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**Datasheet for the decision
of 30 September 2011**

Case Number: T 1389/10 - 3.2.04

Application Number: 03785962.6

Publication Number: 1576899

IPC: A45C 11/00

Language of the proceedings: EN

Title of invention:
Protective case for delicate object

Patentee:
Bastus Cortes, Pedro

Opponent:
1 IDEA ITALIA S.P.A.
Lazerbuilt Limited

Headword:
-

Relevant legal provisions:
EPC Art. 54

Relevant legal provisions (EPC 1973):
-

Keyword:
"Novelty (no - all requests)"

Decisions cited:
T 0215/84, T 0069/85, T 0523/89, T 0637/92

Catchword:
-



Case Number: T 1389/10 - 3.2.04

DECISION
of the Technical Board of Appeal 3.2.04
of 30 September 2011

Appellant: Bastus Cortes, Pedro
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 16 April 2010
revoking European patent No. 1576899 pursuant
to Article 101(2) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: A. de Vries
T. Bokor

Summary of Facts and Submissions

I. On 16 June 2009 the Appellant (Proprietor) lodged an appeal against the Opposition Division's decision of 16 April 2010 to revoke European patent No. 1 576 899 and simultaneously paid the prescribed appeal fee. The grounds of appeal were filed on 4 August 2010.

Two oppositions had been filed against the patent. Both were filed against the patent as a whole and based on Article 100(a) EPC in combination with Article 54 EPC for lack of novelty and inventive step.

The Opposition Division held that this ground prejudiced maintenance of the patent in view of the following documents among others:

D2: US-A-4 863 013
D7: US-A-2 412 087
D8: GB-A-907 207

II. The Appellant (Proprietor) requests that the decision under appeal be set aside and the patent be maintained in amended form according to a main request denoted as "new auxiliary request 2" by the Appellant, or, alternatively, according to a first auxiliary request denoted "prior auxiliary request 1" by the Appellant, both requests filed with the grounds of appeal. With letter of 23 June 2011 he also offers for consideration a number of alternative formulations of the opening lines of claim 1.

The Respondents (Opponents I and II) both request that the appeal be dismissed.

- III. With a communication pursuant to Rule 100(2) EPC issued 25 January 2011 the Board communicated to the parties its provisional observations concerning novelty and inventive step.
- IV. The wording of the claim 1 of the requests on file is as follows:

Main request ("New auxiliary request 2")

"The protective case for enclosing a delicate object, of the type of objects that are portable such as mobile phones, glasses, remote controls for electronic home appliances etc., the case comprising a tubular body formed from a circular knitted fabric (as hereinbefore defined), an elastic section suitably dimensioned to define a mouth at one end of the tubular body, and a seam that provides a permanent closure of the opposed end of the tubular body, wherein the elastic section is configured to facilitate the closure of the mouth of the tubular body preventing accidental exit of the delicate object that is contained inside the case."

First auxiliary request ("Prior Auxiliary Request 1")

Claim 1 is as in the main request but with the opening lines reading

"The protective case for enclosing a delicate object, the case comprising".

V. With regard to novelty the Appellant argued as follows:

The invention is limited to protecting small and delicate objects, mainly hand-held electronic devices, such as mobile phones. Though this is already immediately clear from the specification, the amendments of the main request attempt to further clarify this.

The items in D2, D7 and D8 have a different use, and it makes no sense to consider these fields inside the original wording of the patent's claim 1 because parts of the body are not really objects or "delicate objects". The alternative formulations are intended to avoid such prior art which is utterly unrelated to the object of the invention.

Further, the invention does not claim a generic protective case nor a case for any kind of delicate object, nor any case for delicate objects made of knitted fabric. Rather it claims a specially constructed knitted fabric case for phones that holds the phone loosely and has an elastic band closure to prevent accidental exiting of the phone. This is a non-obvious goal which cannot be achieved by prior art items in unrelated fields such as socks where there is no such need. The novelty objections are based mainly on a reading of the claim far beyond its essential purposes.

VI. The Respondent-Opponent I argued as follows regarding novelty:

The contents of the claimed case are not a distinctive feature of the case itself. The Appellant's arguments are however directed towards the contents not the case.

VII. The Respondent-Opponent II added the following arguments:

The mention of portable delicate objects does not impose any clear limitations on the size of the case. Socks will be of a size suitable for use with mobile phones, glasses, remote controls etc. Without any clear size limitation claim 1 (main, first auxiliary request) is also anticipated by D8. Even if the amendment in the main request were to imply some size restriction, that limitation does not exclude the articles described in D7.

Nor is there any requirement in the claim that the body of the case not be elastic.

Reasons for the Decision

1. The appeal is admissible.
2. *Interpretation of Indefinite Requests*

In the letter of 23 June 2011, page 2/6, final paragraph, the Appellant states that "[he] would be willing to accept any other more accurate wording that would refine further the concept to English speakers.

Maybe something along the following lines" and then on page 3/6 offers the following four alternative versions of the opening lines of claim 1 (using the Appellant's notation):

I: "A protective case for enclosing mobile phones, glasses, remote controls for electronic home appliances and any other portable objects"

II: "A protective case for enclosing mobile phones, remote controls for electronic home appliances and any other electronic portable objects "

III: "A protective case for enclosing mobile phones and other electronic portable objects"

IV: "A mobile phone protective case".

The Board notes firstly that in particular in inter partes appeal proceedings, where impartiality of the Board is fundamental to due process and the principle of fairness, it is not incumbent on the Board to make suggestions as to claim wording. That responsibility must remain firmly with the Appellant. The Board shall, however, in the following consider these alternative formulations as like numbered auxiliary requests - i.e. auxiliary requests I to IV - each directed at a correspondingly amended claim 1.

3. *Background & Claim Interpretation*

3.1 The patent is directed at a protective case for delicate objects - in particular portable objects such as mobile phones, glasses, remote controls. The case is

defined by its constructional features of a *tubular* body of *circular knitted fabric* which has an elastic section defining a mouth at one end, and a closing seam at the other end. The use of knitted fabric protects the delicate objects from damage by banging or scratching, while the elastic mouth section prevents them from accidentally slipping out, see specification section [0005].

- 3.2 As stated in the Board's communication of 25 January 2011, it is long standing office practice that a formulation such as "apparatus for" is to be interpreted as meaning an apparatus which is *suited* for the stated use, see for example the Guidelines C-III.4.13, see also T 69/85, reasons 2.2.8. As explained in the Guidelines, as e.g. in the case of a mould for molten steel, the stated use may imply certain physical limitations (size, material) without which the apparatus could not be used for that purpose. Any prior art apparatus which, in addition to features expressly mentioned in the claim also possesses these implicit physical features and can thus reasonably be used for the stated purpose will then take away novelty of the claimed apparatus. This is irrespective of whether or not *the prior art mentions the stated use or purpose or whether the stated use is obvious or not*. This is because the claim is directed at the apparatus, not its use. Nor can stating a use that is new and not-obvious render an apparatus which is already known novel and inventive, see also the Case Law of the Boards of Appeal, 6th edition 2010, I.C.5.3.3 and the case law cited therein, in particular T 215/84, T 523/89, T 637/92.

- 3.2.1 The various versions of claim 1 are all directed at a *protective case* defined by the same physical features: circularly knitted, tubular body, elastic mouth section at one end, closing seam at the other. Undoubtedly, these features define the claimed subject-matter as an apparatus or device, i.e. as a physical object. Its intended use lies in the indication that it is a "*protective case for delicate objects*", with the particular objects limited in varying degree in the different requests. In the final auxiliary request claim 1 is to "a mobile phone protective case", which the Board reads as equivalent to "a protective case for mobile phones".
- 3.2.2 This intended use will imply certain properties of the knitted material to be able to protect a delicate object or mobile phone. For example, the material should be soft and not abrasive. It also implies an appropriate size of the article to accommodate the object/phone within it.
- 3.2.3 Using the usual rules of construction, in particular those concerning intended use or purpose of an apparatus, the Board then arrives at a construction of claim 1 as directed at any article that has a circularly knitted, tubular body, with an elastic mouth section at one end and closed by a seam at the other, and which is made of appropriate material and has an appropriate size so that it can be used as a protective case for the objects in question.

4. *Lack of Novelty*

4.1 With the above understanding of claim 1 the Board must then, in assessing novelty, determine whether any of the cited prior art discloses articles with all the above features, explicit and implicit, and which therefore could conceivably be used as a protective case for the objects concerned, even that use is not foreseen in that prior art, see above.

4.2 Turning first to D2, this document concerns a protective receptacle for *spectacles*, see title. The receptacle, shown in figure 1, comprises an envelope formed from a *tube*, i.e. a *tubular body*, column 4, line 10, which may be *formed of knitted material*, column 4, lines 28 to 29, see also column 6, lines 8 to 10. The tube is continuously knitted (without a seam) at its circumference, as is clearest from the cross-sections 5 and 7 in particular, meaning that when knitted, it must be *circularly knitted*. Either end 21A or 21B can be sewn closed, column 4, lines 17 and 18, thus forming a *seam providing a permanent closure at one end*. The other (not sewn) end may have "an end closure such as a tightly woven end portion [as in figures 1 and 2] as a tapered or a restricted end", column 4, lines 21 to 24. This is clearly meant to *facilitate closure* and has the same function as the alternative closures of figures 7A to 7C, *namely to prevent the spectacles from accidentally exiting*. As explained in column 4, lines 28 to 34, the envelope material is elastic so as to expand to accept the spectacles, and thereafter contract to engage them. This applies naturally also to the *end section*, which,

is also *elastic*, in particular if the material is knitted.

The material is so as to protect spectacles within the tube, e.g. wool or cotton, column 4, line 30. Similarly, it goes without saying that this receptacle which is specifically meant for spectacles will be sized accordingly. Spectacles or glasses, the Board notes, are expressly mentioned in the patent, see specification paragraph [0001] as an example of a delicate object that the case should protect.

In summary, the receptacle of D2 has all the physical features that are expressly mentioned in all versions of claim 1. It also has those implicit in the use stated in claim 1 of the *main, first auxiliary and auxiliary request I*, which all mention glasses as delicate object. This is only natural as the D2 receptacle is also meant to protect and hold glasses.

If perhaps spacious for a relatively small mobile phone, the D2 receptacle could nevertheless also hold and protect remote controls or other electronic portable devices such as a portable game console, that are of the same size as a pair of glasses. It thus also meets the size requirement implicit in the limited use stated in claim 1 of *auxiliary requests II and III*.

The Board concludes that the case of claim 1 of the main and first auxiliary request and of auxiliary requests I to III lacks novelty vis-à-vis the protective spectacle receptacle of D2.

4.3 D7, see its opening paragraph, relates to a knitted article intended to cover the toe portion of a foot. The article, shown in figures 1 to 3, has a seamless or *circular[ly] knit main body* 10, column 2, lines 5 to 6, produced in the form of a *tubular* fabric on a circular knitting machine, column 2, lines 26 to 28, i.e. is an essentially *tubular body*. It has a cuff or welt 13 at one open end, column 2, line 29, which may have elastic yarn incorporated, column 3, lines 10 to 11, and thus forms an *elastic end section defining a mouth*. At the other toe end the tube is closed as described in column 2, lines 36 to 40, to form what is effectively a *seam* 21 as *permanent closure*, see also the figures.

The size and material of the sock are intended to protect the toes of a foot. Even though D7 does not mention such a use, its sock has all the features that allow it be used to hold and protect a mobile phone, a portable electronic device or any other delicate object of about the same size as the toe portion of a foot. The elastic cuff or welt 13 would then prevent the object from slipping out accidentally.

The subject-matter of claim 1 in *all versions* lacks novelty over the toe sock of D7.

4.4 Finally, D8 describes an undersock or foot cover, see title, shown in figures 3,4. This undersock is formed of a knitted tube 1 formed on a circular knitting machine, page 2, lines 1 to 4, i.e. a *circularly knitted tube*. A rubber thread 2 is knitted into open rim 2, page 2, lines 6 to 10, figure 3, forming an *elastic section defining a mouth at the tube's open end*.

At the other end it is closed by a *seam* 10, page 2, line 57 to 61, figure 3, providing *permanent closure*.

Dimensions are in the order of several centimetres, page 2, lines 19 to 21, and the material can be a crimped or stretch yarn, page 2, lines 62 to 64, making the sock extremely elastic and extensible, page 2, lines 76 and 77, so that it can fit over a foot. D8 also does not mention its use as a protective case for delicate objects. However, it has all the features that would allow it be used that way. Thus, it can hold and protect, say, a mobile phone or other portable electronic device that easily fits inside the stretchable material and stays inside due to the elasticized rim section.

This known undersock thus also takes away the novelty of claim 1 *in any of its versions*.

- 4.5 None of the proposed versions of claim 1 include a limitation, explicit or implicit, that the case is specially constructed to loosely hold a (mobile) phone, and the Board can thus not take this feature in consideration when assessing novelty of the case as claimed. However, even if claim 1 had been so limited, given the small size of many mobile phones, the toe sock of D7 meant to cover the front portion of the foot, see figure 1, would most likely meet that limitation for such phones. Vis-à-vis D7 this feature would therefore not be able to establish novelty.
5. As set out above, the subject-matter of claim 1 in all its versions lacks novelty, contrary to Article 52(1) in combination with Article 54 EPC. None of the

requests on file are therefore allowable and the Board thus confirms the Opposition Division's decision to revoke the patent.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

G. Magouliotis

M. Ceyte