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D E C I S I O N
of 15 January 2001

Case Number: T 1039/00 - 3.2.4

Application Number: 96900622.0

Publication Number: 0805644

IPC: A47L 9/00

Language of the proceedings: EN

Title of invention:
A device for cleaning

Applicant:
INCREA OY

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 113(1)

Keyword:
"Basis of decisions - opportunity to comment (no)"

Decisions cited:
J 0007/82, T 0951/92

Catchword:



Case Number: T 1039/00 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 15 January 2001

Appellant: INCREA OY
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 15 June 2000
refusing European patent application
No. 96 900 622.0 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. A. J. Andries
Members: T. Kriner
H. Preglau

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal on 9 August 2000, against the decision of the Examining Division of 15 June 2000, refusing the European patent application No. 96 900 622.0. The fee for the appeal was paid simultaneously and the statement of grounds was received together with the notice of appeal.

II. The Examining Division held that the application did not meet the requirements of Article 52(1) EPC in connection with Article 56 EPC, in particular because the claimed subject-matter did not involve an inventive step with regard to the disclosure of document

D2: US-A-4 751 759.

Although in section II.2 of the decision under appeal, which deals with the independent claim, also document D1 has been mentioned twice, it is clear that document D2 was intended.

III. The appellant requested that the decision under appeal be reversed and the application be allowed to pass for granting of a European patent.

IV. Independent claim 1 which formed the basis for the impugned decision reads as follows:

"A device for cleaning with a flow of air which is to be sucked by the device, such as a vacuum cleaner, including a central unit, a nozzle (N), a suction tubing (T) of the central unit, the suction tubing (T) being joined to the nozzle (N) during operation, ionization device (IG, IP) for ionizing at least part

of the flow of air for cleaning and an air intake aperture of the nozzle for allowing intake of the flow of air into the nozzle, the intake flow of air through the air intake aperture being generated by suction through said suction tubing (T), characterized in that said ionization device has an ionization electrode (IP) placed in the said intake flow of air at a location before the intake flow of air is able to become contacted with the surface to be cleaned."

- V. In support of its requests, the appellant relied on the following submissions.

In its last communication dated 14 July 1999 the Examining Division stated that the subject-matter of claim 1 filed with letter of 30 June 1999 lacked novelty with respect to each of D2 and D4 (EP-A-0 279 109). However, in its decision the Examining Division held that the subject-matter of claim 1 filed with letter of 14 January 2000 did not involve an inventive step with respect to D2, although the Examining Division indicated that the subject-matter of this claim corresponded in substance to that of claim 1 filed with letter of 30 June 1999. Therefore, the ground for the rejection was set forth for the first time in the decision without giving the appellant an opportunity to traverse this ground.

When starting from D2, the provision of the claimed subject-matter was not obvious for the skilled person. In order to modify the device of D2 so that it corresponded to the claimed device, it was necessary to eliminate the blowing hose (16) and to widen the narrow blowing slot (2) shown in D2. This was a requirement to enable intake of air through the duct (9). Since such

modifications would be contrary to the purpose of the device according to D2, in particular to the object to create a high velocity laminar jet of air for vigorously sweeping over the surface to be cleaned, they were clearly outside any consideration of a skilled person.

Reasons for the Decision

1. The appeal is admissible.
2. *Procedural violation*
 - 2.1 Under Article 113(1) EPC the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. This important procedural right is intended to ensure that no party affected by a decision is caught unaware by reasons on which it did not have an opportunity to comment (see T 951/92, OJ EPO 1996, 53).
 - 2.2 In the present case the Examining Division informed the appellant in its communication dated 14 July 1999 that claim 1 filed with letter of 30 June 1999 did not meet the requirements of Articles 84 and 123(2) EPC (see sections 1.1 and 1.2 of the communication). Furthermore, the Examining Division stated in this communication that the subject-matter of claim 1, the extended subject-matter objection apart, lacked novelty with respect to the disclosure of each of D2 and D4 (see section 1.3 of the communication).

With its letter of 14 January 2000, the appellant filed a new claim 1 which had been amended to overcome the

deficiencies mentioned by the Examining Division.

Compared to the preceding claim 1 filed with the letter of 30 June 1999, this claim comprised the following new features:

- the suction tubing belongs to the central unit;
- the suction tubing is joined to the nozzle (N) during operation;
- the nozzle comprises an intake air aperture for allowing intake of the flow of air into the nozzle;
- the intake flow of air through the air intake aperture is generated by suction through the suction tubing;
- the ionization device has an ionization electrode (IP) placed in the intake flow of air.

Furthermore, the following features of the preceding claim 1 had been deleted:

- the suction tubing is arranged between the central unit and the nozzle;
- at least part of the flow of air is to be sucked through the range of direct ionization influence of said ionization device.

With respect to the question of novelty, the appellant emphasized that the ionizing means shown in D2 and D4 were not placed in such an intake flow of air which was generated by suction, rather in a pressurized flow so that the subject-matter of the new claim 1 was not

disclosed by these documents.

In its decision of 15 June 2000, the Examining Division acknowledged that the subject-matter of the new claim 1 is novel. However, the Examining Division rejected the application on the ground that the subject-matter of claim 1 did not involve an inventive step.

With respect to the amended claim 1, the Examining Division stated:

"Since the subject-matter of the subsisting statement of claim corresponds in substance to that filed with the letter dated 30.06.99, apart from the amendments for compliance with the provisions of Articles 123(2) and 84 EPC, the applicant was given the stipulated opportunity to present his comments and the provisions of Article 113(1) EPC are, therefore, met" (see page 2, section II.1: "Basis of the decision").

- 2.3 Having regard to the findings that the subject-matter of claim 1 filed with the letter of 30 June 1999 lacks novelty over D2 and that the subject-matter of claim 1 filed with the letter of 14 January 2000 differs from the device disclosed in D2 by the feature according to which the intake flow of air through the air intake aperture is generated by suction through the suction tubing (see section 2.2 of the decision), the Examining Division obviously recognized that claim 1 had been amended to such an extent that the objection of lack of novelty could not be maintained.

Consequently, the Examining Division based its decision on the ground of lack of inventive step, a new ground which had never been raised before with respect to the

filed independent claims 1, and on which the appellant therefore did not have an opportunity to present its comments.

Furthermore, the last filed claim 1 also was not a combination of claim 1 with one of the dependent claims, which were considered in the communications as not involving an inventive step, so that even indirectly it could not be upheld that inventive step had been raised.

- 2.4 The decision under appeal, therefore, contravenes the requirements of Article 113(1) EPC.

This amounts to a substantial procedural violation and requires the reimbursement of the appeal fee pursuant to Rule 67 EPC, although reimbursement was not requested by the appellant (see J 7/82, OJ EPO 182, 391).

3. *Procedural matter*

- 3.1 The appellant's argumentation concerning inventive step which has been filed with the notice of appeal has not yet been considered by the first instance. With respect to the substantial procedural violation and in accordance with Article 10 RPBA, it is therefore appropriate to remit the case to the first instance for further prosecution.
- 3.2 With the further prosecution of the examining proceedings, the Examining Division will have to consider amongst others the appellant's remarks concerning D2 filed with letter of 8 August 2000.

With respect to these remarks, the Board likes to emphasize that the appellant's argumentation according to

which the skilled person would not modify the device disclosed in D2 in such a way that it corresponds to the subject-matter of claim 1, is convincing.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

G. Magouliotis

C. A. J. Andries