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D E C I S I O N
of 22 March 2000

Case Number: T 0788/98 - 3.2.4

Application Number: 89850321.4

Publication Number: 0371937

IPC: A47B 88/20

Language of the proceedings: EN

Title of invention:

Improvements in or relating to a partition wall

Patentee:

PLASTUNION AB

Opponent:

Perstorp AB

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Extension of subject-matter by generalisation - yes"

Decisions cited:

T 0096/89

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: T 0788/98 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 22 March 2000

Appellant: Perstorp AB
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 July 1998
rejecting the opposition filed against European
patent No. 0 371 937 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: C. A. J. Andries
Members: M. G. Hatherly
R. E. Teschemacher

Summary of Facts and Submissions

- I. The decision of the opposition division to reject the opposition against European patent No. 0 371 937 was posted on 17 July 1998. On 6 August 1998 the appellant (opponent) filed an appeal against this decision and paid the appeal fee. The appellant filed the statement of grounds of appeal on 5 November 1998.
- II. In the appeal proceedings the appellant argued that parts of claim 1 as granted contravened Article 123(2) EPC and that the subject-matter of claim 1 as granted was not inventive over various combinations of three cited prior art documents.

The respondent (proprietor) explained in the appeal proceedings why he considered the appellant's arguments to be wrong.

Both parties attended oral proceedings on 22 March 2000.

Following discussion in the oral proceedings the respondent filed two more sets of claims forming the basis for auxiliary requests 1 and 2.

- III. Claim 1 as granted (the basis for the main request) reads:

"Partition wall of a drawer included in office furniture, said wall (1) can be moved into the drawer (4) and which is removable and optionally fixable in the drawer (4) with the aid of coacting lug means (6,7) projecting out from end parts (2,3) of the wall for

coaction with recesses (8,9) situated in the casing of the drawer (4), of said lug means (6,7) at least one means (6) situated upwards in each end part (2,3) being manually actuatable to and from a locking engagement with recesses (8) in the casing (5) of the drawer (4), and of which at least one lug means (7) downwardly situated in the respective end part (2,3) is adapted for coaction with recesses (9) in the casing (5) at the bottom of the drawer (4), said lug means (6,7) are integrally formed in the end parts (2,3) of the wall (1), whereby at least one of said lug means is situated on a tongue element (10) extending resiliently in the height direction of the wall (1) and a free end part of the tongue element (10) comprises a gripping means (17) for manual actuation of the lug means (6) on the tongue element (10) during attachment and/or removal of the partition wall (1), **characterised in** that the tongue element (10) departs in the height direction of the wall (1) from the bottom section of each end part (2;3) in order to project in an upwards direction, that said tongue element (10) is defined laterally with the aid of two longitudinal slots (15,16) departing from the bottom section of each end part (2;3) in the same said upwards direction."

Claim 1 of auxiliary request 1 and claim 1 of auxiliary request 2 are the same as claim 1 as granted up to and including line 24 of column 3 of the patent specification. Thereafter they read as follows, the only difference between them being that the words in square brackets "and a free end part of" are absent from the auxiliary request 1 but are present in the auxiliary request 2:

"(extend)ing resiliently in the height direction of the wall (1), [and a free end part of] the tongue element (10) comprises means (17) for facilitating its manual actuation during attachment and/or removal of the partition wall (1), **characterised in** that the tongue element (10) departs in the height direction of the wall (1) from the bottom section of each end part (2;3) in order to project in an upward direction, said tongue element (10) is defined laterally with the aid of two longitudinal slots (15,16) that are mutually parallel and extend downwardly along the end wall (11) of the partition wall."

IV. The appellant requested that the decision under appeal be set aside and the patent revoked.

The respondent requested that the appeal be dismissed and the patent maintained as granted (main request). Alternatively he requested that the decision be set aside and that the patent be maintained on the basis of one of the sets of claims submitted during the oral proceedings as auxiliary requests 1 and 2.

Reasons for the Decision

1. The appeal is admissible.
2. *Claim 1 as granted (the main request) - Articles 100(c) and 123(2) EPC*
 - 2.1 Claim 1 as originally filed was amended in various ways during the examination proceedings to arrive at claim 1

as granted. It has to be decided whether the content of the whole of the patent application as originally filed forms an adequate basis for the amendments or whether they extend its content and so contravene Article 123(2) EPC.

2.2 The abstract has no legal effect on the application containing it and therefore cannot be used to justify amendments to the rest of the application.

2.3 The feature of a free end part of the tongue element comprising a gripping means

2.3.1 The originally filed claim 1 states that:

- "at least one lug means (6) is situated on a tongue element (10) departing from the bottom part of each end part (2;3) and extending resiliently in the height direction of the wall (1), such as to enable rapid and simple attachment and/or removal of the partition wall (1)"

whereas claim 1 as granted states that:

- "at least one of said lug means is situated on a tongue element (10) extending resiliently in the height direction of the wall (1) and a free end part of the tongue element (10) comprises a gripping means (17) for manual actuation of the lug means (6) on the tongue element (10) during attachment and/or removal of the partition wall (1)".

2.3.2 The relevant passages in the originally filed

application are the following:

- A. "... the tongue element (10) extends with its free end part in the form of an extension (17) a short distance above the upper end part (12) of the wall (1) for easy access on manual actuation of the lug means (6) during fitting or removing the wall (1)" - see the originally filed dependent claim 2;
- B. "For facilitating manual operation of the element 10, it is provided with an extension 17 a short distance above the upper edge part 12 of the wall 1" - see page 3, lines 19 to 21 of the originally filed description referring to Figure 4; and
- C. "... using both hands side by side while pressing the tongue elements 10 towards each other, e.g. with the aid of the little fingers ... the grip on the extensions 17 of the tongue elements 10 is released as soon as the wall 1 has assumed its proper position in the drawer ... the tongue elements 10 automatically springing backwards to their original position due to the resiliency of the material, i.e. the position the tongue elements 10 had before actuating the extensions with the little fingers ... a later removal is carried out in a similar manner, i.e. the extensions 17 are acted on" - see page 3, line 28 to page 4, line 10 of the originally filed description.

2.3.3 The words "gripping means" in claim 1 as granted are not present in claim 1 as originally filed or anywhere else in the originally filed application. However it is

clear from the above cited passages A and B that the tongue element 10 and therefore the lug means 6 thereon are manually actuated by means of the extension 17.

The functional statement at the end of the originally filed claim 1 "such as to enable rapid and simple attachment and/or removal of the partition wall (1)" concerns the tongue element 10 being resilient so that its lug means 6 can spring into the recess 8. The cited functional statement has nothing to do with the means by which the tongue element is actuated and so cannot be a basis for saying that the tongue element could be actuated other than by means of the extension 17.

Further it is clear from the above cited passages B and C that the tongue elements 10 at each end of the wall 1 are moved inwardly by pressing their extensions 17 inwards e.g. with the aid of the little fingers. Thus the "grip on the extensions 17" referred to in passage C is a grip made up of one little finger pressing inwards on the outer face of one extension 17 and the other little finger pressing inwards on the outer face of the other extension 17. Thus looking at each extension on its own, this extension is pushed and not gripped.

Furthermore the board stresses that the word "grip" is only used in combination with the expression "on the extensions 17" not with an unspecified, general actuated element or means.

Moreover in the originally filed application the term "free end part" is only used as meaning an extension of the tongue element, see the above cited passage A.

Finally, it is clear from the above cited passages A and B (and from Figures 1 and 4) that the extension (i.e. the free end part) extends a short distance above the upper end part of the wall.

- 2.3.4 Thus there is no basis in the originally filed application for the addition of a feature defined by the general wording of "a gripping means (17) for manual actuation of the lug means (6) on the tongue element (10)" which implies that the (single) tongue element is gripped.
- 2.3.5 Secondly, contrary to the disclosure of the originally filed application, this generally worded definition omits to state that the free end part which is acted upon is an extension of the tongue element.
- 2.3.6 Thirdly this generally worded definition encompasses a free end part which lies, and is acted upon, below the level of the upper end part of the wall whereas the application as originally filed only discloses that this free end part (i.e. the extension of the tongue element) lies above the upper end part of the wall.

2.4 The feature of the tongue element being defined laterally with the aid of two longitudinal slots

2.4.1 The originally filed claim 1 specifies:

- "a tongue element (10) departing from the bottom part of each end part (2;3) and extending resiliently in the height direction of the wall (1)"

to which claim 1 as granted adds essentially that:

- "said tongue element (10) is defined laterally with the aid of two longitudinal slots (15,16) departing from the bottom section of each end part (2;3) in the same said upwards direction."

2.4.2 The relevant passages in the originally filed application are the following:

- D. "the tongue element (10) is formed in the end wall (11) of the partition wall (1) and is defined laterally thereon with the aid of two longitudinal slots (15,16) which are mutually parallel and extend from the upper edge part (12) of the wall (1), and downwards along the end wall (11) a distance substantially corresponding to half the height of the partition wall (1)" - see the originally filed dependent claim 3; and
- E. "... the tongue element is integral with the end wall 11 itself, and is defined laterally by two longitudinal slots 15, 16, of which one slot 15 extends somewhat lower down on the end wall 11" - see lines 13 to 16 of page 3 of the originally filed description referring to Figure 4.

2.4.3 Thus the originally filed application when speaking of the tongue element 10 being defined by two longitudinal slots does so only in the context of these longitudinal slots being in the end wall 11. There is therefore no basis in the originally filed application for the two longitudinal slots being anywhere else than in the end wall.

Claim 1 as granted however is not restricted to the longitudinal slots being in the end wall, indeed the end wall is not even mentioned in claim 1 as granted. This claim covers e.g. a partition wall with, at each end, two slots in the **sides** instead of, at each end, two slots in the end wall.

2.4.4 Moreover the general wording of the tongue element being defined laterally with the aid of two longitudinal slots in the granted claim 1 also describes a partition wall whose tongue is defined by two longitudinal slots not extending to the upper edge part 12 of the wall (e.g. with the upper ends of the slots joined by a horizontal slot so that the tongue lies wholly within the end wall). This would be contrary to the originally filed dependent claim 3 (see the above cited passage D) and the only particular embodiment shown in Figure 4. Such a generalised definition, encompassing a location of a tongue wholly within the end wall, has no basis in the originally filed disclosure.

2.5 Claim 1 as originally filed was narrowed in scope during the examination proceedings. However the narrowing was achieved not by taking a group of functionally related features from the originally filed application, but by selecting individual features, taking them out of their originally disclosed context and generalising them, without there being a proper basis in the originally filed application for this. The resulting broadly defined features (see the above sections 2.3.4 to 2.3.6, 2.4.3 and 2.4.4) were not even vaguely envisaged in the originally filed application.

2.6 The respondent argued that the gripping means was included in the preamble of claim 1 as granted and described what the claimed partition wall had in common with the wall known from the closest prior art document DE-C-2 944 683.

While this is indeed the correct procedure when formulating the **preamble** of the independent claim (Rule 29(1)(a) EPC), it cannot justify an extension of the subject-matter of the application or patent beyond that as originally filed. The subject-matter allowed in an application or patent is fixed at the moment that the application is originally filed and cannot be extended on the basis of the disclosure of the closest prior art document. If a feature in an originally filed application needs to be generalised such that the generalisation also defines a feature in the prior art and thus this generalisation can be put in the preamble of the independent claim, then this generalisation must be trimmed back in the characterising portion to the subject-matter originally disclosed. An uncontrolled generalisation would be unallowable (see section 2.3 of T 96/89 cited in Case Law of the Boards of Appeal of the EPO, 3rd edition, 1998, III.B.2).

2.7 Accordingly the generalising amendments dealt with in the above sections 2.3.4 to 2.3.6, 2.4.3 and 2.4.4 contravene Article 123(2) EPC and render claim 1 as granted unallowable.

3. *Claim 1 of the auxiliary request 1 - Article 123(2) EPC*

3.1 This claim adds to the originally filed claim 1 that "the tongue element (10) comprises means (17) for

facilitating its manual actuation".

- 3.2 The passages A to C cited in the above section 2.3.2 make it clear that the tongue element is actuated using the extension 17 which extends above the upper end part of the wall. The only disclosure for this purpose in the originally filed application is this extension with its specified location.

Accordingly the use of the vague term "means" for this purpose in claim 1 of auxiliary request 1 and the lack of information as to its location constitute an unallowable generalisation of the patent application as originally filed.

Moreover the objection made in the above section 2.4.4 against claim 1 as granted concerning the slots not extending to the upper edge part of the wall is not overcome by claim 1 of auxiliary request 1.

- 3.3 Thus claim 1 of auxiliary request 1 contravenes Article 123(2) EPC and is unallowable.

4. *Claim 1 of the auxiliary request 2 - Article 123(2) EPC*

- 4.1 This claim adds to the originally filed claim 1 that "a free end part of the tongue element (10) comprises means (17) for facilitating its manual actuation".

- 4.2 The passages A to C cited in the above section 2.3.2 make it clear that the free end part is an extension 17 which extends above the upper end part of the wall. This is the only disclosure for this purpose in the originally filed application and so the omission from

claim 1 of auxiliary request 2 of the extension with its specified location constitutes an unallowable generalisation of the patent application as originally filed.

Moreover the objection made in the above section 2.4.4 concerning the extent of the slots is not overcome by claim 1 of auxiliary request 2.

4.3 Thus claim 1 of auxiliary request 2 contravenes Article 123(2) EPC and is unallowable.

5. Thus Article 123(2) EPC is contravened by claim 1 of each of the requests and so none of these requests is allowable.

A discussion of inventive step is thus superfluous.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

G. Magouliotis

C. Andries