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**Datasheet for the decision
of 30 March 2017**

Case Number: T 0075/14 - 3.2.03

Application Number: 01978742.3

Publication Number: 1368594

IPC: F23Q2/16

Language of the proceedings: EN

Title of invention:
CHILD RESISTANT GAS LIGHTERS

Patent Proprietor:
Swedish Match Lighters B.V.

Opponent:
FLAMAGAS S.A.

Headword:
Disclaimer -requirements of G0001/03 (no)

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

Keyword:
Amendments - added subject-matter (yes)
Late-filed auxiliary requests - admitted (no)

Decisions cited:

G 0001/03

Catchword:



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Case Number: T 0075/14 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 30 March 2017

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 8 October 2013 revoking European patent No. 1368594 pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman G. Ashley
Members: C. Donnelly
E. Kossonakou

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division revoking European Patent No. 1 368 594.

In its decision the opposition division held that the non-disclosed disclaimer introduced into claim 1 of the main request and auxiliary requests 1 to 3 to restore novelty with respect to the prior art document under Article 54(3) WO 02/055934 A1 (D3) removed more subject-matter than necessary and therefore was not allowable according to the case law as given in G1/03.

- II. The patent-proprietor (hereinafter: the "appellant") filed an appeal against this decision in due time and form.

- III. In a communication pursuant to Article 15(1) RPBA, annexed to the summons to oral proceedings, the Board informed the parties of its provisional opinion.

- IV. Oral proceedings before the Board were held on 30 March 2017. At the end of the debate the parties confirmed their requests as follows:

The appellant requested that the decision under appeal be set aside and the patent maintained as granted (main request), alternatively, that the patent be maintained in amended form on the basis of auxiliary request 1 (corresponding to auxiliary request 4 filed in the opposition proceedings), or on the basis of auxiliary request 2 (filed with the grounds of appeal).

The respondent (opponent) requested that the appeal be dismissed.

V. Claim 1 as granted reads:

"A child resistant roll-and-press gas lighter including a lighter body (1), a lever (12) for controlling the flow of gas from the lighter, a wheel assembly (13) rotatably mounted on the body, and a flint (17) cooperating with the wheel assembly for igniting the gas, the wheel assembly comprising a sparkwheel means (15) together with thumbwheel means (16), said thumbwheel means including a digit engaging surface (16'),
the lighter further comprising an impeding element (26) mounted adjacent the thumbwheel means such that as the user contacts the wheel assembly, an engaging surface (26') of the impeding element is engaged by the user's digit, wherein the engaging surface (26') of the impeding element is substantially flush with the digit engaging surface (16') of the thumbwheel means which in use is engaged by the user's digit,
characterised in that the thumbwheel means (16) does not have an association in which the thumbwheel means (16) is movable with respect to the sparkwheel means (15)."

Claim 1 of the auxiliary request corresponding to auxiliary request 4 filed during the opposition proceedings is the same as granted claim 1 except the characterising portion has been amended to read:

"characterised in that the thumbwheel means (16) only have an association in which the thumbwheel means (16) are movable together with the sparkwheel means (15)".

In claim 1 of the auxiliary request filed with the grounds of appeal the characterising portion of claim 1 has been amended to read:

"characterized in that the child resistant lighter not comprising:
a sparker configured and adapted to produce spark; a cover configured and adapted to substantially prevent operational contact of the sparker by a user during actuation of the sparker; and at least one manipulable member configured and adapted for manipulation and movement by a user; wherein the manipulable member has at least two associations with the sparker, including a first association in which the manipulable member is movable with respect to the sparker, and an operable association in which the manipulable member moves the sparker."

In claim 1 of the auxiliary request filed during the oral proceedings the characterising portion of claim 1 has been amended to read:

"characterized in that the thumbwheel means (16) is immovable with respect to the sparkwheel means (15)."

VI. The submissions of the parties relevant to the decision can be summarised as follows:

(a) Appellant

Main request (claim 1 as granted)

D3 only discloses a spark generating device which includes a manipulable member that is configured to have at least two associations with the sparker. Thus, the disclaimer which reads:

"the thumbwheel means (16) does not have an association in which the thumbwheel means (16) is movable with respect to the sparkwheel means (15)."

has been correctly formulated since it clearly expresses, in the language of D3, that the thumbwheel means is fixed to the sparkwheel.

In the present case, it is not possible to exclude specific embodiments. Such a claim would be unclear within the meaning of Article 84 EPC since it would place an unreasonable burden on the skilled person to understand the subject-matter. Therefore, the disclaimer meets the requirements of G1/03 since it strikes a reasonable balance between the requirement not to remove more subject-matter than is necessary and the need to maintain conciseness and clarity.

Auxiliary request 1.

The characterising portion of claim 1 reading:

"characterised in that the thumbwheel means (16) only have an association in which the thumbwheel means (16) are movable together with the sparkwheel means (15)".

clearly defines a "monobloc" arrangement which is originally disclosed, thus the requirements of Article 123(2) EPC are met.

A disclosure may be explicit or implicit provided it meets the requirement that it is directly derivable by the skilled person. In the description of the application as filed there are many indications that the lighter is of the "monobloc" type:

- page, line 1 refers to "gas lighters of the roll and press type";
- page 1, lines 8 to 9 refers to "a sparkwheel disposed between two thumbwheels";
- page 7, lines 6 to 9 states "The sparkwheel assembly comprises sparkwheel means, comprising a spark-wheel 15, disposed between thumbwheel means comprising two thumb-wheels 16";
- page 7, line 12 refers to "The sparkwheel assembly mounted on an axle 31 rotating in a pair of holes 70 in the ears 30";
- page 9, line 5 "The lighter is operated in the same way as a conventional roll-and-press lighter";
- page 9, line 21 "to rotate the wheel assembly the use must first overcome the frictional resistance inherent in the ordinary construction of a roll-and-press lighter."

No other arrangements are hinted at. The possibility of alternative arrangements not explicitly specified could only be the product of speculation and would be rejected by the skilled person in favour of the conventional and most economic arrangement which does not require specifying in detail in view of its commonality.

In its notice of opposition at pages 5, 6 and 7, the respondent was also of the opinion that nothing other than a monobloc arrangement could be meant.

US 5 096 414 (N7), referred to by the opposition division and the respondent, does not disclose a wheel assembly comprising a sparkwheel means together with a thumbwheel means since the "plates" 7,8 are freely rotatable with respect to the spark-wheel means 6.

Therefore, they do not have the same function as conventional lighter thumbwheels and cannot be defined as such.

Auxiliary request 2, Article 123(3) EPC

This request introduces the wording of claim 1 of D3 as the disclaimer and therefore overcomes any objection that more subject-matter than necessary is removed.

Auxiliary request filed during the oral proceedings.

The request should be admitted since it is in direct response to issues raised during the oral proceedings and overcomes all objections.

(b) Respondent

Main request

The present disclaimer not only excludes lighters where there are two associations, but also all those with any association in which the thumbwheel is "movable" with respect to the sparkwheel means. Consequently, devices which are totally distant from D3 are excluded. For example the lighter of US 5 096 414 (N7), in which the thumbwheel means 7,8 are freely rotatable with respect to the spark-wheel means 6, is excluded. Other types of lighter which are unnecessarily disclaimed include arrangements where there is a conical friction coupling between the sparkwheel, or an arrangement in which the sparkwheel or thumbwheel is mounted in a vertical groove to allow relative movement.

In conclusion, the disclaimer removes all possible embodiments in which the thumbwheel is movable with

respect to the sparkwheel, including arrangements not disclosed in D3.

Auxiliary request 1

The auxiliary request does not specify a "monobloc" arrangement. The feature:

"the thumbwheel means only have an association in which the thumbwheel means are movable together with the sparkwheel means."

covers more than a monobloc mechanism since the term "movable" includes all kinds movement and is not restricted to rotation. Several types of lighters exist where there is movement other than rotation. For example, the sparkwheel assembly may be mounted in a vertical groove in which it can move, or a system of gears could be used, or some kind of friction arrangement using a conical connection which would allow a sliding movement.

Thus, the requirements of Article 123(2) EPC are not met since the claim includes devices other than the monobloc arrangement which were not originally disclosed.

Also, the positive feature introduced into this request is not unambiguously and directly derivable from the original application as reasoned by the opposition division in its decision.

Auxiliary request 2, Article 123(3) EPC

Since the disclaimer has been narrowed in scope the subject-matter remaining within the scope of the claim must have been extended. Consequently, the requirements of Article 123(3) EPC are not met.

Auxiliary request filed during the oral proceedings.

The request should not be admitted into the proceedings, since it is extremely late filed and may well raise problems as regards Articles 84 and 123(3) EPC. In any case, the late admittance would place the respondent under undue stress to analyse the full implication of the amendment in a short space of time.

Reasons for the Decision

1. *Allowability of disclaimers*

According to G1/03, a disclaimer which does not have a basis in the application as filed may be allowable in order to restore novelty by delimiting a claim against state of the art under Article 54(3) EPC, such as D3 in the present case, (see Headnote, point 2.1). However, G1/03 also stipulates amongst other criteria (see Headnote, points 2.2 and 2.4) that:

- (i) a disclaimer should not remove more than is necessary to restore novelty;
- (ii) a claim containing a disclaimer must meet the requirements of clarity and conciseness of Article 84 EPC.

2. *Main request*

2.1 The main request comprises the following disclaimer:

"the thumbwheel means (16) does not have an association in which the thumbwheel means (16) is movable with respect to the sparkwheel means (15)."

This characteristic is not disclosed in the application as filed, thus the requirements of G1/03 apply.

2.2 D3 discloses several variants of a lighter with various designs for resisting undesired operation by unintended users. The embodiments illustrated in figures 1 to 4 and figure 6 of D3 disclose in the terms of claim 1 as granted:

a child resistant roll-and-press gas lighter including a lighter body (22), a lever (28,36) for controlling the flow of gas from the lighter, a wheel assembly (23) rotatably mounted on the body, and a flint (24) cooperating with the wheel assembly for igniting the gas, the wheel assembly comprising a sparkwheel means (96) together with thumbwheel means (98), said thumbwheel means including a digit engaging surface, the lighter further comprising an impeding element ("guard" 119) mounted adjacent the thumbwheel means such that as the user contacts the wheel assembly, an engaging surface of the impeding element is engaged by the user's digit, wherein the engaging surface of the impeding element (119; 219) is substantially flush (see page 8, lines 16 to 17; page 9, lines 18 to 19) with the digit engaging surface of the thumbwheel means which in use is engaged by the user's digit.

- 2.3 Therefore, the disclaimer has only been used to establish novelty in accordance with G1/03. It remains to be seen therefore whether it has been correctly formulated not to remove more than is necessary to restore novelty and is clear and concise.
- 2.4 All embodiments of D3 comprise a manipulable member with at least two associations with the sparker; a first disengaged association in which the manipulable member is movable with respect to the sparker, and preferably freely rotatable with respect to the sparker, and an operable association in which the manipulable member moves, and preferably rotates, the sparker (see page 2, lines 3 to 9 and claim 1 of D3).
- 2.5 However, the disclaimer of granted claim 1 is not restricted to excluding lighters where there are at least two associations between the thumbwheel ("manipulable member") and the sparkwheel, as is disclosed in D3, but rather is formulated to remove just one of those associations, namely where the manipulable member is movable independently of the sparker. As a result, any lighter in which the thumbwheel is "movable" with respect to the sparkwheel means is excluded, regardless of whether it is part of a mechanism with just two associations or not. Consequently, devices which comprise one or even possibly three associations and which are not disclosed or even hinted at in D3, are excluded.
- 2.6 In particular, the lighter of US 5 096 414 (N7) comprises "plates" 7,8 which are freely rotatable with respect to the spark-wheel means 6 (see Abstract). Since the plates 7,8 are turned by the user's thumb and act to resist undesired operation by children who do

not have the necessary thumb flesh thickness to reach spark wheel 6, the board considers these to be thumbwheels even though they do not perform the function of rotating the spark-wheel. Thus, N7 discloses a particular kind of child safety mechanism, relying on freely rotatable thumbwheel means, which is completely remote from D3, but which would nevertheless be excluded by the present disclaimer. Other possible types of lighter which are unnecessarily disclaimed include arrangements with one association using a ratchet and/or gearing allowing movement in one direction.

2.7 Since the disclaimer removes all possible embodiments in which the thumbwheel is movable with respect to the sparkwheel, including arrangements not disclosed in D3, it removes more subject-matter than is necessary to restore novelty. Therefore, it does not meet the criteria for assessing the allowability of a disclaimer which is not disclosed in the application as filed, as set out in decision G1/03 (see Headnote, point 2.2).

2.8 Considering that it has already been concluded on the above basis that the disclaimer removes more subject-matter than is necessary to restore novelty, the board sees no need to also examine whether the disclaimer should have been restricted further by features common to each novelty destroying embodiment as held by the opposition division.

2.9 The case pending before the Enlarged Board under referral number G1/16 asks the following question:

"Is the standard referred to in G2/10 for the allowability of disclosed disclaimers under Article 123(2) EPC, i.e. whether the skilled person would,

using common general knowledge, regard the subject-matter remaining in the claim after the introduction of the disclaimer as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed, also to be applied to claims containing undisclosed disclaimers?"

2.10 However, considering that the disclaimer in this case does not meet the fundamental requirements of G1/03, because it removes more than is necessary to restore novelty, there is no need to stay proceedings and await the decision in G1/16.

3. *Auxiliary Request 1*

3.1 Contrary to the opinion of the opposition division, the appellant has argued that the original application directly and unambiguously discloses a lighter with a "monobloc" sparkwheel assembly. The appellant also submitted that this mechanism is defined by the characterising portion of claim 1, which recites that the thumbwheel means only have an association in which the thumbwheel means are movable together with the sparkwheel means.

3.2 However, the board understands that in a "monobloc" sparkwheel assembly the thumbwheel means is *fixed* to the sparkwheel means and is only *rotatable* together with the sparkwheel means. The passages of the originally filed description cited by the appellant confirm that only a rotational movement of the sparkwheel is disclosed:
- page 7, line 12 refers to "The sparkwheel assembly mounted on an axle 31 **rotating** in a pair of holes 70 in the ears 30";

- page 9, line 21 "to **rotate** the wheel assembly the user must first overcome the frictional resistance inherent in the ordinary construction of a roll-and-press lighter".

3.3 There is no mention in the original application of any other kind of movement, such as linear movement in a groove as part of the sparking action or to a locked position. Hence there is no basis for the generalisation from the specific term "rotatable" to the generic term "movable" which is used in the feature of the characterising portion of claim 1. In fact the term "movable" does not appear in the application documents as filed and has been transferred from the wording of the disclaimer based on the wording of D3. Similarly, the term "association" does not appear in the application documents as filed and has been taken from D3. By employing this term, other connections between the sparkwheel and thumbwheel apart from a fixed one not originally disclosed, such as a gearing, are included in the scope of the claim.

3.4 Consequently, even if it were accepted that a monobloc mechanism is disclosed in the application as filed, claim 1 of the auxiliary request corresponding to auxiliary request 4 before the opposition division does not define such a mechanism and does not meet the requirements of Article 123(2) EPC.

4. *Auxiliary Request 2 - Article 123(3) EPC*

Since the disclaimer defined in claim 1 of auxiliary request 2 is of a narrower scope than that of granted claim 1, the subject-matter remaining within the scope of the claim has been extended. Consequently, the

requirements of Article 123(3) EPC are not met. The respondent did not contest this conclusion.

5. *Auxiliary request filed during the oral proceedings.*

This request was filed at the last moment during the oral proceedings. The characterising portion of claim 1 was amended to read:

"characterized in that the thumbwheel means (16) is immovable with respect to the sparkwheel means (15)."

The board accepts the argument of the respondent that the admittance of such a late-filed request would place the respondent under undue stress to analyse the full implications of the amendment, particularly with respect to Articles 84 and 123(3) EPC, in a short space of time.

Therefore the request is not admitted into the proceedings (Article 13(3) RPBA).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Spira

G. Ashley

Decision electronically authenticated