



File Number T 26/81

DECISION

of the Technical Board of Appeal 3.2.2
of 28 October 1981

Appellant: Imperial Chemical Industries Limited
Imperial Chemical House Millbank
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Grande Bretagne

Representative: Laird, A.H.
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Decision under appeal: Decision of the Examining Division 81
of 16 March 1981 to reject European
Patent Application No. 78 300 221.5
in accordance with Article 97(1) EPC

Composition of the Board:

S.Lewin	Chairman
P.Ford	Member
L.Gotti Porcinari	Member
C.Maus	Member
K.Schügerl	Member

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SUMMARY OF FACTS AND SUBMISSIONS

I. The application was filed on 1 August 1978. The Examining Division refused the application by a decision delivered on 16 March 1981. The decision was based on an amended claim 1 submitted on 11 August 1980, on amended claims 2 to 12, submitted on 17 November 1979, on the amended description submitted on the same date, and on the drawings submitted on 1 August 1978 and amended drawings submitted on 17 November 1979. Claim 1 relates to an open mouth container. The invention claimed is characterised by the geometrical structure of the container.

The independent claim 9 relates to a process for making a container according to claim 1.

The independent claim 11 relates to a core component for use in the process.

II. In its decision, the Examining Division states that the technical problem, as set out in the description, is strictly bound to the production of containers by shaping them around a core component. For such containers, therefore Rule 27(1)(d) EPC, which prescribes that the description shall disclose the invention "in such terms that the technical problem...and its solution can be understood", is satisfied. For containers not produced around a core component for which protection is likewise sought by claim 1 - however no technical problem is stated in or derivable from the description. In respect of such containers, the requirements of Article 84 (support of the claims by the description) and of Rule 27(1)(d) EPC are not met.

III. The questions, whether Rule 27(1)(d) is the implementing regulation to Article 84 and whether the criteria of Article 52 are satisfied, were judged by the Examining Division as being immaterial to the decision.

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IV. On 27 April 1981, the applicants lodged an appeal against the decision. Notice of appeal and the statement of grounds were received in time and the appeal fee was duly paid. The decision is impugned insofar as it related to claims 1-12; it is requested that the application be granted in full on the basis of existing claims 1-12 (Statement of Grounds for Appeal, page 9). Applicants submit amendments to the description (page 1 and 1a) and request that the appeal be conducted on the basis of these amendments.

V. Applicants submit that the description poses two independent problems, namely to devise, first, a stackable container and, second, a simplified moulding technique. The first problem is solved by the conception of a particular geometrical configuration, defined in claim 1, which was judged as being new and inventive in a communication of the Examining Division dated 10 January 1980.

VI. Applicants' further arguments are, in short, the following:

The patentability of the subject-matter of claim 1 does not depend on the specific method of production. The structure of the container is inventive, because it affords the capability of being stacked in a contiguous manner and the capability of being produced by a new technique. Since all the criteria of Article 52 EPC are satisfied, a patent has to be granted.

Claim 1 is not speculative, in view of the fact that it is fully supported by the description, and covers all obvious modifications, for instance containers which are produced by the commonly employed blow-moulding technique. Thus, the application is in accordance with the requirements of Article 84 EPC.

Rule 27(1)(d), which should not be deemed mandatory, is likewise satisfied. Rule 27(1)(d) does not require the explicit statement of a technical problem and the extent of the technical problem does not need to be coterminous with the claimed invention. The first technical problem, which is solved by the conception of such a structure of

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the container, that it is stackable in continuous relationship, is clearly indicated in the description. But even when the first and the second problem are considered as one single problem, the container with the features of claim 1 would be a solution to that problem.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106-108 EPC and with Rule 64 EPC and is, therefore, admissible.
2. The decision is correct in the interpretation of Article 97 EPC, insofar as an application can be refused not only because the claimed subject-matter is lacking in patentability (Article 52 EPC), but also on other grounds, such as violation of the rules governing the content of the description.
3. The basic statement in the decision reads:

"A technical problem concerning containers not produced around a core as also claimed in claim 1 cannot be inferred from the description. So the application does not meet the requirements of Article 84 of the Convention and Rule 27(1)(d) of the Implementing Regulations."
4. Starting with the interpretation of Article 84 EPC, it must be remembered that this article states a requirement in respect of the claims and not of the description. Since most claims are generalisations of examples disclosed in the description, the purpose of this provision must be seen as safe-guarding that the claims do not cover any subject-matter which, after reading the description, still would not be at the disposal of a skilled person. Undoubtedly, there may be cases where the lack of disclosure of a technical problem could lead to the conclusion that the claims lack support by the description. In the present case, however, the problem of stackability has been stated

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also for containers not produced by the claimed method. Furthermore, claim 1 is not speculative since the geometrical structure of the container is clearly determined by claim 1 and fully exposed in the description. Even without additional indications, the skilled person will immediately appreciate that the claimed container may be produced by known methods, e.g. by a blowing process. Therefore, claim 1 must be said to be fully supported by the description. Consequently, no objection can arise under the terms of Article 84 EPC.

5. With regard to the application of Rule 27(1)(d) EPC, it should be first observed that the Board cannot share the opinion of the applicants that this rule is not of a mandatory character. Rule 27(2) EPC allows a "different manner and order" of disclosure from that prescribed in paragraph 1 only when it "because of the nature of the invention" would afford a better understanding and a more economic presentation." This cannot imply any derogation from the essence of the requirement in Rule 27(1)(d) that the invention should be presented in such a way that the technical problem and its solution can be understood.
6. However, as to the technical problem to be solved by the container defined in claim 1, the description deals with the production method as well as the stackability of the containers; see for instance page 1, line 28 ("The object of this invention is to provide a container which can be placed next to a similar container with the bodies of the containers contiguous even when they are lidded...") and a similar indication on page 3, line 29 ("A container according to this invention" etc.).
7. Applicants are therefore right in saying that the application poses a "bipartite" technical problem. It can be no hindrance to patentability that the invention enables one to solve more than one problem, i.e. the provisions of Rule 27(1)(d) should be understood to cover also this possibility. As there is no difficulty in recognizing the problems involved from the description as well as the manner in which they

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have been solved, no objection against the application can be sustained on these grounds.

8. In the case of the solution to multiple problems, the question of unity of invention may arise as a ground for rejection if the application is not being limited in this respect (Article 82 EPC).

However, no objection under this article has been raised by the Examining Division. It is also the opinion of the Board that the claim construction, with an independent claim for the container as such, fully conforms with Rule 30 EPC, which relates to the above Article, since in this case the process claimed in the independent claim 9 is a process specially adapted for the manufacture of the product according to claim 1.

9. The Examining Division has stated that the applicant's argument that in the present case the criteria of Article 52 EPC are satisfied, can be left undecided. In the opinion of the Board this position is not correct. The provisions of Rule 27(1)(d) require that the description shall disclose how the invention can be understood as the solution to a technical problem.

Indeed, the inventive step may be considered as a step from the technical problem to its solution. If, therefore, the requirements of the above rule are neither satisfied by the original description, nor, after request, by an amendment, it will emerge that an invention within the meaning of Article 52 does not exist.

On the other hand, if the subject-matter of an independent claim, for which there is sufficient disclosure, is judged as being inventive in character, it must always be possible to derive a technical problem from the application. If, therefore, as applicants maintain, the Examining Division has in fact accepted that claim 1 defines a patentable

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invention, a conclusion that the conditions of Rule 27(1)(d) have not been or cannot be made to be satisfied, is contradictory. In other words, whether the condition of Rule 27(1)(d) is fulfilled will have to be judged in relation to or as a consequence of the examination of the pertinent claim in respect of novelty and inventive step and this condition cannot be set up as a separate formal criterion independent of inventiveness.

10. It is thus the opinion of the Board that, contrary to what is stated in the decision of the Examining Division, the provisions of Article 84 and Rule 27(1)(d) do not constitute grounds for the rejection of the application.

11. However, a patent on the application cannot be granted without further examination, especially of the invention now claimed in claim 1, for novelty and inventive step.

The statement of the applicants (see page 8 of the Grounds for Appeal) that the Examining Division 81 agrees that the container is novel, involves an inventive step and is susceptible of industrial application, is true only insofar as in the communication of 10 January 1980 it was stated that no objections on these grounds were made. The Division in its complete composition has taken no position on this question. On the contrary, as has already been said, in its decision, the Division expressly states that this issue can be left undecided. Further, the statement in the communication could be interpreted as being conditional upon the limitation of claim 1 to products of the process.

12. It is proper procedure that in regard to the rights of the applicants, the question of patentability, in this case the patentability of the invention claimed in claim 1 of the application, should be treated by the Examining Division as a first instance.

For the reasons explained by the applicant in his application and accepted by the Examining Division, the Board finds claims 9-12 of the application to be allowable.

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13. In its further examination, the Examining Division should especially consider whether claim 1, i.e. the claim for the product, has the required inventive step considering the fact that as an independent claim it does not rely on the features included only in the process claim.

The arguments for inventiveness of claim 1 put forward by applicants in their Grounds for Appeal, as well as the amendments submitted with the appeal should be examined by the Examining Division in the above context.

14. No application has been made for reimbursement of the appeal fee in accordance with Rule 67 EPC, and it is not considered that the circumstances of the case would have justified such an order.

For these reasons,

it is decided that:

The Decision of Examining Division 81 dated 16 March 1981 is set aside. The application is remitted to the Examining Division for continued examination.

The Registrar:

The Chairman:

J. Bergeron

Saul Lewin