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**Datasheet for the decision
of 1 October 2021**

Case Number: T 0474/19 - 3.2.06

Application Number: 11003225.7

Publication Number: 2444295

IPC: B62B3/14

Language of the proceedings: EN

Title of invention:

Shopping trolley

Applicant:

Creaciones Marsanz, S.A.

Headword:

Relevant legal provisions:

EPC Art. 84

EPC R. 99(1)(c), 101(1)

Keyword:

Admissibility of appeal - notice of appeal - request defining
subject of appeal (yes)

Remittal to the department of first instance - fundamental
deficiency in first instance proceedings (no)

Decisions cited:

Catchword:



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Case Number: T 0474/19 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 1 October 2021

Appellant: Creaciones Marsanz, S.A.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 5 November 2018
refusing European patent application No.
11003225.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Harrison
Members: M. Hannam
E. Kossonakou

Summary of Facts and Submissions

- I. An appeal was filed by the appellant (applicant) against the decision of the examining division refusing European patent application No. 11 003 225.7, in which it found *inter alia* that claims 1 to 5 of the sole request lacked clarity.
- II. In the appellant's combined notice and grounds of appeal, the following is stated as regards the objection to lack of clarity:

"In EPO Resolution 05.11.2018 Patent application 11003225.7, having the title "Shopping trolley", is refused and in section "I. Summary of Facts and Submissions" point 4, it is expressed that it was announced that refusal of the application under Article 97(2), was expected upon failure to amend claim 1 substantially. Moreover in point 6 it says that communication issued by the examining division on 24.01.2018 included a warning about that said refusal of the application.

"For that reason, the applicant in the response given on 18.03.2018, to the said EPO communication dated on 24.01.2018, provided the requested amendment of claim 1, as well as other amendments in order to comply with the above suggestion made by the EPO examining division in their communications, as it is noted in point 7 of the Resolution 05.11.2018.

"Nevertheless, in section "II. Reasons for the Decision" of EPO Resolution, it is pointed out that there still are objections regarding lack of clarity.

"Those objections are listed in points 10.1 to 10.13. Notwithstanding, making a comparison with the above referred EPO communication dated on 24.01.2018, it is obvious that the same text in objections 3.5 to 3.18 were copied in the last Resolution 05.11.2018, so it can be understood that none arguments were taken in consideration in response given on 18.03.2018, despite the effort by the applicant to amend claim 1."

III. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion. In point 2 of the communication, the Board indicated its understanding of the appellant's apparent request in the light of the statement cited above in point II. and invited the appellant to confirm its request(s). In point 4.1.1 to 4.19 of the communication it indicated that the examining division appeared, in its decision, to have appropriately taken the amendments and arguments in the applicant's letter of 19 March 2018 into account, but had still found the claims to lack clarity. Consequently, it appeared that no procedural violation had been committed by the examining division in reaching its decision to refuse the application.

IV. With its submission of 17 August 2021, the appellant clarified its request as follows:
"... the applicant is not requesting EPO decision to be set aside, but to EPO division to exam the amendment of claims and substantive response given on 18 March 2018."

V. Oral proceedings were held before the Board by video conference on 1 October 2021. At the end of the oral proceedings the appellant's request was that the decision under appeal be set aside and the case be

remitted to the examining division for further prosecution.

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

"Shopping trolley, which incorporates a rolling frame, made out of metal, on which there are four casters attached, at least two of these of a swivel type, frame to which a basket made out of plastic (1) is attached with an inverted isosceles trapezoid cross section equipped with a displaceable rear wall for the horizontal stacking of the trolley, characterised in that from the metallic rolling frame emerges a pair of supports with an inverted "U" configuration to which the basket is coupled at its lower base, envisaged with corresponding edges which define the lateral borders of the rear wall of the basket, said edges incorporating lower longitudinal blind holes (6), designed to receive a bar (7), which emerges in the same way as the supports (5) of the rolling frame, at each transmission point of the vertical forces generated by the load contained in the trolley to the rolling frame."

VII. The appellant's arguments may be summarised as follows:

In the examining division's communication of 24 January 2018, several objections to the clarity of the claims were raised. In the applicant's response of 19 March 2018, amendments were made to overcome these. Despite this, the examining division's decision still had objections to the clarity of the claims. Furthermore, many of the initially raised objections were simply copied into the decision such that it was evident that the applicant's arguments in its letter of 19 March 2018 were not taken into consideration. This amounted to a procedural violation.

From the behaviour of the examining division indicated above, it was evident that it failed to understand the claimed subject-matter. Refusal of an application simply because the examining division failed to understand the claims should not be possible. Moreover, the description further explained the content of the claims such that clarity could not be questioned. The examining division should also have explained why the claims were unclear, rather than simply stating this; suggestions of allowable modification could also have been offered.

Reasons for the Decision

1. *Admissibility of the appeal*

1.1 Rule 99(1)(c) EPC states that the notice of appeal shall contain a request defining the subject of the appeal. Rule 101(1) EPC identifies the consequence of of an appeal not complying with *inter alia* the requirement of Rule 99(1)(c) EPC to be that the appeal is rejected as inadmissible.

1.2 In the entirety of the appellant's appeal, no explicitly worded requests are made. However, having filed an appeal against the decision of the examining division with the argument that the applicant's comments and amendments had not been taken into account, and since no new claims had been filed nor a substantive response made to the reasons for refusal, it can only be understood that, implicitly, the appellant was requesting that the decision be set aside due to a procedural violation. This implicit request was ultimately confirmed by the appellant at oral

proceedings. Since all other requirements for an admissible appeal were met, the appeal is admissible.

2. *Requests*

As regards the request(s) of the appellant, particularly in view of the unusual request indicated in response to the Board's preliminary opinion (see point IV. above), at oral proceedings this was confirmed to be that the decision under appeal be set aside and the case be remitted to the examining division for further prosecution due to a procedural violation having been committed by the examining division.

3. *Alleged procedural violation*

3.1 The substantive actions of the examining division, and the letters of the applicant with amended claims filed during the examination procedure, were as follows:

9 March 2015	Extended European search report issued
30 June 2015	Amended claims filed
28 October 2016	First communication issued under Article 94(3) EPC
16 February 2017	Amended claims filed
24 January 2018	Second communication issued under Article 94(3) EPC
19 March 2018	Further amended claims filed
5 November 2018	Decision to refuse the application

3.2 The examining division's second communication of 24 January 2018 included more than fifteen clarity objections to the claims filed with the applicant's letter of 16 February 2017. In point 5.1 the following

was stated: "When not overcoming all objections raised so far, the applicant is emphasized (*sic*) that **refusal of the application under Article 97(2) EPC** is to be expected.". The clarity objections raised *inter alia* included under point 3.5:

"The last three lines of claim 1 are completely unclear due to grammatical reasons. It can not be understood which features are defined with this wording."

The wording in question reads as follows:

"...designed to receive a bar (7), which emerges in the same way as the supports (5) of the rolling frame, defined at the bottom of each blind hole or transmission point due to the vertical forces generated by the load contained in the trolley by the rolling frame."

3.3 With letter of 19 March 2018 in response to this particular objection, the applicant simply stated:

"We propose the following amendment that improves the clarity of the text:

...designed to receive a bar (7), which emerges in the same way as the supports (5) of the rolling frame, at each transmission point of the vertical forces generated by the load contained in the trolley to the rolling frame."

3.4 In point 10.1 of its Reasons for the Decision, the examining division found, as in its second communication of 24 January 2018:

"The last three lines of claim 1 are completely unclear due to grammatical reasons. It can not be understood

which features are defined with this wording."

and further added:

"It is unclear which 'transmission points' are meant as there are at least six force transmission points at the ends of parts 5 and 7."

3.5 The Board has no problem to fully understand the examining division's objection when considering the last lines of the claim, and cannot see in any way how the objection was met by the applicant's response, not least due to the lack of any explanation by the applicant as to how its amendment overcame the objection. In its justification for the above amendment of 19 March 2018, the applicant stated summarily that "the following amendment ... improves the clarity of the text" but failed to explain, in any way at all, how the new text improved the clarity of the claim. Indeed, the sole amendments made were to delete 'the bottom of each blind hole' and to substitute 'by the rolling frame' with 'to the rolling frame' which failed to address the grammatical lack of clarity indicated by the examining division.

3.6 The appellant's argument that the examining division should have more clearly explained in what way claim 1 was grammatically unclear is not accepted. Whilst it can be appreciated that the application was filed in a non-official EPO language and that translation into the language of proceedings may have led to the grammatical problems (the appellant having argued that the same application was found to be clear in Spain), the objection raised by the examining division leaves no doubt as to the lack of clarity which has been encountered and why this is so. The appellant is of

course correct that the examining division has a duty to make its objections clear and understandable, yet in the particular context of the wording found to lack clarity, this has been done. Also, if the applicant had problems understanding the particular objection, it could have raised this matter when responding to the examining division's communication, and explained this in its letter of response together with what features it was trying to define. Moreover, an applicant always has the option of requesting oral proceedings in order to allow it to explain its amendments to the examining division in such cases, yet the applicant did not avail itself of this opportunity.

- 3.7 The appellant's argument that the examining division had the possibility of referring to the description in order to interpret what the claims should mean is not accepted. Since the claims define the matter for which protection is sought (see Article 84 EPC), the claims must be clear in their own right, without relying on reference to the description or the figures for interpretation.
- 3.8 The appellant's further argument that the examining division should have made suggestions as to how the clarity objections could be overcome is also not accepted. Whilst this may under some circumstances be helpful, the examining divisions are under no obligation to provide such indication, particularly since the applicant is itself responsible for the requests presented for consideration by the examining division. In the present case the examining division elected not to provide suggestions as to suitable claim wording and this is not objectionable. Moreover, in the present case the examining division stated that it "can not be understood which features are defined with this

wording", such that making suggestions for improved wording may well also not have been possible.

3.9 The appellant's contention that the examining division had simply failed to understand the claimed subject-matter thereby avoiding examination of inventive step therein is precisely the point of the refusal of the application. The objection to lack of clarity under Article 84 EPC is separate to an objection concerning inventive step under Article 56 EPC. Both clarity and inventive step are requirements which need to be fulfilled, amongst others, in order that a patent may be granted. It may also be added that an examining division may also be unable to make concrete inventive step considerations until the claims clearly define the subject-matter for which protection is sought. Nevertheless, in the present case, the examining division (see items 4.1 and 4.2 of the communication of 24 January 2018) did consider inventive step and referred the applicant to its previous communications on this issue as well as adding information on the basis of "as far as the claims can be understood" (see item 4.2 of the communication of 24 January 2018), which the appellant in fact did not respond to at all with its reply dated 13 March 2018.

3.10 The appellant's further contention that it had made amendments to address the clarity objections raised in point 3.5 of the communication of 24 January 2018 but that the decision had not reflected these, since the wording in point 10.1 of the decision was identical to that of the previous communication, does not allow the conclusion to be drawn that the examining division failed to consider these amendments. Firstly, the examining division evidently found the amendments not to overcome the clarity objection since it used

essentially identical wording in point 10.1 of the decision to that used in the previous communication. Moreover, the examining division added further detail in point 10.1 specifically indicating why at least the "transmission points" were unclear in the context claimed. Consequently the Board sees the examining division as indeed having considered and addressed the amendments alleged to have been ignored.

- 3.11 In summary, therefore, the Board finds that the examining division did appropriately consider the amendment made to the last three lines of claim 1 and, in finding the claim not to meet the requirements of clarity, even on this point alone, did not commit a procedural violation.
4. The appellant's sole request is for the decision under appeal be set aside and for the case to be remitted to the examining division for further prosecution. In the absence of a procedural violation, at least in respect of the reason for refusal stated above, the appellant's request cannot be granted. The appeal must therefore be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Grundner

M. Harrison

Decision electronically authenticated