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**Datasheet for the decision
of 25 October 2012**

Case Number: T 0712/10 - 3.2.06

Application Number: 00946345.6

Publication Number: 1219274

IPC: A61F 13/494, A61F 13/475,
A61F 13/15

Language of the proceedings: EN

Title of invention:
Disposable absorbing article

Patentee:
DAIO PAPER CORPORATION
Daio Paper Converting Co., Ltd.
Elleair Paper Tech. Co., Ltd.

Opponents:
SCA Hygiene Products AB
The Procter & Gamble Company

Headword:
-

Relevant legal provisions:
EPC Art. 112(1), 123(2)(3), 84
RPBA Art. 13(1)(3)

Keyword:

"Main request, auxiliary requests I - IV: no clear and unambiguous disclosure"

"Auxiliary request V, VIII to XI: not admitted"

"Auxiliary request VI: extended scope of protection"

"Auxiliary request VII: "footnote" - formulation of the claim; incompatible with the European patent system"

"Request for referral of questions to Enlarged Board - rejected"

Decisions cited:

G 0001/93

Catchword:

-



Case Number: T 0712/10 - 3.2.06

DECISION
of the Technical Board of Appeal 3.2.06
of 25 October 2012

Appellant I:
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Decision under appeal: Decision of the Opposition Division of the European Patent Office posted 11 February 2010 revoking European patent No. 1219274 pursuant to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: M. Harrison
Members: G. de Crignis
K. Garnett

Summary of Facts and Submissions

- I. European patent No. 1 219 274 was revoked by the opposition division by way of its decision posted on 11 February 2010.
- II. The opposition division held that the subject-matter of claim 1 of the main request and of claims 1 of auxiliary requests 1 and 2 included an unallowable intermediate generalisation and thus contained subject-matter which extended beyond the content of the application as originally filed (Article 123(2) EPC). Concerning the third auxiliary request, the opposition division found that the requirements of Article 123(3) EPC were not met.
- III. The appellant (patent proprietor) filed an appeal against this decision and with its grounds of appeal filed a main request and auxiliary requests 1 to 9. With its letter of 14 March 2011, a reply to the submissions of the opponents I and II was filed including auxiliary requests 10 to 14. It also included a request that, in the event that the main request and none of the auxiliary requests 1 to 9 were allowable, the following questions be referred to the Enlarged Board of Appeal:
1. *Is the drastic consequence of G1/93 (the so-called Article 123(2)/123(3) EPC trap) still valid, although no contracting state of the EPC and no other country in the world followed that approach?*
 2. *If a European patent as granted contains subject-matter which extends beyond the content of the*

application as filed and also limits the scope of protection conferred by the claims, is it possible during the opposition proceedings to maintain the patent in view of paragraphs 2 and 3 of Article 123 EPC while no rights can be derived from features that relate to said subject matter in the sense that said features must not be considered to delimit the subject matter over prior art but restrict the scope?

3. Is there a difference in answering questions 1 and 2, if an amendment which leads to the drastic consequence that a feature cannot be deleted because of Article 123(3) EPC but extends beyond application as filed has been carried out during the international phase of a PCT application which then entered the regional phase in Europe or if that amendment has been carried out during the granting proceedings before the EPO?

4. If questions 1 and 2 are answered in the negative, does there exist another possibility of escaping the so-called Article 123(2)/123(3) EPC trap?

IV. When issuing a summons to oral proceedings, the Board indicated in its annexed communication that none of the requests appeared allowable since the requirements of Article 123(2) EPC and/or Article 84 EPC did not appear to be fulfilled. Moreover, as regards the request for referral to the Enlarged Board, no inconsistent application of Articles 123(2)/123(3) EPC appeared to be present.

V. With letter of 24 September 2012, the appellant filed auxiliary requests I and II, each in versions a and b,

and auxiliary requests III and IV, each in versions a to d, and maintained the previously submitted requests.

- VI. Oral proceedings were held before the Board on 25 October 2012. During these proceedings the appellant withdrew all previous requests and filed a new main request, and auxiliary requests I to XI (see the minutes of the oral proceedings and point 1, below, for the details).

The appellant requested that the decision under appeal be set aside and the patent be maintained in accordance with the main request, alternatively on the basis of the auxiliary requests I to XI, all as filed during the oral proceedings. The appellant further requested that a question be referred to the Enlarged Board of Appeal in accordance with the request contained in its letter dated 14 March 2011.

The respondents (opponents OI and OII) requested that the appeal be dismissed.

- VII. Claim 1 of the main request reads:

"A disposable absorbent article in the form of a diaper having an absorbent structure comprising an absorbent core (3) which is coated with absorbent sheets (3A, 3B) to thereby form the absorbent structure and disposed between a liquid pervious sheet (1) and a liquid impervious sheet (2), wherein the absorbent sheets (3A, 3B), laterally extend beyond the side edges of the absorbent core (3) to thereby form extended peripheral side portions in the opposite leg portions of the diaper wherein the liquid

impervious sheet (2) has the shape of a rectangle with a width being larger than that of the absorbent structure and a back sheet (30), which has the shape of an hourglass, is provided so as to cover externally the liquid impervious sheet (2), wherein the liquid pervious sheet (1) has the shape of rectangle with a width being larger than that of the absorbent structure so as to laterally extend beyond the side edges of the absorbent structure with a short distance, and is fixed to the liquid impervious sheet (2), and at least one standing cuff (B) comprising a double standing sheet which has a free portion thereof standing toward the wearer's leg by means of a stretching force of stretching members (5) in a used condition, wherein an internal side of the double standing sheet initiates at the proximal edge fixed to the side edge of the liquid pervious sheet (1) and is fixed to the liquid impervious sheet (2) along its extended peripheral side portion in the laterally outboard portion with respect to the proximal edge and the proximal edge where the internal side of the double standing sheet is fixed to the liquid pervious sheet 1, defines a base line from which each standing cuff B stands such that said free portion has a base line for standing in a side flap being outboard with respect to the side edge of said absorbent core, wherein the free portion includes a standing portion (10) which stands from the base line toward the longitudinal centerline of said article and a contacting portion (20) which folds back halfway outwardly;

wherein said stretching members (5) extend in said contacting portion (20), in the vicinity of the fold and in said standing portion (10), respectively; and said standing cuff (B) stands toward said wearer's leg by means of a stretching force of said stretching members (5) in a used condition, while the extended peripheral side portion of the absorbent sheets (3A, 3B) and the absorbent core (3) are deformed and lifted such that said side flap between said side edge of said absorbent core (3) and said base line for standing is deformed and a deep pocket space is formed in the diaper."

Claim 1 according to auxiliary requests I to IV, VIII to XI includes the feature "wherein said stretching members (5) extend in said contacting portion (20), in the vicinity of the fold and in said standing portion (10), respectively;".

The objection concerning this feature being decisive (see *infra*), the further amendments made by way of these requests are not relevant for the decision.

In claim 1 according to auxiliary request V the above feature was amended and reads: "wherein said stretching members (5) extend on the surface-contacting portion (20), along the side edge of the surface-contacting portion (20) and on said standing portion (10), wherein the stretching members are 6 in total;".

Again, the objection concerning this feature being decisive, the further amendments to this requests are not relevant to the decision.

In claim 1 according to auxiliary request VI the features (ii), (iii) and (iv) of claim 1 as granted, which were objected to in the appealed decision (see point 2.1.2 of the appealed decision), have been deleted. These features were as follows:

feature (ii): said free portion has a base line for standing in a side flap being outboard with respect to a side edge of said absorbent core;

feature (iii): the stretching members (5) extend in the vicinity of the fold;

feature (iv): the side flap between the side edge of the absorbent core (3) and the base line is deformed during use.

Claim 1 according to auxiliary request VII is identical to claim 1 as granted except that a footnote is added: "[*Claim 1 as granted which reads as follows*] is maintained and a note is introduced in the specification, that no rights are derived from the features of the above claim 1 which are not originally disclosed in EP 1 219 274 A1, this is at least one of features ii, iii, iv mentioned in the decision of the Opposition division dated 11.02.2010."

VIII. The arguments of the appellant may be summarised as follows:

Claim 1 of the main request met the requirement of Article 123(2) EPC. All objections concerning the added features set out in the appealed decision were overcome. The claimed article was limited to the first embodiment of a diaper such as shown in Figures 1 to 3. The invention was concerned with two essential functional

concepts, namely a "containment/volume-function" and a "sealing-function". All features were to be considered with respect to these functional aspects and the claim included all structural features essential for obtaining the configuration to enable such functions. In particular, claim 1 included the design of the standing sheet as set out in paragraphs [0060], [0063], [0064] and [0068]. All parts extending beyond the side edge of the absorbent core formed the side flap. This was defined in claim 1. For enabling a correct function it was sufficient to define that the baseline was outside of the absorbent structure. Concerning the objected feature (iii) relating to the stretching members (5) extending in the vicinity of the fold, paragraph [0068] referred to the preferred embodiment having a stretching member in the vicinity of the side edge of the surface-contacting portion which could only be understood to refer to the fold shown in the free portion of Figure 2.

No further arguments were added with respect to auxiliary requests I to IV.

Auxiliary request V should be admitted into the proceedings. In claim 1 thereof, the article was further limited to the first embodiment shown in Figures 1 to 3. In particular with respect to feature (iii), it was specified that exactly six stretching members were present and their position was defined in a manner consistent with the disclosure in paragraph [0068] and with the sketches of Figure 2. Moreover, the folding and the fixation of the standing cuff were specifically defined.

In auxiliary request VI all objected features had been deleted. The question set out in the grounds of appeal should be referred to the Enlarged Board of Appeal. Decision G 1/93 concerning this matter was already rather old and, moreover, the present case was different in that the amendments were made during the International phase. For such reason, such questions could be decided in a positive sense and the auxiliary request VI could be admitted into proceedings. The German High Court had not followed such case law. Auxiliary request VII followed the solution practised by the German High Court. Hence, a "footnote"-request should be allowable.

Concerning auxiliary requests VIII to XI the arguments put forward with regard to the main request and auxiliary request V applied equally.

IX. The arguments of the respondents may be summarised as follows:

Claim 1 of the main request did not meet the requirement of Article 123(2) EPC. Neither literal nor any other clear and unambiguous disclosure for either feature (ii):

"... said side flap between the side edge of the absorbent core (3) and the base line for standing is deformed during use"

or feature (iii):

"wherein said stretching members (5) extend ... in the vicinity of the fold...;"

was present in the application as filed.

Moreover, the specific embodiment shown in Figures 1 to 3 included further features which were not included in the claim, such as e.g. a folded standing sheet, the attachment of the standing cuff and of the elastics.

These arguments also applied to auxiliary requests I to IV.

Auxiliary request V should not be admitted into proceedings. The alternative wording did not overcome the objections raised under Article 123(2) EPC. In addition to there being no clear and unambiguous disclosure of the wording "*along the side edge of the surface-contacting portion*" in combination with the further features of the claim, it was not clear (Article 84 EPC) how such wording should be understood.

In claim 1 of auxiliary request VI the objected features were deleted. These features were technically relevant. Accordingly, the requirement of Article 123(3) EPC was not met. No necessity was present to refer any question to the Enlarged Board of Appeal. The Boards of Appeal uniformly and consistently applied the relevant case law. No other diverging case law of any European states was cited or well-known.

Concerning claim 1 of auxiliary request VII, the footnote solution had already been considered by the Enlarged Board of appeal in G 1/93 (see paragraph 14 therein). Accordingly, such a request was clearly not allowable.

Auxiliary requests VIII to XI included the objected feature concerning the stretching members which had been discussed already for the main request. Hence, these requests should not be admitted into the proceedings.

Reasons for the Decision

1. *Requests*

1.1 The Main Request as well as auxiliary Requests I to IV, VI and VII were filed with the statement of grounds of appeal as auxiliary requests II to VI, VIII and IX, respectively. With letter of 24 September 2012, further auxiliary requests were filed, *inter alia* auxiliary requests IIa, IIb, IVc and IVd, which were re-submitted during the oral proceedings as auxiliary requests VIII to XI. Request V was newly submitted during the oral proceedings.

1.2 According to Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA), it lies within the discretion of the Board to admit any amendment to a party's case after it has filed its grounds of appeal or reply and it is stated that "the discretion shall be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy." According to Article 13(3) RPBA, "amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral

proceedings". Hence, such provisions apply for auxiliary requests V and VIII to XI.

2. Main request - Amendments

2.1 The feature of claim 1

"wherein said stretching members (5) extend in said contacting portion (20), in the vicinity of the fold and in said standing portion (10), respectively;"
(specified as "feature (iii)" in the following text)
results, in particular with regard to the wording "in the vicinity of the fold", in subject-matter which does not meet the requirement of Article 123(2) EPC.

2.2 Objection had been made already to this feature in the decision under appeal (point 2.1.4.3) as contravening the requirement of Article 123(2) EPC.

2.3 The appellant was of the view that although there was no literal disclosure of such wording, the drawings shown in Figures 1 to 3, which refer to the first and second embodiments, clearly disclosed such feature and claim 1 defined the essential features of these embodiments. In particular, it considered the black dot in the double standing sheet (in Figure 2) close to the position separating the standing portion (10) from the surface contacting portion (20) as representing the stretching member which extended in the vicinity of the fold. Additionally, paragraphs [0068] and [0076] (A-publication) should be interpreted in such a way that they confirmed this disclosure.

2.4 When scrutinizing the disclosure in the above cited Figures and paragraphs, there is no clear and

unambiguous disclosure with regard to a stretching member "in the vicinity of the fold" as claimed, for the reasons given *infra*.

2.4.1 The wording of paragraph [0068] (A-publication) does not refer to a stretching member in the vicinity of the fold but to a plurality of stretching members as extending in the vicinity of the side edge of the surface-contacting portion 20 and is worded as follows: *"In the more preferable aspect, the stretching members 5, 5... extend in the vicinity of the base line for the standing portion 10, in the vicinity of the distal edge of the double standing sheet, and in the vicinity of the side edge of the surface-contacting portion 20. In addition, a plurality of stretching members 5, 5... preferably extend in the vicinity of the side edge of the surface-contacting portion 20 as shown. Additionally, in order to improve the standing ability of the standing portion 10, a plurality of stretching members 5, 5... may further extend on the standing portion 10. In the Figure are shown six stretching members in total."*

2.4.2 When considering Figure 2 for the presence of such stretching members, the surface-contacting portion 20 is shown as being provided with two stretching members, one of which is positioned in the (outer or distal) side edge of the surface-contacting portion, which edge represents the upper end of the free portion when standing; and the other stretching member is positioned slightly inboard of this edge. Both stretching members are identified via the reference numeral 5. No further stretching member is shown as being located on (or within) the surface-contacting portion.

2.4.3 In Figure 2 there are two further stretching members identified via the reference numeral 5. However, these stretching members are within the standing portion 10 of the free portion and are located at the base end and in the middle between the base end and the distal end of the standing portion, respectively. Hence, these stretching members cannot represent stretching members extending in the vicinity of the side edge of the surface-contacting portion such as set out in paragraph [0068].

2.4.4 Additionally, there are two further numerically unreferenced black dots within the standing portion 10, one of which is close to the edge which joins the surface contacting portion 20 to the standing portion 10. However, on the one hand this black dot cannot be clearly and unambiguously identified as a stretching member because it is not indicated with the corresponding reference number, and on the other hand, it is not clear whether it is this fold which is to be considered. There are two folds possible in the double-layered standing sheet: one fold concerns the folding in relation to the surface-contacting portion, the other fold concerns the folding of the fixed portion in relation to the free portion when fitting the article. Since there is one stretching member 5 exactly at this latter position for folding/upstanding of the cuff - at the base end -, no clear and unambiguous disclosure is present with regard to which fold is concerned.

2.4.5 The further reference to the disclosure in paragraph [0076] is also not unambiguous. This paragraph refers to the second embodiment, shown in Figure 4, which is

said to differ from the first embodiment in that the stretching member is present in the vicinity of the edge where the surface-contacting portion (20) folds back halfway. Hence, this reference cannot clarify the description provided in paragraph [0068] either - on the contrary, it highlights that in the first embodiment no such stretching member should be present at that location. It may be noted also that the claim defines "stretching members" in the vicinity of the fold, whereas, even when considering Figure 2, a single stretching member (if this is the "black dot" mentioned earlier) is present on the end part of the standing portion 10 close to the joining fold.

2.5 Accordingly, the main request is not allowable under Article 123(2) EPC at least because there is no clear and unambiguous disclosure in the application as filed for the feature "*wherein said stretching members (5) extend in said contacting portion (20), in the vicinity of the fold and in said standing portion (10), respectively;*" in combination with the further features in claim 1 concerning the claimed embodiment.

2.6 Moreover, the features of paragraphs [0062] and [0066] of the application as filed (A-publication) which are also disclosed in combination with the embodiment which the appellant claims are omitted. These features concern in part the standing cuff which is made double by folding the inside of the standing sheet inwardly so as to be shorter than the outside and the fixation of the standing cuff in the front and back ends of the diaper body. These features are also related in particular to the functions of "volume" and "sealing" which were emphasized by the appellant as being

essential for the invention. Accordingly, these features are disclosed in a functional and structural relation to the claimed embodiment whereby, via their omission, the requirement of Article 123(2) EPC is not met since an unallowable intermediate generalisation of the content of the application as filed has occurred. Hence, the main request is not allowable at least for the foregoing reasons.

3. Auxiliary request I - IV

Claim 1 according to auxiliary requests I to IV includes *inter alia* the above discussed feature (iii) "*wherein said stretching members (5) extend in said contacting portion (20), in the vicinity of the fold and in said standing portion (10), respectively;*". Accordingly, at least the corresponding objection set out above applies, and claim 1 of these requests contravenes Article 123(2) EPC. None of auxiliary requests I - IV is therefore allowable.

4. Auxiliary request V

4.1 In claim 1 feature (iii) concerning the stretching members has been amended to read:

"wherein said stretching members (5) extend on the surface-contacting portion (20), along the side edge of the surface-contacting portion (20) and on said standing portion (10), wherein the stretching members are 6 in total".

In view of such amendment being decisive, it is not necessary to discuss the further amendments.

- 4.2 Paragraphs [0067] and [0068] of the A-publication were cited by the appellant as providing a disclosure of this feature.

Paragraph [0067] reads: "*In a basic aspect, at least one stretching member 5 extends on the surface-contacting portion 20. Preferably, the stretching member 5 extends along the side edge of the surface-contacting portion 20. Further, it is preferable that the stretching member 5 extends also on the standing portion 10.*"

Paragraph [0068] is cited under point 2.4.1 above.

- 4.3 Neither these paragraphs nor the sketches shown in Figure 2 are suitable for providing a clear understanding of the wording "*along the side edge of the surface-contacting portion*". Figure 2 shows a stretching member within the distal side edge (end edge) of the surface-contacting portion 20. Additionally, there is shown a further stretching member within the surface-contacting portion which is slightly inboard from the end edge. No other stretching members are shown on/within the surface-contacting portion, but there are further stretching members which are positioned on/within the standing portion 10. Hence, there is no clear and unambiguous disclosure as to which side edge should be considered and what should be understood by the term "along" in relation to the "side edge".

- 4.4 Moreover, the reference in paragraph [0068] to six stretching members shown in total in the Figure concerns a particular and specific distribution of the

stretching members in both the standing portion 10 (having four stretching members, if the two non-referenced dots are included) and in the surface-contacting portion 20 (having two referenced stretching members) of the free portion of the cuff. However, claim 1 does not specify the position of all six stretching members as disclosed in the embodiment.

4.5 Hence, the wording of paragraphs [0067] and [0068] remains ambiguous also in view of the sketches of Figure 2 such that there is neither a clear and unambiguous disclosure for the claimed feature nor is the claimed feature itself clear. Thus, the requirements of Article 84 EPC and Article 123(2) EPC are not met.

4.6 Since the request was filed for the first time during oral proceedings, the provisions set out under point 1 above apply. In view of the wording with regard to the feature set out above, claim 1 at least lacks clarity and is *prima facie* not allowable. The Board therefore exercised its discretion in accordance with Article 13(1) RPBA not to admit the request into proceedings.

5. Auxiliary request VI

5.1 Claim 1 is based upon claim 1 as granted with the objected features (ii), (iii), and (iv) being deleted.

5.2 The deleted features concern structural features which give rise to the specific configuration of the article. Hence, these features provide a technical contribution in that they are essential for the function and accordingly necessary for defining the scope of

protection of claim 1. Thus, they are inextricably linked to the other structural and functional features in order to provide the article which is disclosed as having the characteristics of the defined invention. Hence, these features limit the scope of protection. Accordingly, without such features, the scope of protection is extended and the requirement of Article 123(3) EPC is not met.

6. Auxiliary request VII

Claim 1 of this request is identical to claim 1 as granted and is formulated according to the "footnote-solution", which the appellant argued was admissible under German patent practice. Such a "solution" has been excluded by the Enlarged Board of Appeal in G 1/93 (Reasons, paragraph 14) as being incompatible with the European patent system. Accordingly, such request is not allowable.

7. Auxiliary requests VIII to XI

Claim 1 of auxiliary requests VIII to XI includes feature (iii): *"wherein said stretching members (5) extend in said contacting portion (20), in the vicinity of the fold and in said standing portion (10), respectively"*.

Since claim 1 of the main request was not allowable at least having regard to Article 123(2) EPC for the reasons given above (see point 2 above), these requests are not *prima facie* allowable for the same reason, and since these requests were filed after the Board's communication annexed to the summons to oral

proceedings (see point 1 above), the Board exercised its discretion under Article 13(1) RPBA not to admit these requests into proceedings.

8. Requested referral to the Enlarged Board

8.1 The conditions in Article 112(1) EPC for referring a question to the Enlarged Board of Appeal are either that a reference is necessary to ensure a uniform application of the law or that a point of law of fundamental importance arises. Neither of these questions is met in regard to the questions (see item III above) which the appellant requested to have referred.

8.2 Concerning the alleged non-uniform application of law, this requirement in general refers to non-uniform application of the law by the Boards of Appeal: the Enlarged Board does not have the power to ensure uniform application of the law between the Boards of Appeal and national courts. A lack of uniformity between the law as applied by the Boards of Appeal and national courts could in theory bring to the fore a point of law of fundamental importance, something which is considered in the next paragraph. As to non-uniform application of the law by the Boards of Appeal, the appellant did not in fact suggest that the principles laid down in G 1/93 have not been consistently applied by the Boards of Appeal.

8.3 As to whether a point of law of fundamental importance arises, no such issue is apparent. The relevant issues have already been decided by the Enlarged Board of Appeal in G 1/93 and it has not been shown that any

legal or technical developments have occurred in the interim making it desirable in the public interest to have the issues reviewed again by the Enlarged Board: T 82/93 (OJ EPO 1996, 274). The appellant did not provide evidence that the contracting states of the EPO had not followed the principles of G 1/93 concerning the relation between Articles 123(2) and (3) EPC. The separate footnote solution applied in Germany does not support a trend in Europe but rather represents an isolated approach which in fact was held not allowable in G 1/93.

8.4 By question 2 it appears to the Board that the appellant asks a question which is in fact not related to the facts of the present case. The point is that the omitted features do make a technical contribution to the claimed subject matter since they concern the structures which give rise to the specific configuration of the article (see also point 5.2 above). The question is therefore not relevant because its premise ("while no rights can be derived from features that relate to said subject matter in the sense that said features must not be considered to delimit the subject matter over prior art but restrict the scope") does not apply.

8.5 As to question 3, irrespective of when the amendments leading to such a situation were made, the requirements of Articles 123(2)/123(3) EPC have to be met as set out in G 1/93. The issue of the amendments being made during the international phase of the application does therefore not alter the applicable case law. It is also noted that when entering the European regional phase,

the applicant was not required to proceed with any amendments it had made in the international phase.

8.6 Thus, when addressing the four questions posed by the appellant, there is no evidence for the allegation in question 1 that no contracting state of the EPC and no other country follows the approach of the EPC. The subject-matter of question 2 does not arise in the current case. Question 3 can be answered by the present Board to the effect that an application is not restricted to an amendment made at the international phase. Finally, question 4 has already been answered in item 2 of decision G 1/93.

8.7 The request for referral of a question to the Enlarged Board is thus refused.

Order

For these reasons it is decided that:

1. The appellant's request for referral of a question to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.

The Registrar

The Chairman

B. Atienza Vivancos

M. Harrison