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**Datasheet for the decision
of 2 March 2022**

Case Number: T 0707/19 - 3.2.01

Application Number: 15156384.8

Publication Number: 2893832

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A45D2/36, A45D6/00, A45D1/06,
A45D6/02

Language of the proceedings: EN

Title of invention:
Hair styling device

Patent Proprietor:
TF3 Limited

Opponents:
Philips International B.V.
Ehlers, Jochen
SEB S.A.
PHILIPS U.K. LIMITED/PHILIPS ELECTRONICS UK
LIMITED

Headword:

Relevant legal provisions:

RPBA Art. 12(4)

RPBA 2020 Art. 13(1)

EPC Art. 76(1)

Keyword:

Divisional application - subject-matter extends beyond content
of earlier application (yes)

Amendment to appeal case - justification by party (no)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0707/19 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 2 March 2022

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 7 January 2019 revoking European patent No. 2893832 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: A. Wagner
S. Fernández de Córdoba

Summary of Facts and Submissions

- I. The appeal of the patent proprietor lies against the decision of the opposition division to revoke the European patent No. 2893832 pursuant to Article 101(3) (b) EPC.
- II. The opposition division decided, *inter alia*, that the subject-matter of claim 1 of the patent as granted (main request) extended beyond the content of the parent application (Article 100(c) EPC with Article 76(1) EPC). Auxiliary requests 4 to 6 filed during oral proceedings were not admitted into the opposition proceedings as the criteria of clear allowability with respect to Article 76(1) EPC were not met.
- III. The following documents are cited in this decision:
- PL1:** WO 2009/077747 A2 (cited in the patent in suit)
PL15: WO 2012/080751 A2 (parent application of the patent in suit)
- IV. Oral proceedings by videoconference were held before the Board on 2 March 2022. At the end of the oral proceedings the parties' requests were as follows:
- The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of auxiliary request 8 filed with the statement of grounds of appeal (main request) or, alternatively, on the basis of one of the auxiliary requests 13, 18-21, 26-29 or 34-41 filed on 6 November 2019.

The respondents (opponents 1 to 4) requested that the appeal be dismissed.

V. Claim 1 of the main request (filed as auxiliary request 8) corresponds to claim 1 as granted and reads as follows (feature analysis added by the Board):

M1.1 A hair styling device (10) having:
M1.2 a body (12) defining a chamber (16) adapted to accommodate a length of hair (26), the chamber having a primary opening (24) through which the length of hair may pass;
M1.3 an elongate member (20);
M1.4 a rotatable element (34) adapted to
M1.4.1 engage the length of hair adjacent to the primary opening,
M1.4.2 pull the length of hair through the primary opening and into the chamber, and
M1.4.3 to wind the length of hair around the elongate member in use:
characterised by
M1.5 a control system which includes means to detect the load applied to the length of hair (26) by the rotatable element
M1.6 the control system having a record of a predetermined threshold,
M1.7 the control system being configured to stop and then to reverse the rotation of the rotatable element when the detected load exceeds the threshold.

VI. The appellant's arguments, as far as relevant for the decision, can be summarised as follows:

Main request - admission

The main request filed as auxiliary request 8 in appeal

was identical to auxiliary request 2 filed during opposition proceedings. As stated in the minutes of the oral proceedings, point 9.4, the opposition division made it clear that it would reject auxiliary request 2 as claim 1 was identical to claim 1 as granted, which was found not to be allowable.

Main request - Article 100(c) EPC

The opposition division erred in referring to PL15, page 8, lines 23 to 28, as the sole basis for feature M1.4.2. Reference should also be made to the fifth aspect of the invention described on page 6, lines 4 to 13. Lines 6 and 7 of this passage made it clear that the length of hair had to enter the chamber. Line 8 recited that the rotatable element was adapted to engage the length of hair (feature M1.4.1) and lines 10, 11 recited that the length of hair was wound around the elongate member (feature M1.4.3). Hence the elongate member was in the chamber and the length of hair was pulled into the chamber. Feature M1.4.2 was obligatory in order to perform features M1.4.1 and M1.4.3. A skilled person could not possibly conceive a rotatable element which did not also "*pull the length of hair through the primary opening and into the chamber*".

Also all figures of the patent in suit showed the elongate member being in the chamber and the length of hair being pulled into the chamber to be wound around the elongate member.

The passage on page 8 (line 25) clearly indicated the arcuate shape of the leading edge 38 of the rotatable element as being optional in a preferred embodiment. The only component for performing the three functions defined in M1.4.1 to M1.4.3 was the rotatable element

(M1.4) already defined in claim 1.

Furthermore as disclosed on page 1, lines 22 to 24, and page 2, lines 24 to 26, of PL15, the starting point of the patent in suit was a device according to PL1, e.g. as shown in figures 5A to 5C. The features in common were described in the preamble of claim 1. From PL1, incorporated by reference (page 1), it was known that the elongate member was in the chamber and the length of hair was pulled into the chamber to be wound around the elongate member. All information was available in the parent application.

Admission of auxiliary requests 13, 18 to 21, 26 to 29, 34 to 41

All auxiliary requests represented an adequate reaction to the respondents's replies to the statement of grounds of appeal.

The impugned decision only dealt with Article 100(c) EPC on which the revocation of the patent in suit was based. Each of the auxiliary requests filed with the statement of grounds of appeal addressed a single objection raised by the opposition division.

The auxiliary requests filed with letter of 6 November 2019 were based on only six amendments addressing the objections of the respondents under Article 100(c) EPC and Article 100(a) EPC. The amount of requests was caused by simple combinations of these six different amendments reflecting advantageous contingency positions depending on the findings of the board.

VII. The respondents' arguments, as far as relevant for the decision, can be summarized as follows:

Main request - admissibility

The main request was identical to auxiliary request 2 which had been withdrawn by the appellant during oral proceedings before the opposition division. Thus the appellant had intentionally avoided a decision on this request. Accordingly, resubmitting this request was inadmissible pursuant to Article 12(4) RPBA 2007.

Main request - Article 100(c) EPC

Feature M1.4.2 was disclosed on page 8, lines 27-28, of PL15 but was inextricably linked with other features relating to the form of the rotatable element (34). The requirements of Article 76(1) EPC were therefore not met.

While the wording of feature M1.4.2 kept it open how the rotatable element (34) was adapted to pull the length of hair, PL15 (page 8, lines 22-28) only disclosed that it was the form of the rotatable element that allowed to pull the length of hair. The form was defined by an arcuate leading edge 28 able to pass over, engage, capture and further pull the length of hair into the chamber. However claim 1 also covered the possibility that the length of hair was pulled by means of other features of the rotatable element such as e.g. a certain roughness of its surface.

The passage on page 8 referred to a specific embodiment, for which it was defined that the elongate member 20 was located within the chamber 16 (page 7, line 29). However the claim was silent about the

arrangement of the elongate member 20, the rotatable member 34 and the chamber 16.

Page 6, lines 8-11, describing the fifth aspect of the invention, could not be used as implicit disclosure for feature M1.4.2. This passage was much broader than claim 1 and not unambiguously linked to the function defined in M1.4.2 or the disclosure of page 8, lines 22-28. The claimed feature combination constituted an unallowable intermediate generalisation as it was originally disclosed only in combination with further features of the specific embodiment.

PL1 was not relevant when examining the requirements of Article 100(c) EPC. An alleged incorporation by reference as stated in PL15, page 1, lines 22 to 24, even worsened the problem of Article 76(1) EPC as in figures 5A to 5C of PL1 feature M1.4.2 was also disclosed only in combination with further features.

Admission of auxiliary requests 13, 18 to 21, 26 to 29, 34 to 41

None of the requests underlay the impugned decision. Therefore the requirements of Article 12(2) RPBA were not met.

According to Article 12(3) RPBA it was the parties' duty to submit the complete case as early as possible. All auxiliary requests were directed to objections already raised by the opponents in the notices of opposition. Therefore all auxiliary requests should have been filed during opposition proceedings or at the latest with the statement of grounds of appeal. During the written opposition proceedings, the patentee had filed auxiliary requests only to address the two

objections raised by the opposition division in the preliminary opinion. No request was formulated to address the other objections raised by the opponents.

With the statement of grounds of appeal the patent proprietor had failed to file an auxiliary request directed to all objections raised in the impugned decision.

Furthermore the appellant had failed to provide arguments why the amendments made in the auxiliary requests filed with letter of 9 November 2019 allegedly overcame the respondents' objections.

The auxiliary requests were not convergent but randomly covered a plurality of different possible amendments. Moreover the burden of identifying a possibly valid formulation for the claims, which should be the responsibility of the patent proprietor, had been shifted to the board. Such an approach was not acceptable.

Reasons for the Decision

1. Admission of the main request

1.1 The board admitted the main request (filed as auxiliary request 8 with the statement of grounds of appeal).

1.2 As compared to the patent as granted, which includes claims 1 to 6 directed to a device and claims 7 and 8 directed to a method, the main request only includes the device claims 1 to 6. Moreover, the decision under appeal deals with both the device and the method claims as granted (in particular: claim 1 was rejected for non-compliance with the requirements of Article 76(1) EPC). Hence, the main request in appeal constitutes a

limitation of the patent proprietor's case as compared to the main request underlying the contested decision. Under these circumstances, and irrespective of the fact that an identical request (filed as auxiliary request 2) was withdrawn at the oral proceedings before the opposition division, the Board sees no reason to exercise its discretion pursuant to Article 12(4) RPBA 2007 not to admit the main request in the appeal proceedings.

2. Main request - Article 100(c) EPC

- 2.1 The board confirms the decision of the opposition division that the subject-matter of claim 1 according to the main request extends beyond the content of the earlier application as filed (Article 100(c) and 76(1) EPC). The introduction of feature M1.4.2 results in an unallowable intermediate generalisation.
- 2.2 It is undisputed that feature M1.4.2 is extracted from the description of PL15. The board agrees with the respondents that the only explicit disclosure of feature M1.4.2 is in the passage on page 8, lines 22-28. This passage refers to a specific embodiment, according to which there is a particular way of implementing feature M1.4.2, namely by giving a suitable (arcuate) form to the leading edge of the rotatable element.
- 2.3 In the statement of grounds of appeal, point 1.9, the patent proprietor acknowledged that it is the form of the rotatable element that enables the rotatable element to pull the length of hair. However, as brought forward by the opponents, claim 1 leaves open whether the rotatable element has a specific form and thus also covers other possibilities to pull the length of hair

than by means of a specific form as in PL15.

2.4 Contrary to the opinion of the appellant (patent proprietor) the passage on page 6, lines 4-11, can not be considered as an implicit disclosure of feature M1.4.2. As pointed out by the respondents, this passage, which refers to "a fifth aspect of the present invention" neither defines - explicitly or implicitly - that the elongate member is located within the chamber nor that the rotatable element pulls the length of hair into the chamber. This passage is simply silent about feature 1.4.2.

2.5 The appellant further referred to PL1 as an alleged basis for feature M1.4.2. According to established case law (see Case law of the Boards of Appeal of the EPO, 9. edition, chapter II.E.1.2.4) features of a cross-referenced document may be added to a claim without infringing Article 123(2) EPC (or, analogously, Article 76(1) EPC) only under particular conditions. In particular, such features must clearly belong to the description of the invention contained in the application as filed and must be precisely defined and identifiable within the total technical information contained in the reference document. Also, it is not permissible to single out a particular feature inextricably linked to other features. In the present case, it is not apparent from the earlier application as filed (PL15) which features of PL1, if any, are intended to be incorporated and which are not. As a matter of fact, the statement on page 1, lines 22-24, that the "*present invention shares many of the features of the preferred embodiments of the hair styling device described in WO2009/077747*" and the statement on page 3, lines 23-26 that "*the present invention therefore shares a feature of the hair*

styling device of WO2009/077747 in having a (primary) opening through which the length of hair passes into the chamber" cannot be seen as directing specifically to the feature of pulling the length of hair through the primary opening and into the chamber (even assuming that this feature would be disclosed in PL1 in such general terms).

3. Admission of auxiliary requests 13, 18 to 21, 26 to 29, 34 to 41

3.1 The board did not admit the auxiliary requests into the appeal proceedings.

3.2 Auxiliary requests 13, 18 to 21, 26 to 29 and 34 to 41 were submitted after the statement of grounds of appeal, allegedly in response to the replies of the respondents, and constitute an amendment to the appeal case of the patent proprietor according to Article 13(1) RPBA 2020. The appellant (patent proprietor) did not convincingly justify the late filing of the auxiliary requests.

3.3 The replies of the respondents (opponent 1 to 4) did not comprise any objection not already raised from the beginning of the opposition proceedings.

Even if the opposition division in its preliminary opinion did not agree with all of the opponents' objections e.g. in view of Article 100(a) EPC, the patent proprietor could not rely on the preliminary opinion being maintained. By filing auxiliary requests, the patent proprietor should have primarily addressed the objections of the opponents rather than filing them in dependency of the preliminary view of the opposition division. Accordingly, the board takes the view that

the auxiliary requests in appeal could have been filed in opposition proceedings, and that it would a fortiori not be justified to admit them in appeal proceedings in response to respondents' objections raised in appeal but still known to the appellant from the beginning of the opposition proceedings.

- 3.4 Finally the board notes that auxiliary request 13, which is allegedly a combination of auxiliary requests 7 and 8 filed with the statement of grounds of appeal, is the first request filed in appeal proceedings that deals with all the objections under Article 100(c) EPC in the contested decision in respect of the patent as granted (method claims deleted and further features from the description added to M1.4.2). The board is aware of the appellant's submission in the statement of grounds of appeal (see point 4.2) that "*further auxiliary requests will be required in the event that the Appeal Board agrees with two or three of the Opposition Division's objections, the further auxiliary requests combining the amendments of two or more of the attached auxiliary requests*". However, according to Article 12(3) RPBA 2020, the statement of grounds of appeal shall contain a party's complete case. Delaying the filing of auxiliary requests in dependency of the board's (preliminary) findings on specific aspects, is, contrary to the appellant's submissions, not only detrimental to procedural economy but also not in the interest of a fair proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Voyé

G. Pricolo

Decision electronically authenticated