 d in this respect relate to either submitting claims which already had been accepted before by the department of first instance (T 729/90), clearly overcome a novelty objection by adding to the claim a novel feature (T 105/87) or clearly put the established lack of inventive step into question (T 563/91). None of these situations apply here.

13.3 Even if the Board had examined the nature of the amendments in the new sets of claims, it would not have been evident that they also overcome the objections based on insufficiency of disclosure and on lack of clarity/support:

14. The amendments concern the hemispherical shape of the feet and the tangentially shaped connection of the feet to the hemispherical bottom. The objections related however to the wall/bottom weight ratio being at least 4 and to the question whether the invention was sufficiently claimed and described insofar as the wall-thickness/weight of the container's bottom was reduced, while maintaining, or even improving, at the same time

the mechanical properties of the container. The feature of the wall/bottom weight ratio being at least 4 has remained, however, unchanged in claim 1 and the application does not give any indications that the "substantially hemispherical" shape of the feet or their connection to the hemispherical bottom, address the issue of the weight reduction, let alone in connection with the mechanical properties. Finally, the present case does not fall within the other exceptions, listed in Chapter VII.E.7.6.2 of the Case Law of the Boards of Appeal of the EPO, to the principle that the statement of grounds should be complete.

15. It follows from the above that the statement of grounds of appeal, read together with its annexes, does not enable the Board to understand immediately why the decision is alleged to be incorrect as regards the findings of lack of sufficiency of disclosure (Article 83 EPC) and lack of essential features in claim 1 (clarity/support, Article 84 EPC). This would have been necessary because these grounds constitute a sufficient basis for the refusal of the application. It was therefore not sufficient to only make submissions in relation to Article 56 EPC, which is a further ground on the basis of which the present application was refused, independently of the two other grounds.

In conclusion, the appellant did not file any submission that can be regarded as a sufficient statement of grounds of appeal within the meaning of Article 108, third sentence, EPC. Therefore the appeal is inadmissible.

**Order**

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

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

G. Rauh

H. Meinders