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D E C I S I O N
of 19 June 1998

Case Number: T 0203/95 - 3.2.5

Application Number: 88810668.9

Publication Number: 0328846

IPC: B42F 13/42

Language of the proceedings: EN

Title of invention:

Container for filing sheets removed in a block from a loose-leaf binder

Patentee:

Boldini, Mario

Opponent:

Assayah, Patrick

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), (3)

Keyword:

"Extension beyond the content of the application as filed (main and 1st auxiliary request, yes)"

"Extension of the scope of protection (2nd and 3rd auxiliary request, yes)"

Decisions cited:

-

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0203/95 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 19 June 1999

Appellant: Boldini, mario
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Representative: Fiammenchi, Carlo
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Respondent: Assayah, Patrick
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Representative: Misrachi, Alfred
15, Ch. de la Plantaz
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 15 February 1995
revoking European patent No. 0 328 846 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: A. Burkhart
Members: H. P. Ostertag
C. Holtz

Summary of Facts and Submissions

- I. The appellant (proprietor of the patent) lodged an appeal against the decision of the Opposition Division revoking the patent No. 0 328 846.

Opposition was filed against the patent as a whole and based on Article 100(a) EPC (lack of inventive step) and Article 100(c) EPC (lack of original disclosure).

The Opposition Division held that claim 1 as granted contravened Article 123(2) EPC.

- II. Oral proceedings before the Board of Appeal were held on 19 June 1998.

(i) The appellant (proprietor of the patent) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the patent as granted (main request) or an amended claim 1 as filed on 25 February 1998 (first auxiliary request) or to replace in granted claim 1 the word "flexible" in lines 6 and 17 of page 3 of the patent specification by the word "enveloping" (second auxiliary request) or claim 1 according to the second auxiliary request further amended by the deletion of the words "in order to occupy the minimal volume in view of its file" at the end of the claim (third auxiliary request).

(ii) The respondent (opponent) requested that the appeal be dismissed.

(iii) Claim 1 as granted reads as follows:

"1. Container for filing sheets removed in a block (4) from a loose-leaf binder, comprising an envelope (7) similar to that of a loose-leaf binder but without mechanical elements for holding the sheets, envelope that can be extended in a plane (7', 7", 7"'') in the form of a rectangular sheet, a known closing fastener (11) and a known U-shaped handle (5), characterized in that said rectangular sheet, realized in cardboard, corrugated cardboard, plastic or other flexible material, comprises a pair of holes (9, 9' and 10, 10') at a standardized reciprocal distance and close to each smaller side (AB, CD) of said rectangular sheet, in order to receive said known closing fastener (11), comprising flexible plastic branches (11', 11") and used with said known U-shaped metal handle (5, 5', 5") to perform the removal in block of sheets from the loose-leaf binder and to transfer it to the container, the latter being closed at least in its front and back flexible sides adherent to the block (4) of sheets in order to occupy the minimal volume in view of its file."

Claim 1 according to the first auxiliary request differs from claim 1 as granted in that in line 6 of page 3 of the patent as granted the word "flexible" is replaced by the word "foldable".

(iv) The appellant argued essentially as follows:

It was true that the features "flexible material" and "in order to occupy the minimal volume in view of its file" were not literally disclosed in the application as filed. However, these features were implicitly disclosed therein, since the originally mentioned envelope materials, such as cardboard, corrugated cardboard or plastics, were inherently flexible, and since the property of flexibility of the envelope material was deductible from the original disclosure that the envelope could be extended in a plane and folded as an envelope over the block of sheets.

Therefore, the granted claim 1 did not contravene Article 123(2) EPC.

Since in claim 1 according to the first, second or third auxiliary request the term "flexible material" was replaced by other terms, which were clearly disclosed in the original application, these claims were not objectionable under Article 123(2) EPC.

(v) The respondent argued essentially as follows:

Nowhere in the application as originally filed could any clear or suitable word be found which expressed that the envelope forming the container was of flexible material.

Contrary to the appellant's allegation, it was

perfectly feasible to fold a plane sheet so as to form an envelope and to re-flatten the latter back to the form of a plane sheet, if the sheet was not made of a flexible material.

Therefore, claim 1 as granted contravened Article 123(2) EPC.

The same applied to claim 1 according to the first auxiliary request, which moreover, was - due to deletion of the property "flexible" - objectionable under Article 123(3) EPC.

Also claim 1 according to the second and third auxiliary requests contravened Article 123(3) EPC, since the deletion of the property "flexible" extended the scope of protection of the claim 1 as granted.

Reasons for the Decision

1. *Main request*

- 1.1 It becomes apparent from the application as filed that at the filing date the invention was basically seen in providing a container for filing a block of sheets in which the envelope (7) and the closing fastener (11) form separate pieces: before or after use the envelope extends in a plane in the form of a rectangular sheet and may be stored in this state whereby the closing fasteners may be stored separately. The two pieces are assembled only when they are to be used, whereby the U-shaped metal handle serves as a tool for facilitating

the transfer of the block of sheets from the loose-leaf binder to the container.

In view of objections of lack of inventive step raised during the examining procedure, the appellant (then applicant) amended claim 1 as filed as follows:

- (i) The feature "envelope (7) of cardboard, corrugated cardboard, plastic or other material" was amended by adding the term "flexible" so as to read "...or other flexible material".
- (ii) The feature "...closing the latter" at the end of claim 1 as filed was replaced by the feature "the latter being closed at least in its front and back flexible sides adherent to the block (4) of sheets in order to occupy the minimal volume in view of its file".

The description was amended accordingly and the patent granted with these amendments.

- 1.2 The amended features (i) and (ii) identified above clearly relate to another inventive concept, namely to take measures that allow the envelope to be formed from the planar state into a container of variable thickness, i.e. a thickness corresponding to the thickness of the block of sheets.

The question arises, therefore, whether or not this new concept was disclosed in the application as filed.

- 1.3 The appellant does not dispute that there is no explicit disclosure of the amended features (i) and

(ii) to be found in the application as filed but argues that there is a clear implicit disclosure.

1.4 The Board cannot, however, follow these arguments, for the following reasons:

First of all, the materials cited in the application as filed by way of example (cardboard, corrugated cardboard or plastic) cannot be clearly and unambiguously regarded as flexible in the sense that a container can be formed out of a flat rectangular sheet without using folding lines. This is particularly true for corrugated cardboard in its usual form, i.e. consisting of a corrugated layer sandwiched between two planar layers, such a material being a rather stiff material.

This is confirmed by the figures: Figure 6 shows a container in its assembled state whereby the sheet is sharply folded along two parallel straight lines which a person skilled in the art would consider as folding lines embossed in the planar rectangular sheet shown in Figure 3. That means that the container can adopt a predetermined volume only which cannot, therefore, be adapted to the volume of the block of sheets to be inserted.

Likewise, a person skilled in the art would consider the dotted lines of Figure 7 as folding lines, because Figure 8 shows the container with sharply folded edges which would not occur with a flexible material without folding lines. Again, it is not recognisable that the volume of the container can be adapted to the volume of the block of sheets.

Thus, there is no implicit disclosure of the amended features (i) and (ii) identified above.

The appellant has argued that the lines referred to above are not mentioned in the description and that therefore a person skilled in the art would not consider them as folding lines but as lines printed on the rectangular planar sheet for facilitating the assembly of the container. However, this argument is not convincing in view of those figures which show the container in its assembled condition, as explained above.

- 1.5 Therefore, the amended features (i) and (ii) identified above added subject-matter to the originally filed patent application which extends beyond the content of the application as filed.

Thus, the main request is not allowable with respect to Article 123(2) EPC.

2. *First auxiliary request*

- 2.1 Claim 1 according to the first auxiliary request differs from claim 1 according to the main request (granted claim 1) in that the term "or other flexible material" is replaced by the term "or other foldable material".

- 2.2 However, claim 1 according to the first auxiliary request still includes the feature (ii) identified above, and is therefore, also not allowable with respect to Article 123(2) EPC.

3. *Second auxiliary request*

3.1 Claim 1 according to the second auxiliary request differs from claim 1 according to the main request (granted claim 1) in that the word "flexible" in lines 6 and 17 of page 3 of the patent specification is replaced by the word "enveloping".

3.2 The word "enveloping" is to be construed as meaning the function of shieldingly surrounding the block of sheet to be stored within the container.

The word "enveloping" does not qualify the material of the enveloping container. Therefore, the replacement of the material qualifying word "flexible" by the material unqualifying word "enveloping" broadens the scope of claim 1 as granted.

Since such a broadening of the granted claim 1 contravenes Article 123(3) EPC, claim 1 according to the second auxiliary request is not allowable either.

4. *Third auxiliary request*

4.1 The third auxiliary request differs from claim 1 according to the second auxiliary request in that the words "in order to occupy the minimal volume in view of its file" are deleted.

4.2 However, claim 1 according to the third auxiliary request still includes the replacement of the word "flexible" by the word "enveloping" with respect to claim 1 as granted.

Therefore, claim 1 according to the third auxiliary request is, for the same reasons as claim 1 according to the second auxiliary request, also not allowable with respect to Article 123(3) EPC.

5. *Conclusion*

None of the requests of the appellant satisfies the requirements of Article 123 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Townend

A. Burkhart