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**Datasheet for the decision
of 26 November 2013**

Case Number: T 0454/10 - 3.4.03

Application Number: 05767396.4

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Title of invention:
ELECTRONIC APPARATUS

Applicant:
Panasonic Corporation

Headword:

Relevant legal provisions:
EPC 1973 Art. 54, 56, 111(1)

Keyword:
Novelty - (yes)
Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:



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Case Number: T 0454/10 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 26 November 2013

Appellant: Panasonic Corporation
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 7 January 2010 refusing European patent application No. 05767396.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: G. Eliasson
Members: S. Ward
T. Karamanli

Summary of Facts and Submissions

I. The appeal is against the decision of the Examining Division refusing European patent application No. 05 767 396 on the ground that the claimed subject-matter is not new within the meaning of Article 54(1), (2) EPC in the light of the following document:

D1: DE 38 17 227 A1

II. The main request of the appellant is for the decision under appeal to be set aside and, having regard to claims 1-3 of the "Main Motion" set out on page 14 of the statement of grounds of appeal filed with the letter of 11 February 2010, for the Board "to declare them novel over DE 3817 727" (*sic*, DE 38 17 **227**, the sole document cited during the examination procedure, is clearly intended here).

The auxiliary request ("Auxiliary Motion", set out on page 15 of the statement of grounds of appeal) differs from the main request only in that the features of claim 1 are arranged according to a different two-part form.

III. Claim 1 according to the main request reads:

"An electronic apparatus comprising:

- a case (3) defining a penetrating hole (7),
- a protective ring (9) protruding from the case and surrounding the penetrating hole;
- a ventilation cap (13) provided inside the protective ring (9) and fitting into the penetrating hole (7);
- a breathable film (15) provided near the top of the ventilation cap so as to stop up a hole in the centre of the ventilation cap (13); and

- a protective cap (17) having a plate portion (31) and a leg portion (33) and being engaged with the ventilation cap (13);
 - wherein the leg portion (33) extends downwards from the plate portion (31) and the tip of the leg portion is engaged with the ventilation cap, and
 - the plate portion (31) is placed above the breathable film (15)
- characterized in that
- a gap (41) is defined between the plate portion and the protective ring, and
 - in a cross sectional view, an inside upper edge (B) of the protective ring (9) is positioned on or inside a straight line connecting an outer edge (C) of the hole in the centre of the ventilation cap and an outside lower edge (A) of the plate portion."

IV. The appellant's arguments may be briefly summarised as follows:

In relation to the question of novelty, the appellant insisted that the subject-matter of claim 1 of the application as refused differed from the arrangement of document D1 in several respects.

In particular, claim 1 defined that "a protective cap...[is] engaged with the ventilation cap" and that "the tip of the leg portion [of the protective cap] is engaged with the ventilation cap". The claimed ventilation cap and the leg portion of the protective cap could be identified with elements 20 and 25, respectively, of document D1. However, in the arrangement of document D1, the element 25 was merely in *abutment* on element 20, and therefore not *engaged with* it, as the term "engaged with" had to be interpreted as meaning "fixed to".

The document D1 "most importantly...does not disclose the presence of a protective ring protruding from the case and surrounding the penetration hole". Instead, document D1 disclosed "a circular arrangement of studs 31, which are positioned around the hole 29". This was not to be compared with a protective ring.

Moreover, the ventilation cap 20 of document D1 was not provided within a protective ring, but only within the hole 29, and the arrangement of document D1 did not comprise a "gap" in the sense defined in claim 1 as refused, but only holes 32 in the top plate 24.

In relation to inventive step, the appellant argued that the identified differences overcame disadvantages inherent to the arrangement of document D1 in a manner which was "not suggested by the prior art, nor by the skilled person's general knowledge, so that the present invention as claimed must therefore be considered as implying an inventive step".

Finally the appellant argued that the other two documents cited in the search report (EP 0 831 572 A and DE 91 15 939 U1) were not highly relevant to the present case.

Reasons for the Decision

1. The appeal is admissible.

2. Novelty - Main Request

2.1 It is not disputed that document D1 discloses an electronic apparatus ("Schaltgerät" - not shown in the figure but explicitly mentioned in column 2, lines 42-44) comprising a case ("Wand 30") defining a penetrating hole ("Öffnung 29"). Document D1 also discloses a ventilation cap ("Druckausgleichselement 20") fitting into the penetrating hole (29) and a breathable film ("luftdurchlässige Folie 21") provided near the top of a ventilation cap so as to stop up a hole in the centre of the ventilation cap.

Document D1 further discloses a protective cap (24, 25) having a plate portion ("Deckel 24") and a leg portion ("Stege 25"), wherein the leg portion extends downwards from the plate portion (column 2, lines 13-15), the plate portion (24) being placed above the breathable film (21).

2.2 It is also disclosed in document D1 (see the sole figure) that the elements 25 ("Stege") corresponding to the claimed leg portion are *in contact with* the element 20 ("Druckausgleichselement") corresponding to the ventilation cap. They are not, however, disclosed as being *fixed* to each other, and may simply be in abutment.

The appellant interprets the expression "engaged with" as necessarily implying *fixation* and excluding mere abutment (see e.g. statement of grounds of appeal, page 4, point 1.4), and therefore concludes that document D1 does not disclose "a protective cap...being engaged with the ventilation cap" nor that "the tip of the leg portion is engaged with the ventilation cap".

2.3 The Board can see no justification for this narrow interpretation. The term "engaged with" is routinely used in mechanics in the context of elements which are in mutual contact without being permanently fixed to each other (e.g. in gears). In the present context, therefore, the expression "engaged with" must be regarded as encompassing the concept of "abutting", and hence, irrespective of whether elements 25 and 26 are fixed to each other or merely abutting, document D1 discloses that the protective cap is engaged with the ventilation cap and also that the tip of the leg portion is engaged with the ventilation cap.

2.4 Claim 1 of the application as refused also defines:

- "a protective ring protruding from the case and surrounding the penetrating hole".

In the contested decision it is asserted that document D1 discloses this feature, and the parenthetical remark "see Fig. 1" is made in this regard.

The only feature clearly disclosed in the text of document D1 as protruding from the case (30) is the plurality of studs or protrusions ("Fortsätze 31") which are spaced apart from each other (see column 2, line 61 - "zwischen den Fortsätzen 31"). In the statement of grounds of appeal the appellant refers to "a circular arrangement of studs 31, which are positioned around the hole 29", and this is also the Board's understanding of the geometrical disposition of the studs.

In the present context, the Board believes that the term "ring" implies a continuous band of material extending around the hole, and that an arrangement of

studs geometrically disposed at discrete locations around a circle cannot legitimately be described as constituting a physical ring within the meaning of claim 1 ("a protective ring protruding from the case").

This conclusion is further supported by the fact that claim 1 defines the protective ring to be "surrounding the penetrating hole", which clearly implies a structure which runs all the way around the hole in a continuous manner without gaps. The circular array of studs 31 disclosed in document D1 cannot therefore be identified with the claimed protective ring.

The single figure of D1 also appears to show that the the case wall (30) has an upwardly slanting top surface near the rim of the hole. However, this feature is not referred to in the text and it is therefore unclear what precisely is intended. There is no disclosure that this feature is a ring surrounding the hole, nor is any protective function apparent.

Finally, in this context, it is noted that document D1 does disclose an element referred to as "Ring 26". However, this structure is part of the "Druckausgleichselement 20" (i.e. the ventilation cap in the terminology of the application). The "Ring 26" does not protrude from the case, nor does it surround the penetrating hole (it is in fact located *in* the penetrating hole).

In conclusion, no feature can be identified in document D1 which could legitimately be considered to correspond to the claimed protective ring. The Board therefore judges that document D1 does not disclose "a protective ring protruding from the case and surrounding the penetrating hole".

2.5 Since document D1 does not disclose the claimed protective ring, it cannot possibly disclose any features defined by reference to the protective ring. It follows automatically, therefore, that document D1 does not disclose that the ventilation cap is "provided inside the protective ring", or that "a gap is defined between the plate portion and the protective ring".

Furthermore, the identification in the contested decision of the claimed gap with element 32 in document D1 cannot be accepted. It is clear from column 2, lines 54-59 of D1 that the reference number 32 refers to a plurality of discrete through-holes ("Durchbrüche") which are arranged in the plate portion 24, and not to a gap between the plate portion and any other element.

2.6 The final feature of claim 1 is the following:

- "in a cross sectional view, an inside upper edge (B) of the protective ring (9) is positioned on or inside a straight line connecting an outer edge (C) of the hole in the centre of the ventilation cap and an outside lower edge (A) of the plate portion".

As the Board has already stated that it does not believe that document D1 discloses a protective ring, it follows that this feature is also not disclosed.

In addition, in the first instance procedure (see e.g. point 2.1 of the search opinion, and the reference to the search opinion under point 1.1 of the Reasons of the contested decision) it appears that the Examining Division identified the points "B" and "A" with the respective outside upper and inside lower edges of the

through-holes 32 of document D1. The Board does not see how this can be reconciled with the definitions in claim 1 of the present main request that the point "B" is "an inside upper edge of the protective ring" and the point "A" is "an outside lower edge of the plate portion".

3. Further Procedure

The application was refused on the sole ground of lack of novelty in the light of document D1. However, for the reasons given above, the Board finds that the subject-matter of claim 1 of the main request (the sole independent claim) is new over the document D1.

Other requirements for the grant of a patent, including *inter alia* inventive step (Article 56 EPC 1973), have not yet been examined in any detail by the department of first instance. Hence, the Board considers it appropriate to exercise its discretionary power under Article 111(1) EPC 1973 to remit the case to the department of first instance for further prosecution.

The appellant has noted that the manner in which claim 1 is presented in the two-part form "may be objected to as being misleading" (statement of grounds, page 12, final paragraph). The question how, or even whether, the two-part form is to be employed in the present case is better left to be decided in the remitted procedure. The Board therefore leaves this matter open.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 3 of the main request submitted with the statement setting out the grounds of appeal.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated