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**Datasheet for the decision
of 2 June 2016**

Case Number: T 2259/11 - 3.2.06

Application Number: 97903043.4

Publication Number: 0955833

IPC: A46B9/04

Language of the proceedings: EN

Title of invention:

A TOOTHBRUSH WITH ELASTOMER FILLED FLEXIBLE HEAD

Patent Proprietor:

THE PROCTER & GAMBLE COMPANY

Opponent:

Trisa Holding AG

Relevant legal provisions:

RPBA Art. 12(4)
EPC Art. 54(3), 111(1)

Keyword:

Auxiliary request - admitted
Novelty - claim 1 over documents cited under Article 54 (3)
EPC - (yes)
Remittal to the department of first instance



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Case Number: T 2259/11 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 2 June 2016

Appellant: THE PROCTER & GAMBLE COMPANY
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 19 August 2011
revoking European patent No. 0955833 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. Harrison
Members: G. de Crignis
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. European patent No. 0 955 833 was revoked by the opposition division by way of its decision posted on 19 August 2011.

- II. The opposition division held that the ground of opposition under Article 100(a) EPC was prejudicial to maintenance of the patent since the subject-matter of claim 1 lacked novelty in view of
D1 EP 0 976 345 and
D2 WO-A-97/24949
each of which was prior art under Article 54(3) EPC.

- III. The appellant (patent proprietor) filed an appeal against this decision and paid the appeal fee. In its statement setting out the grounds of appeal, the appellant requested that the decision of the opposition division be set aside and the patent be maintained as granted; in the alternative, that the patent be maintained on the basis of one of the first to sixth auxiliary requests submitted therewith.

- IV. The Board summoned the parties to oral proceedings. With its communication dated 24 March 2016, the Board indicated its provisional opinion that D1 disclosed the subject-matter of claim 1 of the main request and that admittance of the auxiliary requests appeared to require discussion.

- V. Oral proceedings were held before the Board on 2 June 2016. After the Board reached a conclusion that the subject-matter of claim 1 as granted lacked novelty over D1, the appellant withdrew this (main) request and made the previously filed first auxiliary request the new main request.

The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request, or on the basis of one of auxiliary requests 2 to 6 as submitted with the grounds of appeal.

The respondent (opponent) requested that the appeal be dismissed, or the case be remitted to the department of first instance.

VI. Claim 1 of the main request reads as follows:

"A toothbrush, comprising:

i) an elongated handle having distal and proximal ends and one or more elastomeric handle regions therein; and
ii) a resiliently flexible head attached to the proximal end of the handle, the head including a pair of opposing faces, one of the pair being a bristle-bearing face with bristles attached to and extending from the face, the bristles being made of polyester or nylon, wherein at least one of the pair has one or more elastomer-containing, transverse grooves therein; and
iii) one or more elastomer supply channels extending between the elastomeric handle regions and the transverse grooves,
whereby at least one of the elastomeric handle regions and the transverse grooves can be filled with elastomer from a single injection point."

The wording of auxiliary requests 2 to 6 is not quoted here, since these requests are not relevant to the decision.

VII. The appellant essentially argued:

The auxiliary requests submitted with the grounds of appeal should be admitted. Having had a legitimate expectation after filing the opposition response that a further opportunity would be given to respond to alleged facts extending beyond those set out by the opponent, Article 113(1) EPC had not been respected in the first instance. The submission of the auxiliary requests together with the grounds of appeal was a reasonable response to the development of the proceedings. The filing of the appeal represented the first opportunity to respond to the opposition division's expanded reasoning. The auxiliary requests were filed with the comment and intention that they should distinguish the invention from the prior art under Article 54(3) EPC.

Concerning former auxiliary request 1, which was now the main request, no new case had been presented, since the discussion even on inventive step would be the same - as the appellant had anyway admitted that the additional feature included in claim 1 was itself not inventive. Hence, the respondent had had sufficient opportunity to prepare its case as that preparation did not involve further issues. There were no objections to remittal of the case, which appeared suitable due to the other lines of attack.

The subject-matter of claim 1 was novel. Neither D1 nor D2 disclosed the material of the bristles as defined in claim 1. The skilled person was aware of the use of other polymeric fibres as well as natural fibres for bristles, both of which were suitable for the toothbrushes of D1 and D2.

D1, when referring to the use of conventional staple technology, was only concerned about the manufacturing

method; this reference did not imply the use of any specific bristle material. The method was only referred to in contrast to ultrasonic bonding, adhesive bonding or other mechanical fastening methods. D1 was concerned with the flexibility of the head but not with the material of the fibre tufts. It was not inherent, and there was no evidence whatsoever, that e.g. natural bristles should be excluded. The skilled person would thus not consider its disclosure to be limited to bristles of nylon or polyester.

D9: US-A-4 263 691,

which was published in 1981, provided evidence for other synthetic materials for bristles being known.

D2 also did not disclose the use of either of the bristle materials claimed.

It was appropriate to remit the case to the opposition division for further prosecution, as had been requested by the respondent.

VIII. The respondent essentially argued:

Auxiliary request 1 (now the main request) and auxiliary requests 2 to 6 should not be admitted (Article 12(4) RPBA). During the opposition proceedings, no auxiliary requests were filed. Also no oral proceedings had been requested. The novelty objections concerning D1 and D2 had been filed comprehensively and completely already at this stage of the proceedings. All the reasons given by the opposition division for revoking the patent were based upon the objections set out in the grounds of opposition and were well founded. The right to be heard

was always respected, and the patent proprietor had had the opportunity to provide its arguments.

No reasons were given in the statement of the grounds of appeal why the auxiliary requests overcame the objections raised.

D1 as well as D2 disclosed all features of claim 1.

Moreover, the material of the bristles was not the subject of the search. It did not concern the inventive concept either. Nylon as well as polyester were always used in conventional staple technology for assembling bristles in tooth brushes, whereas for natural fibres other technologies would have been used. The skilled person knew that conventionally toothbrushes were manufactured with bristles made of nylon. This represented merely the state of the art and was common background knowledge at the date of filing of the patent in suit. Therefore, this feature was to be read implicitly in each toothbrush-publication D1 and D2. Although bristles of other materials were known, these bristles were used for other brushes and they were not applied via conventional staple technology.

Accordingly, the manufacturing technology disclosed in paragraph 23 of D1 was implicitly a clear and unambiguous disclosure of polyester or nylon, such that the subject-matter of claim 1 was not novel. Hence, the novelty objection in view of D1 and in view of D2 made in regard to the previous main request was still valid.

Concerning the materials for the bristles in D2, the skilled person implicitly included the background knowledge that nylon and polyesters were to be used for conventional toothbrushes in the same way as for D1.

Nylon was also mentioned in D9, although in combination with other polymers.

If found novel, the case should be remitted to the opposition division for further prosecution.

Reasons for the Decision

1. Admittance - Auxiliary requests

1.1 According to Article 12(4) RPBA, without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings, everything presented by the parties under Article 12(1) RPBA [*statement of grounds/reply*] shall be taken into account by the Board to the extent it relates to the case and meets the requirement in Article 12(2) RPBA [*substantiation*]. In other words, the principle is to admit what is presented with the statement of grounds and the exception is not to admit what could have been presented in the first instance proceedings.

1.2 An automatic refusal of the requests whenever they "could" have been filed before the opposition division would contravene (a) Article 12(4) RPBA itself which leaves discretion to the Boards, (b) Article 114 EPC which also provides a discretion in admitting late filed documents, Article 12(4) being an implementation of this Article and (c) to some extent the exercise of the right of appeal if the requests may be considered as part of the defence, in particular when the new requests may indeed remedy (or are an attempt to

remedy) a weak point which became apparent before the department of first instance; these requests may be seen as part of the substantiation of the reasons to set aside the decision. On the other hand another of the purposes of Article 12(4) RPBA is to deter parties from (mis)using the procedure in order to e.g. delay the outcome of the case or shift the decision to a further instance (forum shopping).

- 1.3 Accordingly, in the current case, the Board has to reach a finding on whether the new requests were filed as a mere tactical calculation by the appellant to save time or for other tactical reasons, or whether they were a good faith attempt to repair a mere mistake in assessing its case made during the first instance proceedings, and whether this possible mistake justified the admissibility of the requests.
- 1.4 The appellant said that the failure to request oral proceedings had (1) been a clerical error, but it also argued (2) that it was so confident of the outcome of the decision, due to the case that had been made, that it did not file auxiliary requests. Additionally, it set out in the appeal proceedings that in its view, the decision of the opposition division went significantly beyond the opponent's grounds of opposition and the arguments in support of those grounds since it considered the decision was based mainly on arguments developed by reference to a second alternative and related to implicit disclosure (3) not brought forward by the opponent.
- 1.5 As to the argument (3), the Board finds that the decision of the opposition division did not go beyond the opponent's grounds of opposition, and no violation of the right to be heard occurred, but it cannot be

overlooked that the reasons for the decision concerning the novelty objection for example with regard to D1 rely on reference to the alternative embodiment disclosed in paragraph [0023] of D1, which was mentioned very briefly by the opponent, without specifying in detail the relevance of this paragraph. Indeed, during opposition proceedings, the proprietor gave a detailed response stating how a skilled person could understand the disclosure of D1 and why lack of novelty could not be assumed.

- 1.6 Obviously, the appellant was unwise in arriving at its decision (2) (see point 1.4 above), and the alleged clerical error (item (1) in point 1.4 above) made this situation worse. However, that this course of action was the result of a deliberate action on the part of the appellant to shift the case to the board of appeal, or to gain time, or for another tactical reason, is a further conclusion that the Board cannot make in the absence of any hint towards this intention. To do so would be pure speculation. Considering the circumstances as they stand, it remains in doubt whether the appellant's behaviour was minded to delay the proceedings or was a pure error of judgment/assessment concerning the validity of its patent.

- 1.7 In the absence of any evidence of any such abuse of procedure, the contention of the appellant that the statement of ground was the first opportunity to react to the decision, and in particular to the analysis given in the decision which had not been part of the opponent's arguments, becomes important. The opposition division had not sent any communication and the appellant chose an undoubtedly dangerous course of action in expecting this and from refraining from filing an auxiliary request. To punish the appellant by

immediately rejecting all the new requests in the present case, without giving it the benefit of the doubt would nevertheless amount to depriving it of its right of effective appeal, which the Board considers normally encompasses the right to remedy errors in the defence of the patent provided that such errors were indeed simply errors and not a procedural tactic.

1.8 Accordingly, the filing of auxiliary request 1 represents a reasonable response to the development of the proceedings. Also, no new case was made in regard to inventive step, since any discussion of this, given the cited prior art, would be the same, as it was admitted by the appellant that the additional feature included in claim 1 of auxiliary request 1 - now main request - did not alter its inventive step arguments. Hence, the opponent/respondent had enough time to prepare the case as the preparation did not include further issues.

1.9 Although six auxiliary requests were filed, the Board only exercised its discretion to admit auxiliary request 1 (new main request).

2. *Main request - claim 1 - Article 123 EPC*

Compared to claim 1 as granted, this request additionally includes the feature "the bristles being made of polyester or nylon". This feature is based on the application as filed, page 9, lines 26/27.

No objections concerning the requirements of Article 123(2) and (3) EPC were raised. The Board is also satisfied that the amended feature is disclosed in the originally filed description as pertaining generally to the bristles of the tooth brush head and also that its

insertion into claim 1 represents a limitation of the scope of the claim.

3. *Main Request - claim 1 - novelty - D1*

3.1 D1 does not disclose the feature of claim 1 that the bristles are made of polyester or nylon. For this reason, the subject-matter of claim 1 is novel over D1.

3.2 Although the skilled person reads the prior art while relying on common general knowledge in the field, no evidence has been provided that only nylon or polyester were the materials used for tufts of bristles in conventional toothbrushes, albeit the Board and the appellant accept that these materials are the most common.

3.3 In this regard, the appellant referred to D9 (which document had already been cited in the opposition proceedings for different reasons), which document was published in 1981 and discloses a toothbrush having bristles made of a core which is made of a hard thermoplastic material such as nylon 6 or high-density polyethylene and of a sheath which is made of a softer material such as ethylene vinyl acetate co-polymer, polyethylene or poly-vinyl chloride, or of natural or synthetic rubber. Accordingly, D9 provides evidence for synthetic materials other than nylon or polyester being applied for the same purpose before the priority date. It should be noted that the respondent made no objection to the appellant's reference to D9 in this regard. The Board also considered it appropriate as it was not complex and served the purpose of clarifying whether further bristle materials could have been considered in the context of D1.

- 3.4 The respondent's argument that in 1996 (priority year of the patent in suit) only nylon and polyesters would have been used, lacks any supporting evidence. Accordingly, the skilled person could indeed have used a variety of polymeric materials for the bristles in D1 and the limitation of claim 1 to the bristles being made of polyester or nylon represents a specific selection from such materials which renders the subject-matter of claim 1 novel.
- 3.5 The respondent's argument that the skilled person inevitably considered nylon as the mainly used material in view of the historical development of bristles for toothbrushes is not denied. However, in view of the possibility to select other materials, and D1 not referring to any material at all, nor a requirement to inherently require those particular materials, no clear and unambiguous disclosure of nylon and polyester is present therein.
- 3.6 Concerning the respondent's argument that conventional staple technology for assembling the bristles in tooth brushes as disclosed in paragraph [0023] of D1 was applied exclusively for nylon and polyester, whereas for natural fibres other assembling technologies were to be considered, this argument is not accepted since the disclosure in D1 (reading that the "head may then be tufted using conventional staple technology") does not exclude other technologies being applicable. No further evidence in this respect was submitted either.
- 3.7 The appellant's contention that D1 fails to disclose further features of claim 1 is, however, not accepted, but for the purposes of this decision irrelevant.

4. *Main Request - claim 1 - novelty - D2*

Equally, D2 does not disclose the feature of claim 1 that the bristles are made of polyester or nylon. At least for this reason, the subject-matter of claim 1 is novel over D2 and points 3.2 to 3.5 set out above apply as well. No further separate arguments in this regard were made by the respondent.

5. *Remittal of the case for further prosecution*

5.1 Accordingly, as a result of the amendment made to independent claim 1, the Board finds that the objection of lack of novelty to granted claim 1 is overcome by claim 1 of the new main request. This was also the sole reason leading to revocation of the patent by the opposition division, and further this was based on documents which are prior art only under Article 54(3) EPC (i.e. D1 and D2).

5.2 The respondent requested that the case be remitted to the opposition division for further prosecution and the appellant had no objection to this. In view of the fact that the new main request was filed in the appeal proceedings in order to overcome the above-mentioned objection only, the Board concludes that under the present circumstances it is not appropriate to reach a decision in the appeal proceedings on the matter of novelty concerning different prior art nor on the matter of inventive step for the first time.

5.3 For these reasons, the Board decides, in the exercise of its discretion conferred by Article 111(1) EPC and on the basis of the new main request, to remit the case to the opposition division for further prosecution of the opposition.

Order

For these reasons it is decided that:

- The decision under appeal is set aside.
- The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated