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**Datasheet for the decision
of 27 January 2023**

Case Number: T 0061/21 - 3.2.07

Application Number: 15777677.4

Publication Number: 3204197

IPC: B26B19/38

Language of the proceedings: EN

Title of invention:

ELECTRICAL APPLIANCE FOR PERFORMING A CUTTING ACTION ON HAIRS
AS PRESENT ON AN AREA OF SKIN

Patent Proprietor:

Koninklijke Philips N.V.

Opponent:

THE PROCTER & GAMBLE COMPANY

Headword:

Relevant legal provisions:

EPC Art. 100(b), 100(a), 54, 56
RPBA 2020 Art. 12(2), 12(6), 15(1)

Keyword:

Sufficiency of disclosure - main request (yes)
Novelty - main request (yes)
Inventive step - main request (yes)
Late-filed evidence (I) - admitted in first-instance proceedings (no) - error in use of discretion at first instance (no) (II) - should have been submitted in first-instance proceedings (yes) - circumstances of appeal case justify admittance (no)

Decisions cited:

T 0238/92, T 0541/96, T 0063/06, T 0491/08

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0061/21 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 27 January 2023

Appellant: THE PROCTER & GAMBLE COMPANY
(Opponent) One Procter & Gamble Plaza
Cincinnati, Ohio 45202 (US)

Representative: Thoma, Michael
Lorenz Seidler Gossel
Rechtsanwälte Patentanwälte
Partnerschaft mbB
Widenmayerstraße 23
80538 München (DE)

Respondent: Koninklijke Philips N.V.
(Patent Proprietor) High Tech Campus 52
5656 AG Eindhoven (NL)

Representative: Philips Intellectual Property & Standards
High Tech Campus 52
5656 AG Eindhoven (NL)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 12 October 2020
rejecting the opposition filed against European
patent No. 3204197 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman I. Beckedorf
Members: S. Watson
V. Bevilacqua

Summary of Facts and Submissions

- I. An appeal was filed by the opponent in the prescribed form and within the prescribed time limit against the decision of the opposition division rejecting the opposition against European patent No. 3 204 197.
- II. The opposition division found that the grounds for opposition raised by the opponent, namely lack of novelty and inventive step of the subject-matter of claim 1 (Article 100(a) EPC) as well as insufficiency of disclosure (Article 100(b) EPC), did not prejudice the maintenance of the patent as granted.
- III. In preparation for oral proceedings the Board gave its preliminary opinion in a communication pursuant to Article 15(1) RPBA 2020 of 28 June 2022 to which the opponent responded with its submissions of 4 October 2022.
- IV. Oral proceedings before the Board took place on 27 January 2023. At the conclusion of the proceedings the decision was announced. Further details of the proceedings can be found in the minutes.
- V. The following documents are mentioned in this decision:
- D1: JP 04-105685
 - D1a: English translation of D1 filed
19 March 2019
 - D2: US 5,600,888
 - D5: JP 07-124344
 - D5a: English translation of D5 filed
19 March 2019
 - D6: Axén, N. et al (2001), 'Friction and wear

measurement techniques', Bhushan, B. (ed.)
Modern tribology handbook, Boca Raton: CRC
Press LLC, chapter 13

D8: EP 1 418 027 A1

D10: US 5,599,112

D11: US 5,274,735.

VI. The final requests of the parties are as follows:

for the opponent (appellant):

that the decision under appeal be set aside and
that the patent be revoked in its entirety,

for the patent proprietor (respondent):

that the appeal be dismissed; or

if the decision is set aside, that the patent be
maintained in amended form according to the set of
claims of the auxiliary request submitted with
letter dated 14 July 2020.

VII. The arguments of the parties are dealt with in detail
in the reasons for the decision.

VIII. Independent claim 1 of the patent as granted reads as
follows:

"Electrical appliance (1) for performing a cutting
action on hairs present on an area of skin (7),
comprising:

- a functional head (4) having at least one movably
arranged internal cutting member (5) for cutting
off the hairs, and further having an external
cutting member (6) for contacting the area of
skin (7), wherein the external cutting member (6)
is arranged in the functional head (4) to cover
and contact the internal cutting member (5), and
wherein the external cutting member (6) is

provided with hair-entry apertures (8) for allowing the hairs to penetrate the external cutting member (6) and thereby encounter the internal cutting member (5); and

- a motor for driving the internal cutting member (5) of the functional head (4); characterized in that the cutting members (5, 6) of the functional head (4) are designed such that friction between said cutting members (5, 6) is related to a condition of wear of the cutting members (5, 6) according to a predetermined relation;

wherein the appliance (1) is equipped with measuring means for performing a measurement of a parameter related to the friction between the cutting members (5, 6), processing means for processing the measured parameter and thereby determining an actual condition of wear of the cutting members (5, 6) on the basis of the measured parameter, and indicating means (9) for providing a user (3) of the appliance (1) with information relating to the actual condition of wear of the cutting members (5, 6)."

IX. As the auxiliary request does not form part of this decision it is unnecessary to reproduce its independent claim here.

Reasons for the Decision

1. *Sufficiency of disclosure - Article 100(b) EPC - review of the decision under appeal*

1.1 The opposition division found in the decision under appeal (see point II.2.1.3), that the invention was sufficiently clearly and completely disclosed for the skilled person to carry it out.

The opposition division reasoned that the examples given in paragraphs [0016] to [0017], as well as the description in paragraphs [0027] to [0033] and [0036] to [0043] of the embodiments represented in figures 2 to 9, clearly explained how the cutting members were designed such that friction between them related to a condition of wear according to a predetermined relation, as was required by feature A7 of claim 1:

"the cutting members (5, 6) of the functional head (4) are designed such that friction between said cutting members (5, 6) is related to a condition of wear of the cutting members (5, 6) according to a predetermined relation".

- 1.2 It is established case law of the Boards of Appeal that a lack of sufficiency of disclosure presupposes that there are serious doubts, substantiated by verifiable facts. In order to establish insufficiency of disclosure in inter partes proceedings, the burden of proof is on the opponent to show, on the balance of probabilities, that the skilled person is unable to carry out the invention (Case law of the Boards of Appeal (CLB), 10th edition, 2022, II.C.9.).
- 1.3 The appellant has not shown that the invention is insufficiently disclosed such that it cannot be carried out. For example, the appellant has not demonstrated that it was unable to successfully reproduce the examples provided in the patent specification.
- 1.4 The appellant brought forward the argument at oral proceedings before the Board, that if there was only a weak presumption of sufficiency of disclosure of a patent, that this would lead to a reversal of the burden of proof. In the present case, according to the

appellant, there could only be a weak presumption that the claimed invention was sufficiently disclosed as no concrete examples of predetermined relations, for example in terms of mathematical functions, were disclosed (the appellant cited decisions T 63/06, T 491/08 in support of this point) and in addition, paragraph [0015] of the patent in suit contained statements which appeared not to be compatible with Amontons' laws of friction (the appellant cited decision T 541/96 in support of this point).

- 1.4.1 Whether a strong or weak presumption of sufficiency exists must be considered on the facts of each individual case.

The Board notes that the three decisions cited by the appellant relate to very different technical areas than the present case.

As reasoned by the opposition division in point II. 2.1.3 of the decision under appeal, the patent in suit does give a number of examples showing the skilled person how the invention can be carried out. The patent specification also demonstrates how cutting members can be designed so that there is a predetermined relation between friction between the cutting members and a condition of wear.

Neither of the decisions cited by the appellant on this point contain a number of specific examples. In decision T 63/06 it was not contested that the patent specification did not describe how to generate flame kernels having a size of 1 mm or more without a flame nozzle (Reasons, 2.3.1). In T 491/08, relating to human vaccines, only a single animal model had been disclosed, with a specific study design. The competent Board in that case found that only a weak presumption

of sufficiency of disclosure was present as neither the application nor the skilled person's common general knowledge provided sufficient information (Reasons, 5. and 8. to 10.).

Regarding the appellant's second point in support of a rebuttal of a strong presumption of validity, the Board notes that the case underlying the decision in T 541/96 related to inducing fusion between light and heavy unstable nuclei at low temperature by means of an electric field. The Board in that case found that the applicant had outlined a hypothetical experimental set-up but had not provided evidence that it would be possible to achieve the claimed result under realistic laboratory conditions. The Board in decision T 541/96 set out that the amount of information required for a sufficient disclosure of an invention depends on the nature of the invention and the technical field (see Reasons 6.2).

In the present case, examples of cutting blades where blades comprise pins, projections or recesses in various positions, or made of different layers of material with different coefficients of friction, are all disclosed in the patent in suit. In light of the different examples of cutting member designs shown in the patent in suit and the particular technical field of the invention, any possible inconsistencies in a paragraph of the description are not sufficient to shift the burden of proof to the patent proprietor.

- 1.5 The Board therefore finds the arguments of the appellant, that the opposition division was incorrect in finding that the claimed invention is sufficiently disclosed, unconvincing.

2. *Sufficiency of disclosure - Article 100(b) EPC -
admittance of new objections*

- 2.1 In its statement of grounds of appeal (section P2, pages 7 to 10), the appellant argued that the findings of the opposition division were incomplete as the question of whether feature A7 of the invention could be carried out across the entire scope claimed had not been considered; the patent as a whole did not specify the predetermined relation between friction and wear, found in feature A7, in mathematical or parametrical terms; and no means of measuring a predetermined relation are provided in the patent in suit.
- 2.2 The respondent, in its reply to the statement of grounds of appeal (point 3.) and during oral proceedings before the Board, requested that the parts of the appellant's submissions made in its statement of grounds of appeal and developed during oral proceedings before the Board, which were not presented during opposition proceedings, not be admitted into the appeal proceedings as these submissions related to newly alleged facts and objections and consequently did not form part of the decision under appeal.
- 2.3 With its submissions of 4 October 2022 (paragraph bridging pages 1 and 2) and at the oral proceedings before the Board, the appellant argued that no new facts were presented as the objections were raised with its notice of opposition on pages 5 and 6, point 2.
- 2.4 The Board however agrees with the respondent that the objections do not appear to have been raised during opposition proceedings although the appellant had had the opportunity to do so.

2.4.1 The passage referred to by the appellant on page 5 of the notice of opposition merely notes that feature A7 is broad and non-specific and this breadth must be taken into account when assessing claim 1 against the prior art, as it is considered to be part of the design of all electric dry shavers.

In point 2. of the notice of opposition (page 6), the appellant argued that feature A7 is "insufficient to the extent that it is interpreted as not encompassing the routine design process for blades for a dry electric shaver" (notice of opposition, page 6, second paragraph). The following passage (page 6, third and fourth paragraphs) sets out the objection that the skilled person was unable to understand what the design of feature A7 entails and would need to perform a research programme based on trial and error to determine which parameters should be varied in order to achieve the requirements of feature A7. The large number of parameters to consider would make such a research programme onerous to conduct.

There was no mention in the notice of opposition that feature A7 of the claimed invention could not be performed across the entire range of claim 1 nor that the predetermined relation was not shown in mathematical terms, nor that the patent provided no measurement set-up for measuring the predetermined relation according to the feature A7.

2.4.2 With its reply to the notice of opposition (point 3) the respondent argued that the patent specification disclosed several ways of carrying out feature A7 of claim 1 as granted.

2.4.3 The opposition division's preliminary opinion essentially agreed with the arguments brought forward by the respondent that the invention was sufficiently disclosed (annex to the summons to oral proceedings, point 5.1).

The appellant made no further written submissions on this point. During oral proceedings before the opposition division both parties referred to their written submissions only (minutes of the oral proceedings before the opposition division, page 1).

Therefore, although the appellant was aware that the opposition division's preliminary view was that the claimed invention was sufficiently disclosed, it chose not to make any further submissions on this point.

The opposition division's findings in the decision under appeal (see point II.2.1.3) correspond to the opposition division's preliminary opinion as set out in point 5.1.3 of the annex to the summons to oral proceedings before the opposition division.

2.4.4 Therefore, the further objections that the appellant raised in its statement of grounds of appeal relating to Article 100(b) EPC, which did not form part of the decision under appeal, were not raised during the opposition proceedings although they could and should have been.

2.5 According to Article 12(6), second sentence, RPBA 2020, the Board shall not admit objections which should have been submitted in the proceedings leading to the decision under appeal, unless the circumstances of the case justify their admittance. In the present case, the appellant has not provided any justification and the

Board cannot see any. The claims are those of the patent as granted and no surprising or unusual events appear to have occurred during the opposition proceedings which would justify the admittance of new objections during the appeal proceedings.

The Board thus does not admit any of the new objections raised by the opponent into the appeal proceedings (Article 12(6), second sentence, RPBA 2020).

3. *Novelty - Article 100(a) EPC with Article 54 EPC - claim 1 as granted - document D1/D1a*

3.1 The opposition division found (see the decision under appeal, point II.2.2.3) that the third embodiment of document D1 (as disclosed in D1a on page 611, left-hand column, final paragraph to right-hand column, penultimate paragraph and figures 8 to 11) did not disclose feature A7.

3.2 The appellant argued that the opposition division's finding was incorrect as document D1 showed all features of claim 1 as granted because feature A7 was either inherently (statement of grounds of appeal, page 10, lines 21 to 38) or explicitly disclosed in the third embodiment of D1 (statement of grounds of appeal, page 11, line 1 to page 14, line 18).

3.3 Inherent disclosure of feature A7

3.3.1 The opposition division interpreted feature A7 as requiring that "the cutting members are manufactured such that the friction between these members changes according to a predefined relationship dependent on the level of wear of said cutting members". It also found that such an interpretation was consistent with the

embodiments described in the patent in suit (decision under appeal, point II.2.2.3, first paragraph).

- 3.3.2 The appellant argued that the opposition division had unduly limited feature A7 in particular by applying an interpretation based on paragraph [0009] of the patent specification (see statement of grounds of appeal, point P1, pages 5 to 7).

According to the appellant, it is inherent in the physics of the operation of the device of D1 that "friction between the outer and inner blade relates to a condition of wear according to a predetermined relation" because "friction between all sliding surfaces is related to wear according to a predetermined relation". Therefore, any arbitrary electric shaver always had cutting members with a "predetermined relation" between friction and wear (see statement of grounds of appeal, page 10, final two paragraphs).

The appellant referred in particular to section 13.2 of document D6, a tribology handbook, and argued that as D6 explains that wear can be quantified in terms of friction forces, that it is common general knowledge that "an actual condition of wear can be estimated based on friction forces" because "friction forces are proportional to the amount of wear" (see statement of grounds of appeal, page 4, lines 38 to 41).

In its submissions of 4 October 2022 and during oral proceedings before the Board, the appellant further argued that feature A7 did not define or specify the predetermined relation and did not require that the friction between the cutting members was dependent on a condition of wear in a predictable, foreseeable manner, only that it was related to it. No connection existed

between "a condition of wear" in feature A7 and "an actual condition of wear" in feature A9 ("*processing means for processing the measured parameter and thereby determining an actual condition of wear of the cutting members (5,6) on the basis of the measure parameter*") of claim 1 as granted.

According to the appellant, all that was required for a prior art apparatus to disclose features A8 ("*wherein the appliance (1) is equipped with measuring means for performing a measurement of a parameter related to the friction between the cutting members (5,6)*") and A9 was that measuring and processing means were present which were suitable for measuring a parameter related to the friction between the cutting members and for processing such a measured parameter and determining an actual condition of wear.

- 3.3.3 The Board is not convinced by the opponent's arguments that the opposition division interpreted feature A7 in an unduly restricted manner. Feature A7 requires that the blades are designed so that friction between the cutting members is related to a condition of wear according to a predetermined relation. The Board is of the view that the skilled person understands feature A7 as meaning that the cutting members are designed so that friction between them is related to a condition of wear in a way that is intentional and foreseeable. Claim 1 does not however require that the predetermined relation has to be given in mathematical form, there is no requirement that a function is shown encompassing the relation between friction and wear in all circumstances.

Considering the claim as a whole, it is necessary that the relation between friction between the cutting members and a condition of wear of the cutting members

(feature A7) be determined in advance of use of the appliance, i.e. a predetermined relation, so that the processing means are able to process the measured parameter related to the friction between the cutting members and thereby determine the actual condition of wear according to features A8 and A9 of claim 1 as granted.

The appellant's argument that the condition of wear in feature A7 is not related to the condition of wear in feature A9 is not convincing. The skilled person reads the claims with synthetical propensity to arrive at an interpretation of the claim which is technically sensible (see CLB, *supra*, II.A.6.1, first paragraph).

With respect to the appellant's argument relating to document D6, the Board agrees with the respondent's arguments that the passage cited by the appellant does not relate to the system in an electric shaver and does not suggest any predetermined relation according to which friction relates to a condition of wear. It merely discloses that both friction and wear may be separately quantified (see reply to the statement of grounds of appeal, page 3, final paragraph). Thus, the assertion of the appellant that every electric shaver inherently includes feature A7 remains unproven (see reply to the statement of grounds of appeal, page 3, penultimate paragraph).

In addition, as also argued by the respondent, it is not clear in what way the opposition division limited the interpretation of feature A7 by using paragraph [0009] which relates to the subject-matter of claim 2 as granted (see reply to the statement of the grounds of appeal, page 4, second paragraph).

Therefore, the Board is not convinced by the appellant's arguments that document D1/D1a inherently discloses feature A7.

3.4 Explicit disclosure of feature A7

3.4.1 The opposition division found that the third embodiment in document D1/D1a disclosed that the cutting resistance increased due to wear and that friction between members is detected, but that there was no disclosure of the friction between the cutting members being related to a predetermined condition of wear as the increase in temperature disclosed in D1a "might detect an increase in the level of wear of the outer cutting member only or an increase in the level of wear in both the cutting member with regard to the user (i.e. cutting resistance) and between the members" (see decision under appeal, point 2.2.3, second paragraph).

3.4.2 The appellant argued that the decision is incorrect as D1a discloses on page 611, right-hand column, penultimate paragraph and in figures 8 and 11 that the temperature rise measured by the temperature-sensitive layer is attributable to the friction between the inner and outer cutters and generates a wear indication signal based upon this friction according to a predetermined relation. In particular the appellant argued that the cited passage on page 611 of document D1a discloses that the temperature rise due to the sliding resistance is detected (statement of grounds of appeal, pages 11 to 12).

3.4.3 The Board however agrees with the arguments of the respondent set out in the reply to the statement of grounds of appeal, page 7, third paragraph). Document D1a discloses on page 611, right-hand column, second

paragraph, that the temperature detection layer on the inner blade "serves to detect an increase in cutting resistance due to wear and the associated temperature rise". Figure 11 is described on page 612, right column, as illustrating the relationship between the temperature rise due to cutting resistance and the frequency of use. On page 611, right column, penultimate paragraph, it is disclosed that the lifespan can be sensed by detecting the temperature rise due to the cutting resistance as illustrated in figure 11. The single mention of the sliding resistance in this paragraph only discloses that a temperature rise is detected related to the sliding resistance. The paragraph continues that the temperature will increase as shaving increases.

There is no disclosure that a temperature change is measured which is related to the sliding resistance related to a condition of wear according to a predetermined relation.

3.4.4 The appellant argued further that D1a discloses an electrical appliance "capable of measuring a temperature rise when the device is switched on but not actively cutting hairs" when any temperature rise would only be attributable to sliding resistance between the cutting members (see statement of grounds of appeal, page 13, lines 29 to 31).

The Board cannot follow this argument and agrees with the respondent that there is no disclosure in D1a that such a measurement is foreseen and there is in any case no disclosure of feature A7, that the friction between the cutting members is related to a condition of wear of the cutting members according to a predetermined relation (reply to the statement of grounds of appeal, page 9, fourth paragraph).

3.5 The appellant therefore has not convincingly shown that the decision under appeal is incorrect regarding the objection to lack of novelty of the subject-matter of claim 1 with respect to document D1.

4. *Novelty - Article 100(a) EPC with Article 54 EPC - claim 1 as granted - document D2*

4.1 The opposition division found that document D2 did not disclose feature A7 because the feature "how the friction varies depending on the level of wear between cutting members according to a predetermined relationship cannot be clearly and unambiguously derived" (see decision under appeal, page 10, first two paragraphs).

4.2 The appellant argues that the decision is incorrect because it is disclosed in document D2 that after 30 or 35 hours of active use an indicator informs the user that the blades should be replaced due to wear. This requires that the designer of the cutting blades must know that after 30 or 35 hours the blades are worn, *i.e.* there is a predetermined relation which "links a total amount of (increased) friction between the blades to a condition of wear" (see statement of grounds of appeal, page 17, lines 25 to 29).

4.3 The Board however agrees with the respondent that document D2 does not disclose feature A7. In D2 there is an implied predetermined relation between the total time of actual loading of the shaver and the condition of wear of the blade, and the skilled person may be aware in general that as an applied load increases friction increases, but this does not imply that the cutting members are designed so that there is a predetermined relation between friction between the

cutting members and a condition of wear of the cutting members (see reply to the statement of grounds of appeal, page 11, first complete paragraph).

- 4.4 For essentially the same reasons, the appellant's arguments that the embodiment of D2, which describes an integrator which sums the consumption of the motor until a predefined level is reached when a blade replacement indicator is triggered, also discloses feature A7 cannot be followed (see statement of grounds of appeal, page 18, third and fourth paragraphs).

As the respondent argues, this embodiment discloses that there is a predetermined relation between accumulated total current consumption and blade wear but it does not disclose that the friction between the cutting members is related to a condition of wear according to a predetermined relation (see reply to the statement of grounds of appeal, page 11, fourth paragraph).

- 4.5 The appellant therefore has not convincingly shown that the decision under appeal is incorrect regarding the objection to lack of novelty of the subject-matter of claim 1 with respect to document D2.

5. *Inventive step - Article 100(a) EPC with Article 56 EPC - claim 1*

- 5.1 The opposition division found that the subject-matter of claim 1 as granted was not obvious over the combination of the teaching of either document D1 or D2 together with the teaching of either document D5 or D8 or with the common general knowledge of the skilled person (see decision under appeal, 2.2.5.3).

5.2 Starting from document D1 or D2, the opposition division found in both cases that the distinguishing feature of claim 1 was feature A7.

5.2.1 In its statement of grounds of appeal (page 23, lines 21 to 25), the appellant argued that only part of feature A7, namely "according to a predetermined relation" is not known from documents D1 or D2.

The opposition division found that the technical effect of the distinguishing feature was to provide a reliable indication of the actual condition of wear, which was reproducible for various sets of cutting members of the same type. The objective technical problem to be considered was therefore "to provide an electrical appliance having a more accurate and reliable wear-indicating functionality than time-based warning systems" (decision under appeal, page 15, first paragraph).

The appellant contested this and argued that the objective technical problem formulated by the opposition division was too ambitious and should be reformulated as:

"how to improve the reliability and reproducibility of the system indicating an actual condition of wear as disclosed in the closest prior art".

5.2.2 However, even if the arguments of the appellant on these points were to be accepted, the Board follows the findings of the opposition division that the subject-matter of claim 1 is inventive. It is therefore unnecessary to consider whether the distinguishing feature and objective technical problem put forward by the appellant are correct or not.

- 5.3 Combination of the teaching of document D1 or D2 with the teaching of document D5/D5a
- 5.3.1 The opposition division found that document D5 did not teach that heat generated by sliding friction could be used as a parameter to monitor the level of wear of the blades but rather disclosed the use of sequential layers to enable visual inspection. Therefore even if the skilled person were to combine the teaching of document D5 in the electrical appliance of either document D1 or D2, the measurement and processing means would be replaced by the visual indicator (see decision under appeal, page 15, third paragraph).
- 5.3.2 According to the appellant the opposition division's decision is incorrect as it is not based on the embodiment of document D5 which was referenced by the appellant in the opposition proceedings. The appellant had argued that paragraphs [0032] and [0033] of D5a disclosed layers having different coefficients of friction and that it would be obvious for the skilled person to combine this embodiment with the appliances of documents D1 or D2 as it is already taught in these documents that temperature and motor consumption respectively are dependent on friction between the cutting members (see statement of grounds of appeal, page 24, line 1 to page 25, line 25).
- 5.3.3 The Board does not find the appellant's arguments convincing. As the respondent argued (reply to statement of grounds of appeal, page 14, penultimate paragraph), paragraph [0032] of document D5a discloses that different coefficients of friction are used to provide a different feel to the user in addition to the colour identification, therefore the teaching of

paragraph [0032] of D5a is to provide a visual and tactile indication to a user.

The Board agrees with the opposition division's findings that a combination of the two documents would not lead to the subject-matter of claim 1 as the skilled person, if they were motivated to combine the two documents, would replace the measuring and indicating means of documents D1 and D2 with the direct visual and tactile indicators of paragraph [0032] of document D5 because document D5 clearly teaches to use the change in feeling to the user to recognize the wear of the outer blade.

In addition, the Board also agrees with the respondent that there is no unambiguous disclosure in D5 of layers of the inner face of the outer blade having different coefficients of friction (page 15, first and second complete paragraphs).

- 5.3.4 The appellant argued that the skilled person would not replace major components of the appliances of D1 or D2 but would rather take only the use of layers with different coefficients of friction from document D5 as the skilled person "would realise that application of such a coating to the inner surface of the outer blade of either D1 or D2 would create a detectable signal in the parameter that the wear indicator of each document already measures" (statement of grounds of appeal, page 25, third paragraph).

This argument is based on hindsight. Document D5 is not concerned with automatic measurement of a parameter related to wear and contains no indication which would motivate the skilled person to combine the teaching of document D5 with the appliances of document D1 or D2 regardless of whether the objective technical problem posed by the opposition division or the appellant is

used (see the reply to the statement of grounds of appeal, page 15, last paragraph).

In its submissions of 4 October 2022 (see page 8) the appellant argued that no hindsight is necessary as implementing a layered coating on the inside of the outer blade in the appliance of D1 or D2 would be the most obvious way to incorporate the teaching of D5 in the appliance of either D1 or D2. The Board cannot see where the motivation in document D5 is found for such a combination.

In its statement of grounds of appeal (see page 25, lines 21 to 25), the appellant has argued that the skilled person has an "implicit motivation" to introduce the coatings of D5 to the appliances of either D1 or D2 as it is evident to the skilled person from their understanding of the interaction of sliding surfaces how these coatings would function in the wear indicator systems of D1 and D2 and specifically how these coatings would generate a readily detectable signal that solves the objective technical problem.

However, in combining the teaching of two patent documents in order to solve an objective technical problem, it is generally required that there is a recognisable pointer in the state of the art to combine the teaching thereof. It is not sufficient that the skilled person could have combined them, it must be shown that they would have combined them (CLB, *supra*, I.D.5). The appellant did not indicate any specific passages of D5 which would prompt the skilled person to combine the teaching and the Board cannot see any motivation which would lead the skilled person to such a combination, without prior knowledge of the invention.

5.3.5 Therefore the appellant's arguments regarding the incorrectness of the decision under appeal with respect to the combination of the teaching of documents D1 or D2 with that of document D5 are not convincing.

5.4 Combination of the teaching of document D1 with the teaching of document D8

5.4.1 The opposition division found that document D8 did not disclose feature A7 as even if paragraph [0020] were to be understood as containing a direct or indirect reference to both wear and friction, the document did not give any indication on the choice of the parameters according to a predetermined relation (decision under appeal, page 15, second paragraph).

5.4.2 The appellant argued that document D1, figure 11, showed a relationship between temperature rise and frequency of use because "a change in the fairly linear steady state relationship" is used in D1 to signify that cutting members need to be replaced. Therefore as D1 already used the change in temperature rise as a signal of wear and D8 teaches that "the temperature rise can be changed by addition of a protrusion or recess to the cutting members", it would be obvious for the skilled person that the protrusion or recess in the blade of D8 would give greater control over the change in temperature and would therefore improve the appliance of D1 (see statement of grounds of appeal, page 26, second paragraph).

5.4.3 However, paragraph [0020] teaches only that the provision of a recess or a protrusion can reduce sliding resistance and thus also associated temperature increases. As reasoned by the opposition division, this

is not a disclosure of a predetermined relation between friction and condition of wear.

As the respondent argues, document D8 is completely silent regarding wear of the blades so that the skilled person has no motivation to combine the teachings, irrespective of the precise objective technical problem to be solved. The appellant's objections are based on hindsight. The skilled person, without knowledge of the invention, would have no reason to expect an improvement in wear detection by including a feature which is intended to reduce sliding resistance and associated temperature increases (see reply to the statement of grounds of appeal, paragraph bridging pages 16 and 17).

With its submissions of 4 October 2022 (page 9, final paragraph) the appellant argued that there was no need for D8 to explicitly disclose the relationship between sliding resistance/temperature and wear as the skilled person, starting from documents D1 and D2 is trying to solve an objective technical problem which already sets the goal of improving wear indication.

The Board, however, cannot see why, when trying to improve wear indication the skilled person would turn to a document with no relation to wear indication. Even if the skilled person learns from D8 that sliding resistance and rises in temperature can be reduced, there is nothing in document D8 to indicate to the skilled person that if the protrusion were to be worn off, the ensuing abrupt temperature increase could be used in the appliances of documents D1 or D2.

5.4.4 Therefore the appellant's arguments regarding the incorrectness of the decision under appeal with respect

to the combination of the teaching of documents D1 or D2 with that of document D8 are not convincing.

5.5 Combination of the teaching of document D1 or D2 with the common general knowledge of the skilled person

5.5.1 The appellant argued that the opposition division's findings in the decision under appeal were incorrect because the findings did not start from a correct interpretation of documents D1 and D2. It was already known from documents D1 and D2 that actual wear of the cutting members is to be measured indirectly using a suitable parameter and both documents show measuring and processing means for this parameter.

According to the appellant, it is part of the normal course of designing cutting members for electric shavers that choices will be made relating to cutting members' size, shape, material and area of contact with one another. Each of these choices will affect the friction between the cutting members, which will effect the wear. As there is no limitation regarding the "predetermined relation" in claim 1, the routine selections are "akin to choosing the predetermined relation between friction and wear" (statement of grounds of appeal, page 27, lines 13 to 25).

5.5.2 The Board however follows the arguments of the respondent (reply to the statement of grounds of appeal, page 17, penultimate paragraph and page 3, final paragraph to page 4, first paragraph), that the appellant has provided no evidence that designing cutting members such that friction between them is related to a condition of wear of the members according to a predetermined relation forms part of the skilled person's common general knowledge. Therefore, as found

by the opposition division, a combination of the appliances of documents D1 or D2 with common general knowledge cannot lead to the subject-matter of claim 1.

5.6 *Non-admittance of D10 by the opposition division*

5.6.1 The opposition division did not admit document D10 into the opposition proceedings finding it late-filed and not prima facie relevant (see decision under appeal, 2.2.3.3).

5.6.2 The appellant argued that the opposition division was incorrect to not admit document D10 as it was filed two months before the oral proceedings were held, in direct response to the preliminary opinion of the opposition division regarding document D2 and was prima facie relevant. When deciding not to admit document D10, the opposition division had incorrectly placed excessive weight on the supposed remoteness of the document without considering the context of the claimed invention (see statement of grounds of appeal, point P5).

5.6.3 The appellant filed document D10 after the nine-month period under Article 99(1) EPC but before the final date for making written submissions according to Rule 116(1) EPC. It is established case law that evidence submitted after the nine-month period is generally to be regarded as late, unless special circumstances apply, for example the subject of the proceedings has changed (CLB, *supra*, IV.C.4.3.2).

The appellant argues that D10 was filed in direct response to the preliminary opinion of the opposition division that document D2 did not disclose feature A7, and sought to elaborate on the relationship between

friction, wear and motor power consumption. The Board does not consider that the preliminary opinion of the opposition division changed the subject of the proceedings. Firstly, the claims remained as in the granted patent and secondly, the opposition division's preliminary opinion (annex to the summons to oral proceedings, page 4, first to third paragraphs) was that feature A7 was not disclosed in document D2, as had already been put forward by the respondent in its reply to the notice of opposition (section 4.2).

Therefore the Board is of the opinion that document D10 was not filed in due time and that the opposition division did have discretion to disregard this document.

- 5.6.4 As noted by the respondent (see reply to statement of grounds of appeal, page 12, second and third paragraphs), it is established case law that if a discretionary decision of an opposition division is challenged it is not for the Board to review all the facts and circumstances as if it were the opposition division. A Board should only overrule the way in which an opposition division has exercised its discretion if it comes to the conclusion that the opposition division used the wrong principles, or did not take into account the right principles or exercised its discretion in an unreasonable or arbitrary manner (CLB, *supra*, IV.C.4.5.2 and V.A.3.4.1 b), first paragraph).
- 5.6.5 All of the arguments raised by the appellant in its statement of grounds of appeal (pages 19 to 21, penultimate paragraph) address why the opposition division, according to the appellant, should have found document D10 *prima facie* relevant, rather than demonstrating that the opposition division followed

incorrect principles or used its discretion unreasonably. The two decisions cited by the appellant are not relevant as neither one refers to a discretionary decision of an opposition division to disregard a late-filed document.

5.6.6 In its submissions of 4 October 2022 (page 10, second paragraph to page 11, second paragraph) the appellant argued that the opposition division based its decision on the wrong principles or at least did not take into account the right principles. Since document D10 clearly showed feature A7, which was a decisive feature for the outcome of the case, D10 was *prima facie* relevant to the decision to be taken by the opposition division.

5.6.7 In the Board's view the opposition division exercised its discretion reasonably and according to the right criteria.

The opposition division heard both parties arguments regarding admittance of D10 (see minutes of oral proceedings before the opposition division, page 2, penultimate paragraph) and based its decision on the criterion of *prima facie* relevance which is recognised as being a decisive criteria for such a decision (see CLB, *supra*, IV.C.4.5.3 a), first two paragraphs).

The opposition division found that as the technical field of D10 (centrifugal pumps) was so remote from the technical field of document D2 (electrical appliances for cutting hair) that a *prima facie* assessment of document D10 led to the conclusion that the skilled person would not combine the teaching of document D10 with the electric razor of document D2 (decision under appeal, page 12, first paragraph).

Therefore, the opposition division correctly carried out a prima facie assessment of the relevance of document D10 to the outcome of the case at hand.

The Board cannot see that the opposition division based its decision on the wrong principles or did not take into account the right principles. That an opposition division comes to a different conclusion to one of the parties in an opposition proceedings regarding the prima facie relevance of a late-filed document is to be expected.

5.6.8 There is therefore no reason to overturn the decision of the opposition division not to admit document D10 into the opposition proceedings.

5.7 *Admittance of document D10 into the appeal proceedings*

The appellant further requested that D10 be admitted into the appeal proceedings in accordance with principles established in T 238/92, that a document is not considered to be late-filed if it "serves as clear evidence of the feature relied upon by the Opposition Division to find an inventive step" (see statement of grounds of appeal, page 21, final paragraph).

5.7.1 The respondent argues that this request is not allowable as document D10 was already presented in the opposition proceedings so that the cited case law does not apply (reply to the statement of grounds of appeal, penultimate paragraph).

5.7.2 The Board notes that pursuant to Article 12(6), first sentence, RPBA 2020, evidence shall not be admitted into appeal proceedings which was not admitted into the proceedings leading to the decision under appeal,

unless the decision not to admit it suffered from an error in the use of discretion or unless the circumstances of the appeal case justify its admittance.

As set out above in point 5.5, the Board does not see any error in the opposition division's use of its discretion.

The Board also sees no circumstances in the present case which would justify the admittance of document D10. The claims under consideration are the claims of the patent as granted. The appellant argues that the filing of document D10 was as a response to the opposition division's preliminary opinion. However, as the opposition division found the same distinguishing feature in document D2 as had been put forward by the respondent in its reply to the notice of opposition, the preliminary opinion could not have been seen as an unexpected turn of events or as changing the subject of the proceedings.

5.7.3 In the absence of any circumstances justifying its admittance the document D10 and its associated lines of attack are not admitted into the appeal proceedings.

5.8 *Admittance of D11*

5.8.1 The appellant filed document D11 for the first time with its statement of grounds of appeal and requested its admittance into the appeal proceedings. The appellant argued that document D11 is prima facie relevant and was filed as a direct response to a new position taken by the opposition division for the first time in the decision under appeal (see statement of grounds of appeal, page 30, lines 8 to 35).

- 5.8.2 The respondent requested that document D11 not be admitted into the appeal proceedings (reply to the statement of grounds of appeal, point 11., first paragraph).
- 5.8.3 According to Article 12(6), second sentence, RPBA 2020, a Board shall not admit evidence which should have been submitted in the proceedings under appeal, unless the circumstances of the case justify their admittance.
- 5.8.4 The appellant argues that the opposition division stated in the decision that "the 'predetermined relation' aspect of Feature A7 could not be derived from D2", whereas in the preliminary opinion the opposition division had reasoned that "there was some predetermined relation but that Feature A7 was not disclosed in D2 owing to hypothetical additional sources of friction affecting this predetermined relation" (see statement of grounds of appeal, page 30, lines 27 to 35).
- 5.8.5 In the Board's view, any difference between the reasoning given in the preliminary opinion of the opposition division (see page 4, third paragraph of the annex to the summons) and its reasoning in the decision (see page 10, second paragraph of the decision under appeal) is insufficient to be regarded as changing the framework of the proceedings such that the filing of new evidence would be justified.

In the decision under appeal the opposition division found that there was no direct and unambiguous disclosure that the cutting members are designed so that the friction between them is related to a condition of wear according to a predetermined

relation, even if the monitored parameter "power consumption of the motor" inevitably took into account the friction between the cutting members.

In the summons to oral proceedings the opposition division had given its preliminary opinion that feature A7 was not known from document D2 (see page 4, second and third paragraphs). The opposition division considered that even if it was disclosed in document D2 that the load on the cutter foil was measured, which would encompass contact with the inner blade, this did not amount to disclosing that the cutting members were designed such that friction between them relates to a predetermined relation of a condition of wear. In the Board's view the mention of further frictional forces by the opposition division in this context did not amount to taking a position that there was a predetermined relation but hypothetical additional sources of friction affected it.

In any case, the opposition division did not change its preliminary opinion that the subject-matter of claim 1 was novel with respect to the disclosure of D2 due to feature A7.

- 5.8.6 No change in the subject of the proceedings can be identified and the claims under consideration remain those of the patent as granted. The Board cannot see any circumstances in the appeal case which would justify admitting new evidence into the appeal proceedings. Therefore, document D11 and its associated lines of attack are not admitted into the appeal proceedings.

6. *Conclusion*

The appellant has not convincingly shown that the decision under appeal was incorrect in finding that none of the grounds for opposition raised by the appellant prejudice the maintenance of the patent as granted. The appeal is therefore to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated