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**Datasheet for the decision
of 10 October 2023**

Case Number: T 2044/20 - 3.2.03

Application Number: 10005609.2

Publication Number: 2390584

IPC: F24C15/08

Language of the proceedings: EN

Title of invention:

Oven cabinet

Patent Proprietor:

Electrolux Home Products Corporation N.V.

Opponent:

BSH Hausgeräte GmbH

Headword:

Relevant legal provisions:

EPC Art. 123(2), 111(1)

RPBA 2020 Art. 13(1)

Keyword:

Amendments - added subject-matter (yes)

Amendment to appeal case - amendment to patent - amendment
overcomes issues raised (yes)

Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:

G 0002/10, G 0003/89, G 0011/91, G 0001/93

Catchword:



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Case Number: T 2044/20 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 10 October 2023

Appellant: Electrolux Home Products Corporation N.V.
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Respondent: BSH Hausgeräte GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 13 October 2020
revoking European patent No. 2390584 pursuant to
Article 101(3)(b) EPC.**

Composition of the Board:

Chairwoman D. Prietzel-Funk
Members: B. Miller
R. Baltanás y Jorge

Summary of Facts and Submissions

I. European patent No. 2 390 584 B1 ("the patent") relates to an oven cabinet.

II. An opposition against the patent was filed on the grounds of Article 100(c) EPC, 100(b) EPC, and Article 100(a) EPC together with Articles 54 and 56 EPC.

The opposition division concluded that the ground for opposition under Article 100(c) EPC prejudiced the maintenance of the patent as granted. The opposition division further concluded that auxiliary requests 1 to 17 as filed during the opposition proceedings did not meet the requirements of Article 123(2) or (3) EPC. Hence, the opposition division decided to revoke the patent.

This decision of the opposition division was appealed by the patent proprietor ("the appellant").

III. In the statement setting out the grounds of appeal, the appellant referred to:

D13: "comprise" entry in the online version of the Oxford Dictionary:
<https://www.oxfordlearnersdictionaries.com/definition/english/comprise?q=comprise>

IV. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted according to the main request and, alternatively, that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 4

filed with the letter dated 1 April 2022 or, further alternatively, on the basis of one of auxiliary requests 5 to 11 corresponding to auxiliary requests 1 to 7 filed with the statement setting out the grounds of appeal or, further alternatively, on the basis of one of auxiliary requests 12 and 13 filed with the letter dated 20 April 2023.

The opponent ("respondent") requested that the appeal be dismissed. Procedurally, the respondent requested that auxiliary requests 1 to 4 not be admitted in the appeal proceedings.

Both parties requested as a further auxiliary request that the case be remitted to the opposition division.

V. Wording of the requests at issue in this decision

(a) Claim 1 as granted according to the main request reads (feature analysis as used by the parties and presented in point I.1.14 of the decision of the opposition division):

- M1.1 Oven cabinet, comprising
- M1.2 - a rear panel (12),
- M1.3 - two side panels (14, 16) arranged at either side end of the rear panel (12),
- M1.4 - a top panel (18) arranged at the upper ends of the rear panel (12) and of the side panels (14, 16),
- M1.5 - a front door (20) pivotally arranged by means of hinges (22), and
- M1.6 - a bottom panel (24) comprising at least one electronic component,
- M1.7 in particular a steam generator (26) or a heating element, whereby

- M1.8 - the rear panel (12), the side panels (14, 16), the top panel (18) and the front door (20) are attached to each other in such a manner that they together form an inherently stable and stiff unit
- M1.9 serving as the constructional base of the cabinet,
characterised in that
- M1.10 the bottom panel (24) is arranged at the bottom ends of the rear panel(12)and of the side panels (14, 16) and
- M1.11 - the bottom panel (24) is detachably fixed to said unit,
- M1.12 wherein the bottom panel (24) is provided at its side ends with upwardly projecting upstandings (40),
- M1.13 which encompass the side panels (14, 16),
- M1.14 in particular from the outside,
- M1.15 and which are detachably fixed to the side panels (14, 16),
- M1.16 in particular by means of screw connections (42).

(b) Claim 1 of auxiliary request 1 is based on claim 1 of the main request with the following feature 6A inserted after feature 1.7:

- M1.6A the bottom panel (24) receiving the at least one electronic component,

The remaining auxiliary requests 2 to 13 are not relevant for this decision.

- VI. With the summons to oral proceedings, the Board sent a communication pursuant to Article 15(1) RPBA 2020 informing the parties of its preliminary opinion on the case.
- VII. With a letter dated 7 September 2023, the respondent withdrew its request for oral proceedings and announced that it would not attend the oral proceedings before the Board.
- VIII. Oral proceedings were held on 10 October 2023 in the absence of the respondent in accordance with Article 15(1) RPBA 2020 and Rule 115(2) EPC.
- IX. The appellant's arguments relevant for this decision can be summarised as follows.

(a) Main request - amendments

The expression "a bottom panel receiving an electronic component" in claim 1 as filed left it open where the electronic component was arranged in relation to the panel. The expression referred to any kind of bottom panel without any restriction on the shape of the bottom panel.

The expression "bottom panel comprising" in claim 1 of the main request should be understood in a technically plausible way for such an oven cabinet, namely as excluding, for example, mounting the electronic component below the bottom panel. The term "comprising" did not implicitly mean "being mounted to". It did not require that "there [be] a mounting connection between bottom panel and electronic component".

The skilled person would understand that the terms "comprising" and "receiving" were used synonymously in the application as filed and the patent as granted.

The scope of claim 1 as filed had been clarified at the request of the examining division on the basis of the original disclosure.

(b) Auxiliary request 1 - admittance

Auxiliary request 1 was an appropriate response of the appellant to the reasoning in the contested decision and the arguments reiterated by the respondent in its reply to appeal.

(c) Auxiliary request 1 - amendments

Claim 1 recited the claim language of claim 1 as filed and therefore brought the wording in line with the requirements of Article 123(2) EPC.

Furthermore, the addition of a feature did not extend the scope as granted. Hence, the requirements of Article 123(3) EPC were fulfilled.

X. The respondent's counter-arguments to the above points can be summarised as follows.

(a) Main request - amendments

The terms "comprising" and "receiving" had different meanings in the context of a bottom panel of an oven cabinet. A bottom panel comprising an electronic element as specified in claim 1 as granted referred to an arrangement where the electronic element could be

placed above or below the bottom panel and could be affixed to it by any means.

On the contrary, a bottom panel receiving an electronic element as specified in claim 1 as filed referred to an arrangement where the bottom layer had to have a shape which allowed the electronic element to be received in it.

The term "comprising" implied an unambiguous association of one component with another, no matter whether it was mounted on the latter or was an integral part as in a one-piece design.

This interpretation of the term was confirmed by the patent since the term "comprising" was used in the application as originally filed in reference to the oven cabinet itself and the lugs in the walls of the base plate ("upstandings").

The term "receiving" was used throughout the application only in reference to the base plate which accommodated the electronic component.

Therefore, no reason existed for interpreting the term "receiving" differently from its commonly used interpretation.

The amendment in M1.6 was therefore not only a simple clarification.

(b) Auxiliary request 1 - admittance

Auxiliary request 1 filed with the letter dated 1 April 2022 was filed late in appeal proceedings and should have been filed during opposition proceedings.

Moreover, auxiliary request 1 was not prima facie allowable since claim 1 contained the amended feature M1.6, which had been found non-allowable. Furthermore, the amendments to claim 1 did not comply with the requirements of Rule 80 EPC, and the subject-matter of claim 1 lacked novelty and inventive step.

(c) Auxiliary request 1 - amendments

Auxiliary request 1 contained the same amendment as claim 1 of the main request and therefore did not comply with the requirements of Article 123(2) EPC.

Reasons for the Decision

1. Main request - Amendments

- 1.1 Under the gold standard (G 2/10, OJ 2012, 376) for assessing compliance with Article 123(2) EPC, any amendment to the parts of a European patent application or a European patent on the disclosure (the description, claims and drawings) is subject to the mandatory prohibition on extension laid down in Article 123(2) EPC and can therefore, irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed (G 3/89, OJ 1993, 117; G 11/91, OJ 1993, 125).

This gold standard is not met by the amendments made to claim 1 as granted according to the main request.

- 1.2 Claim 1 as granted is based on claim 1 as originally filed in which the expression:

"bottom panel (24) **receiving** at least one electronic component"

is replaced with:

"bottom panel (24) **comprising** at least one electronic component" (emphasis added by the Board)

It is undisputed that the application as originally filed (in line with the submissions by the parties, the

references in the following are made according to the application as published: EP 2 390 584 A1, "the application") does not contain a literal basis for this amendment. Throughout the application, the bottom panel is described as "receiving" at least one electronic component (see, for example, paragraphs [0001], [0002], [0005] and [0013] of the application).

- 1.3 The appellant argues that the amendment to claim 1 does not extend beyond the technical teaching of the application since in the application, the term "receiving" was understood to be synonymous with the term "comprising", as is evident from the interpretation adopted by the examining division during the examination of the application at the EPO.

This argument is not convincing.

- 1.4 Based on the common understanding of the verb "to comprise" (see definition in D13), the expression "bottom panel comprising at least one electronic component" in claim 1 of the main request requires that the bottom panel include the electronic component as a part or member.

In other words, the bottom panel and the electronic component have to form an assembly in line with the assessment of the opposition division (see point 3.3 of the contested decision). Whether the bottom panel is shaped in a specific manner to receive the electronic component is irrelevant for claim 1 of the main request. Hence, the definition of claim 1 of the main request encompasses, for example, assemblies in which the electronic component is screwed or glued to a flat bottom panel, either on its top or bottom face, so that

the electronic component becomes part of the bottom panel.

Contrary to this, the expression "bottom panel receiving at least one electronic component" in claim 1 of the application requires that the bottom panel have a specific shape which allows the electronic component to be received, i.e. to be placed in it. Hence, an arrangement as described above based on the wording of claim 1 of the main request, with the electronic component being screwed or glued to a flat bottom panel, is not encompassed by the expression "bottom panel receiving ..." as defined in claim 1 of the application.

Therefore, the expressions used in claim 1 as filed and claim 1 as granted according to the main request encompass different subject-matter when taking into account the common understanding of the terms "comprising" and "receiving".

1.5 This common understanding of the terms "comprising" and "receiving" is also reflected by the remaining teaching of the description of the application.

On the one hand, the application uses the verb "receive" in paragraph [0018] according to its usual meaning. Here, it refers to the joining of parts, where one part is shaped in a specific form so that the other part fits into it:

"The recess 50 is adapted to receive a lug which is integrally formed to the upwardly projecting upstanding 40b."

This understanding corresponds also to the disclosure in paragraph [0010] of the application on a recess into which a lug is to be engaged.

On the other hand, the application uses the term "comprising" for the various panels forming the oven cabinet (see paragraphs [0001], [0007] and [0013] of the application).

Paragraph [0013], on which the appellant relies to support its argument, contains both terms: the term "comprises" in the description of the parts forming the oven cabinet, and the term "receives" in the description of the assembly formed by the bottom panel and the electronic component.

Hence, the description as filed also does not support the argument of the appellant that the terms "comprising" and "receiving" are to be understood synonymously in the application.

- 1.6 In addition, neither the opposition division nor the Board is bound by an interpretation adopted during the examination proceedings. Nevertheless, the opinion of the examining division in the examination proceedings has been taken into account, although the Board does not find it convincing for the above-mentioned reasons.
- 1.7 In view of the above, the Board agrees with the conclusion in point 3.3 of the contested decision that the amendment in claim 1 as granted generates subject-matter which extends beyond the technical teaching of the application as originally filed.

Hence, the ground for opposition pursuant to Article 100(c) EPC prejudices the maintenance of the patent as granted according to the main request.

2. Auxiliary request 1 - Admittance

2.1 The appellant filed auxiliary request 1 with the letter dated 1 April 2022.

2.2 Claim 1 of auxiliary request 1 has been amended by the following feature M1.6A being added after feature M1.7:

M1.6A the bottom panel (24) receiving the at least one electronic component,

2.3 Since auxiliary request 1 was not filed with the statement setting out the grounds of appeal, it constitutes an amendment to the case under Article 13(1) RPBA 2020. Its admittance is thus at the Board's discretion.

2.4 This discretion must be exercised in view of, inter alia, the suitability of the amendment to resolve the issues raised, the current state of the proceedings and the need for procedural economy. The Board considers that none of the criteria mentioned in Article 13(1) RPBA 2020 justifies the non-admittance of auxiliary request 1.

2.4.1 The amendment to the case can be considered an appropriate reaction of the appellant to the reasoning in the contested decision and the arguments reiterated by the respondent in its reply to appeal since it prima facie overcomes the objections under Article 123(2) and (3) EPC (see points 3 and 4 below).

- 2.4.2 Procedural economy is not negatively affected by the amendment of the case since it prima facie overcomes the objections under Article 123 EPC, which have been discussed in the appealed decision for 17 auxiliary requests.
- 2.4.3 Although auxiliary request 1 was not filed together with the grounds of appeal but only in reaction to the reply to the appeal by the respondent, it was nevertheless filed at a very early stage of the appeal proceedings. This allowed the respondent to react (see letter dated 13 June 2022) and the Board to consider the arguments of both sides on the proposed amendment when dealing with the case in preparation for its communication under Article 15 RPBA 2020.
- 2.5 The respondent argues that auxiliary request 1 should have been submitted in the opposition proceedings or at the latest with the grounds of appeal.

The Board does not agree.

Indeed, the ground for opposition pursuant to Article 100(c) EPC was discussed in opposition proceedings and even led to the revocation of the patent. Nevertheless, it is not excluded that a patent proprietor can amend its patent in appeal proceedings to overcome the grounds leading to the revocation of the patent.

In the current case, the appellant did react to the objections raised during the opposition proceedings by filing amended sets of claims in which the objected feature M1.6 had been replaced. These bona fide attempts to overcome the objections under Article 100(c) EPC were, however, not successful since the

opposition division concluded that these auxiliary requests did not meet the requirements of Article 123(3) EPC (see point 5 of the contested decision).

Hence, the appellant found itself in a so-called inescapable trap (see G1/93, OJ 1994, 541, Reasons 13). Usually it is not self-evident how to overcome an objection under Article 123(2) EPC in such a scenario.

Therefore, the filing of a further request to overcome the objection under Article 123(2) EPC can be considered an appropriate reaction of the appellant to the course of the opposition proceedings.

2.6 In addition, the respondent argues that auxiliary request 1 should not be admitted since it is not prima facie allowable for the following reasons.

- Claim 1 still contains the amended feature M1.6, which had been found non-allowable.
- The amendments to claim 1 do not comply with the requirements of Rule 80 EPC.
- The subject-matter of claim 1 of each auxiliary request lacks novelty and inventive step.

These arguments by the respondent are also not convincing.

2.6.1 The addition of feature M1.6A is prima facie suitable for bringing claim 1 in line with the requirements of Article 123(2) and (3) EPC (see points 3 and 4 below).

2.6.2 The addition of feature M1.6A is an attempt to overcome the ground for opposition of Article 100(c) EPC under which the patent had been revoked by the opposition division. Hence, the amendment is occasioned by a ground for opposition and therefore is allowable under Rule 80 EPC.

2.6.3 The further grounds for opposition pursuant to Article 100(a) and (b) EPC were not discussed conclusively in the opposition proceedings. Hence, the Board sees no reason why the appellant should be limited to file auxiliary requests which on a prima facie basis overcome all outstanding objections raised in the opposition proceedings. The purpose of the appeal proceedings is instead to focus on the grounds discussed in the appealed decision. This condition is clearly met by auxiliary request 1.

2.7 In view of the above, the Board decided to admit auxiliary request 1 into the appeal proceedings, exercising its discretion under Article 13(1) RPBA 2020.

3. Auxiliary request 1 - Article 123(2) EPC

3.1 Claim 1 of auxiliary request 1 is based on the wording of claim 1 of the application in which it is further defined that the bottom panel (24) comprises at least one electronic component (feature M1.6).

The wording added to claim 1 of the application ("the bottom panel comprising at least one electronic component") does not change the technical teaching of the application which requires that the bottom panel receive the electronic component (see claim 1, paragraphs [0001], [0002], [0005] and [0013] of the

application). A bottom panel which receives an electronic element forms an assembly which comprises both the bottom panel and the electronic component. The addition of the further expression ("the bottom panel comprising at least one electronic component") into claim 1 does not change this technical teaching of the application.

3.2 The respondent objected to the amendment of claim 1 since claim 1 still contains feature M1.6.

However, the corresponding objection against this feature in claim 1 of the main request is based on the fact that feature M1.6a in claim 1 of the application is replaced by feature M1.6.

Although the terms "comprising" and "receiving" in the context of claim 1 have different meanings, no added matter can be identified in comparison to the application when both terms are simultaneously present according to features M1.6 and M1.6A of claim 1 of auxiliary request 1.

In its letter dated 13 June 2022, the respondent also did not give any example of subject-matter generated by the amended claim 1 that extends beyond the technical teaching of the application.

The Board is thus of the opinion that the amendments made to claim 1 of auxiliary request 1 fulfil the requirements of Article 123(2) EPC.

4. Auxiliary request 1 - Article 123(3) EPC

Claim 1 of auxiliary request 1 is based on the wording of claim 1 as granted and further requires in addition that the bottom panel (24) receive the at least one electronic component (feature M1.6A).

Compared to claim 1 as granted, the scope of protection has therefore been limited due to the addition of feature M1.6A since the added feature implies that the bottom panel is shaped in a specific manner for receiving the electronic component.

The respondent has not provided any argument under Article 123(3) EPC and therefore has not disputed this assessment by the Board.

The Board therefore concludes that the amendments in claim 1 according to auxiliary request 1 fulfil the requirements of Article 123(3) EPC.

5. Remittal of the case (Article 111(1) EPC)

Under Article 11 RPBA 2020, the Board may remit the case to the department whose decision was appealed if there are special reasons for doing so.

In the current case, the opposition division did not decide on the issues arising from the grounds for opposition pursuant to Articles 100(a) and (b) EPC.

In addition, both parties requested that the case be remitted to the department of first instance if it became necessary to evaluate these issues.

Taking into account these special reasons, the Board decided to remit the case in accordance with Article 11 RPBA 2020 to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The decision is set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of auxiliary request 1 filed with the letter dated 1 April 2022.

The Registrar:

The Chairwoman:



C. Spira

D. Prietzel-Funk

Decision electronically authenticated