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**Datasheet for the decision  
of 18 March 2020**

**Case Number:** T 0320/16 - 3.2.07

**Application Number:** 05797884.3

**Publication Number:** 1789237

**IPC:** B26B21/38, B26B21/52

**Language of the proceedings:** EN

**Title of invention:**  
VIBRATING WET SHAVER

**Patent Proprietor:**  
BIC Viorex S.A.

**Opponent:**  
The Gillette Company LLC

**Headword:**

**Relevant legal provisions:**  
EPC Art. 54(3), 113(1), 116(1)  
RPBA Art. 12(4)  
RPBA 2020 Art. 12(8), 15(1), 15(3)

**Keyword:**

Novelty - main request (no)

Late-filed auxiliary request - request could have been filed  
in first instance proceedings (yes)

Decision in written proceedings after cancellation of oral  
proceedings

**Decisions cited:**

G 0009/91, T 1705/17, T 1067/08, T 0003/90

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0320/16 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 18 March 2020**

**Appellant:** BIC Violex S.A.  
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**Respondent:** The Gillette Company LLC  
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**Representative:** P&G Patent Germany  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
10 December 2015 concerning maintenance of the  
European Patent No. 1789237 in amended form.**

**Composition of the Board:**

**Chairman** I. Beckedorf  
**Members:** G. Patton  
A. Cano Palmero

## Summary of Facts and Submissions

I. The patent proprietor lodged an appeal in the prescribed form and within the prescribed period against the decision of the opposition division maintaining European patent No. 1 789 237 in amended form on the basis of the then first auxiliary request.

II. The opposition was directed against the patent as a whole and based on Article 100(a) EPC (lack of novelty and/or inventive step).

The Opposition Division held that the subject-matter of claim 1 of the patent as granted lacked novelty over D1 and that the then first auxiliary request fulfilled the requirements of the EPC.

III. With the statement setting out the grounds of appeal the appellant (patent proprietor) requested

that the impugned decision be set aside and that the patent be maintained as granted (main request),  
or, in the alternative,  
that the patent be maintained in amended form on the basis of an auxiliary request filed with the statement setting out the grounds of appeal.

With its reply letter the respondent (opponent) requested

that the appeal be dismissed.

IV. In a communication pursuant to Article 15(1) RPBA 2020 dated 13 February 2020 the Board provided its

preliminary, non-binding opinion that the appeal would likely be dismissed.

None of the parties reacted in substance to the Board's preliminary opinion. The appellant merely informed the Board with letter dated 26 February 2020 that they **will not attend the oral proceedings** scheduled for 23 July 2020.

V. Following the appellant's feature analysis provided with the statement setting out the grounds, point III. 1, claim 1 of the **main request** (patent as granted) reads as follows:

- A. A vibrating wet shaver comprising:
  - B. - a hollow handle (2),
  - C. - a shaving head (5) borne by said handle (2),
  - D. - an electric vibrator (11) including
    - D1. a rigid casing (13)
    - D2. which is fixed inside said handle (2), for transmitting vibrations to the shaving head (5) through the handle (2),
    - D3. wherein the vibrator (11) includes an electric motor (12),
    - D4. an output shaft (14) adapted to be rotated by the motor
    - D5. and an eccentric mass (15) borne by said shaft (14),
  - E. wherein the casing (13) of the vibrator is tightly fitted in the handle (2),
    - C1. wherein said shaving head (5) comprises at least one blade (5b)
    - C2. and the or each blade (5b) of said shaving head is not driven by a motor relative to the shaving head,
  - F. characterized in that at least an elastomeric

layer (16) is interposed between said casing (13) and said handle (2).

With respect to claim 1 of the main request, claim 1 of the **auxiliary request** further comprises at the end of the claim:

" , wherein the elastomeric layer (16) includes an elastomeric sleeve surrounding the casing of the vibrator."

VI. The following documents of the opposition proceedings are relevant for the decision:

D1\*: EP-A-1 563 967;

P1: Screen shot of Internet website "The free dictionary", for the definition of "tight fit"; and

P2: Screen shot of Internet website "Merriam-Webster", for the definition of "interpose".

\*D1 is an European patent application filed on 11 February 2004, i.e. before the claimed priority date (7 September 2004) of the contested patent, and published on 17 August 2005, i.e. between the priority date and the filing date (6 September 2005) of the contested patent. Therefore, D1 is a document to be taken into account for novelty only pursuant to Article 54(3) EPC.

VII. The appellant argued essentially as follows:

According to P1, the expression "tightly fitted" used in feature E of claim 1 of the main request means fitted with a slight negative allowance.

According to P2, feature F of claim 1 of the main request involves three different elements: the handle, the casing and the elastomeric layer, i.e. the elastomeric layer is distinct from the handle. Moreover the elastomeric layer is between the casing and the handle.

In view of these interpretations, the main embodiment of D1 has no elastomeric layer distinct from the handle since the soft component (18) is molded on the hard component (16) so as to form together the handle. Hence, no elastomeric layer is interposed between the sleeve (23) and the handle within the meaning of feature F. Should the soft component (18) be considered as a part distinct from the handle, it is merely axially interposed between the sleeve (23) and the handle, i.e. not radially as required by claim 1 in order to avoid transmission of radial vibrations. Furthermore, in D1 the sleeve (23) is not tightly fitted in the handle within the meaning of feature E, i.e. with slight negative allowance. Therefore, the main embodiment of D1 does not disclose an elastomeric layer distinct from the handle, nor features E and F.

In addition to these distinguishing features, the variant of paragraph 78 of D1 does not comprise a rigid casing.

Consequently, novelty of the subject-matter of claim 1 of the main request should be acknowledged.

The subject-matter of claim 1 of the main request is also inventive over the prior art.

The features added to claim 1 of the auxiliary request with respect to claim 1 of the main request enable to

further distinguish the claimed subject-matter from the disclosure D1 and also to justify inventive step over the prior art.

VIII. The respondent argued essentially as follows:

The soft component (18) of D1 which is subsequently molded around the rigid casing of the electric vibrator is distinct from the rest of the hollow handle even though not separable. It forms an intermediate layer (18) which is interposed at least axially between the casing (23) and the handle (10, 12, 14, 16) within the broad meaning of feature F. The molding of the soft component (18) in D1 represents one of the possible processes resulting in the casing of the vibrator being "tightly fitted" in the handle of D1 (feature E).

Consequently, D1 discloses all the features of claim 1 of the main request so that its subject-matter should be considered as lacking novelty over D1.

The subject-matter of claim 1 of the main request lacks inventive step over the prior art.

The features added to claim 1 of the auxiliary request with respect to claim 1 of the main request are known from D1 such that the subject-matter of claim 1 of the auxiliary request also lacks novelty over D1.

These added features are also known from other prior art such that the subject-matter of claim 1 of the auxiliary request lacks inventive step.



## **Reasons for the Decision**

### 1. *Procedural aspects*

The present decision is taken in written proceedings without holding oral proceedings. The principle of the right to be heard pursuant to Article 113(1) EPC is however observed since that provision only affords the opportunity to be heard. By explicitly declaring their intention not to attend the oral proceedings, to which both parties were duly summoned, the appellant gave up that opportunity and said declaration is considered equivalent to a withdrawal of the request for oral proceedings under Article 116(1) EPC, whereby the appellant is to be treated as relying only on its written case (see Case Law of the Boards of Appeal, 9<sup>th</sup> edition 2019, sections III.B.2.7.3 and III.C.4.3.2, in particular with reference to T 3/90, OJ EPO 1992, 737).

In view of said declaration and of the fact that the case is ready for decision on the basis of the extensive parties' written submissions and the decision under appeal, the Board, while cancelling the oral proceedings, issues this decision in written proceedings in accordance with Article 12(8) RPBA and Article 15(3) RPBA 2020.

### 2. *Main request (patent as granted)*

In the following the Board will follow the feature analysis of claim 1 provided by the appellant, see point V above.

#### 2.1 In justifying novelty of the claimed subject-matter, the appellant only contests that D1 (main embodiment

and variant of paragraph 78) discloses the following features of claim 1 of the main request:

- an elastomeric layer distinct from the handle
- and interposed between said casing and the handle (feature F); and
- the casing of the vibrator is tightly fitted in the handle (feature E).

2.2 The Board cannot follow the appellant's view for the following reasons:

2.2.1 As put forward by the respondent, claim 1 of the patent as granted does not specify that the elastomeric layer would have to be **separable** from the rest of the handle.

As a result, the soft component of D1 ("*...die anschliessend eingespritzte Weichkomponente...*" 18) which is subsequently molded around the rigid casing ("Schutzelement", "Schutzhülse", "Hülse" 23; "zwei schalenförmige Kunststoffteile" providing the function of the sleeve 23 in the variant of paragraph 78 and for which "*slight press-fit*" is mentioned) of the electric vibrator ("Vibrationseinrichtung", "Vibrationsvorrichtung" 20) is unambiguously distinct from the rest of the hollow handle ("Hartkomponente" 16; "Griffbereich" 10; "Halsbereich" 12; "Kopfbereich" 14) even though not separable, see for instance paragraphs 1, 26, 31, 69 to 78, 87 and 88 and Figures 4a, 5a, 9a, 9b.

2.2.2 Claim 1 as granted is also silent about how the elastomeric layer should be interposed - radially and/or axially; partially or completely - between the casing and the handle so that this feature is unambiguously disclosed in D1 since the intermediate

layer (18) is interposed **at least axially** between the casing (23) and the handle (10, 12, 14, 16), compare for instance Figures 3a and 4a. The above interpretation is also supported by P2: "*to be or come between*" (see impugned decision, point 2.3, last paragraph, of the reasons). Hence, feature F is disclosed by D1.

2.2.3 Claim 1 concerns **a product** and does not specify any process step for producing the claimed product. As put forward by the respondent the expression "*tightly fitted*" used in feature E does not specify or imply any such process step which would relate to for instance the introduction of the vibrator with its casing into the handle. In this respect, the Board considers that the definition given in P1 does not apply to feature E of claim 1 as such since there is no disclosure in the original application where the casing and the handle would provide "*mating parts with slight negative allowance, requiring light to moderate force to assemble*". As a matter of fact, an elastomeric layer is to be interposed between them in accordance with feature F. Hence, the molding of the soft component (18) in D1 represents one of the possible processes resulting in the casing of the vibrator being "*tightly fitted*" in the handle of D1, especially in view of the variant of paragraph 78 which discloses "*slight press-fit*". Hence, feature E is disclosed by D1.

2.3 The above reasons on the main request correspond to the Board's preliminary opinion provided to the parties in section 6 of its communication, which has not been commented on nor has it been contested by the parties during the appeal proceedings.

Under these circumstances, the Board - having once again taken into consideration all the relevant aspects concerning said issue - sees no reason to deviate from its preliminary opinion.

- 2.4 As a consequence, the Board cannot find fault in the reasoning and conclusion of the impugned decision, point 2 of the reasons, regarding the lack of novelty of the subject-matter of claim 1 of the main request over D1 (Article 54(3) EPC).

3. *Auxiliary request*

- 3.1 The appellant filed the auxiliary request for the first time with the statement setting out the grounds without any justification for not having done it during the opposition proceedings.

As a consequence, claim 1 of the auxiliary request has not been dealt with by the Opposition Division and is clearly not part of the impugned decision.

The appeal proceedings, which are largely determined by the factual and legal scope of the preceding proceedings, are, however, not about bringing an entirely fresh case to the Board. This means that an appellant is not at liberty to bring about the shifting of its case to the appeal proceedings as it pleases, and so compel the Board either to give a first ruling on the critical issues or to remit the case to the Opposition Division. Conceding such freedom to an appellant would run counter to orderly and efficient appeal proceedings primarily directed to reviewing the correctness of the decision under appeal, contrary to Article 12(4) RPBA 2007. In effect, it would allow a

kind of "forum shopping" which would jeopardise the proper distribution of functions between the departments of first instance and the Boards of Appeal and would be absolutely unacceptable for procedural economy generally (G 9/91, OJ EPO 1993, 408, point 6 of the reasons; T 1705/07, not published, point 8.4 of the reasons; T 1067/08, not published, points 7.1 to 7.2 of the reasons).

Therefore, the Board is of the opinion to not admit the auxiliary request into the appeal proceedings.

- 3.2 The above reasons on the auxiliary request correspond to the Board's preliminary opinion provided to the parties in section 7.1 of its communication, which has not been commented on nor has it been contested by the parties during the appeal proceedings.

Under these circumstances, the Board - having once again taken into consideration all the relevant aspects concerning said issue - sees no reason to deviate from its preliminary opinion and exercises its discretion to not admit the auxiliary request into the proceedings in accordance with Article 12(4) RPBA 2007.

4. As a consequence, the appellant has failed to demonstrate in a convincing manner the incorrectness of the decision under appeal in respect of the main request (patent as granted). Since the auxiliary request is not admitted into the appeal proceedings, there is no valid set of claims on the basis of which the patent could be maintained.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated