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D E C I S I O N
of 28 January 2003

Case Number: T 1203/02 - 3.2.4

Application Number: 98940109.6

Publication Number: 0994660

IPC: A44B 11/00

Language of the proceedings: EN

Title of invention:
Adjustable quick-release buckle, particularly for diving masks of similar

Applicant:
Tecnorubber S.R.L.

Opponent:
-

Headword:
Opportunity to comment/TECNORUBBER S.R.L.

Relevant legal provisions:
EPC Art. 96(2), 109, 113(1), 123(2)
EPC R. 51(2)(3), 67

Keyword:
"Amendment to claims of application"
"Invitation to file new claims which do not infringe Article 123(2) EPC"
"Lack of essential reasoning in communication"
"Substantial procedural violation"
"Reimbursement of appeal fee"

Decisions cited:
T 0951/92

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1203/02 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 28 January 2003

Appellant: Tecnorubber S.R.L.
Via Dante Alighieri, 9/1
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 9 August 2002 refusing European patent application No. 98 940 109.6 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: C. A. J. Andries
Members: M. K. S. Aúz Castro
C. D. A. Scheibling

Summary of Facts and Submissions

I. European patent application 98 940 109.6 was filed as International application PCT/EP98/04071 on 1 July 1998 by 3 applicants claiming the priority of IT application SV97A000037 of 11 July 1997.

II. The International Preliminary Examination Report (IPER) issued on 24 November 1999 stated under its point V that the subject-matter of claim 1 - as far as it was understandable in view of the clarity objection enumerated under point VIII - met the requirements of Article 33 PCT.

Under point VIII 2(ii) the applicants were requested to indicate a basis in the application as originally filed for the feature "means for manually displacing the ratchet-like means..." introduced into claim 1 pursuant to Article 34(2)(b) PCT.

III. By letter of 25 January 2000 the applicants entered the regional phase before the EPO without having further amended the set of claims.

IV. On 23 January 2002 a communication of the examining division was sent to the applicants which, after citing the application documents on which the examination was being carried out, set out the following:

"1. An international preliminary examination report (IPER) has already been drawn up for the present application in accordance with the PCT. The deficiencies mentioned in the IPER give rise to objections under the corresponding provisions of the EPC.

2. The applicant is requested to file new claims which take account of the objections raised in the IPER."

V. On 6 May 2002 the applicants filed a main and two auxiliary requests.

Claim 1 of the main request reads as follows:

"A combination of an adjustable quick-release buckle and a strap (1) which has a set of equally spaced teeth (101), or similar, arranged on at least one end portion of said strap (1), particularly for masks or similar, which combination comprises:
a) a buckle body (2);
b) a return roller (4) rotatably mounted on the buckle body (2) and around which passes the strap (1);
c) ratched-like strap retaining means mounted in a displaceable way on the buckle body (2) and urged by elastic means in the direction of an active position, in which said ratched-like means prevent the strap (1) to slide in the loosening direction and allows it to slide in the opposite tightening direction,
d) means for manually displacing the ratched-like means against the action of the elastic means in an inactive position, in which said ratched-like means allow the strap (1) to slide freely in both the loosening and tightening directions; characterized in that
e) the buckle body (2) has an arched wall (102), which extends coaxial to the roller (4) through a certain angular width, the distance between the arched wall (102) and the roller (4) substantially corresponding to or being slightly greater than the thickness of the strap (1), but smaller than the total thickness of the strap (1) including the projection of the teeth (101)

of the strap;
f) the return roller (4) has longitudinal external teeth (204) and the strap (1) is passed between the roller (4) and the arched wail (102) of the buckle body (2) so as to engage the teeth (101) of the strap (1) between the teeth (204) of the roller (4);
g) the return roller (4) is rotatably mounted on a central pin (5), which bears at one of its ends (105) at least one axial locking tooth (305),which tooth (305) cooperates with a crown of axial teeth (204) on the facing end side of the roller (4), which teeth (204) have a guide slanted side facing the strap tightening direction of rotation, and substantially axial steep front on the side facing the strap loosening direction of rotation, whereas the pin (5) is mounted in such a way as to be unable to rotate but to be able to slide axially to move the locking tooth (305) from the crown of axial teeth (204) on the facing end side of the roller (4), while opposing the action of elastic means (205) which stably push said pin (5) towards engagement of the locking tooth (305) with the teeth (204) of the end side of the roller (4), said pin (5) projecting out of a transverse wall (202) of the buckle with a button-like head".

Claim 1 of the main request differs from that upon which the IPER was based in that in paragraph (c) the reference numerals "(4,5)" for the feature "ratched-like strap retaining means" are deleted.

Claim 1 of the first auxiliary request differs from that of the main request in that said feature "ratched-like strap retaining means" of paragraph (c) is provided with the reference numerals "(204,305,205)".

Claim 1 of the second auxiliary request differs from that of the first auxiliary request in that the wording of the first line of paragraph (g) is amended from "the return roller (4) is rotatably mounted to "the return roller (4) is associated to the ratched-like means being rotatably mounted".

The applicants explained their opinion that the examiner had found claim 1 to lack clarity because in the preamble of claim 1, line 7 reference number (4) denoted a return roller whereas in line 9 this reference number was used for "ratched-like strap retaining means". They proposed these 3 versions of claim 1 because, according to them, there was no acceptable way for defining the common features of the nearest prior art.

Furthermore, the applicants indicated several references in the original application as basis for the amended features.

VI. By decision of 9 August 2002 the patent application was refused for not complying with Article 123(2) EPC.

The examining division found that is was apparent from the application as filed that the ratchet-like means referred to in paragraph (c) of claim 1 - i.e. teeth 305 located at an end of central pin 5 and teeth 204 located on the facing end side of roller 4 - moved from an active to an inactive position when pin 5 was axially displaced against the action of elastic means 205, so disengaging teeth 305 from teeth 204. It was further apparent that the aforementioned displacement was effected by pressure exerted on the head of said pin 5 by a forefinger or thumb.

However, the newly introduced wording of paragraph (d) implied the presence of an **additional** technical feature which served to effect said axial displacement of the pin 5. The references in the application as filed cited in this respect by the applicants merely confirmed that displacement of the ratchet-like means against the action of the elastic means was effected by means of pressure exerted on the head of pin 5 by a forefinger or thumb.

VII. Against this decision applicant 1 - appellant in the following - filed an appeal on 4 October 2002. On the same day the statement setting out the grounds of appeal was filed. The appeal fee was paid on 26 September 2002.

The appellant alleges that claim 1 of the patent application as amended was misinterpreted by the examining division and that there was no violation of Article 123(2) EPC.

Furthermore, the appellant alleges a substantial procedural violation because the communication of the examining division had failed to indicate precisely the objections to clarity, so that the appellant would know the interpretation of amended claim 1 by the examination division and could react accordingly.

VIII. The appellant requested that the decision under appeal be set aside and that claim 1 according to one of the main or auxiliary requests be declared allowable or that the case be remitted to the first instance for further prosecution, furthermore, reimbursement of the appeal fee and auxiliarily oral proceedings.

Reasons for the Decision

1. *Admissibility of the appeal*

The appeal complies with the provisions enumerated in Rule 65(1) EPC and is therefore admissible.

2. *Basis of the impugned decision - Article 113(1) EPC*

2.1 Pursuant to Article 113(1) EPC the decision of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

The purpose of this provision is to ensure that no party is caught unaware by the reasons given in a decision on which he had no opportunity to comment.

The term "ground" does not refer merely to a ground of objection to the application in the narrow sense of a requirement of the EPC - in the case under consideration Article 123(2) EPC - which is considered not to be met. The term has rather to be interpreted as referring to the essential reasoning, both legal and factual, which leads to the refusal of the application. In other words, before a decision is issued an applicant must be informed of the case which he has to meet, and must have an opportunity of meeting it (T 951/92, OJ EPO 1996, 53, point 3; see further decisions in Case Law of the Boards of Appeal of the EPO, 4th edition 2001, VI.B, page 261 ff).

2.2 In the present case this was exactly what the examining division failed to do. In their communication the examining division did not even cite the ground of

objection in the narrow sense i.e. the corresponding article of the EPC, but simply referred to "the corresponding provisions of the EPC" and invited the applicants to file new claims without informing them about their legal and factual reasoning, why the newly introduced features contravened Article 123(2) EPC.

2.3 By that the applicants were at a loss what the examining division's essential objections were. Nevertheless, they tried to figure it out and complied with the communication by filing new claims and by indicating several references in the original application as a basis for the amended features.

2.4 At least when receiving the answer to their communication and realising that the applicants' line of reasoning was completely different from their's the examining division should have pursuant to Article 96(2) EPC and Rule 51(2) and (3) EPC provided the applicants with a reasoned statement explaining in detail their objections to the grant of the patent before surprising them with a negative decision they could not anticipate.

2.5 By reserving their reasoning for the decision of refusal the examining division has not only failed to comply with Article 96 EPC and Rule 51 EPC to explain right from the start of the examining procedure in detail their objections to the introduction of the new feature. But they have also contravened Article 113(1) EPC by basing their decision on grounds on which the applicants had no opportunity to present their comments.

2.6 This form of conducting the proceedings constitutes a

substantial procedural violation which alone for these reasons leads to the setting aside of the impugned decision.

3. *Reimbursement of the appeal fee*

Pursuant to Rule 67 EPC, first sentence the reimbursement of the appeal fee shall be ordered where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

In the present case, all three requirements are fulfilled: the appeal is allowable, a substantial procedural violation has occurred and because of this substantial procedural violation the appellant had to file an appeal, so that the reimbursement is equitable.

4. *Interlocutory revision*

The Board takes the opportunity of reminding the examining division of the instrument of interlocutory revision pursuant to Article 109 EPC.

For this case it would have been appropriate to apply interlocutory revision alone in view of the substantial procedural violation which at least when receiving the grounds of appeal should have become obvious to the examining division.

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. The reimbursement of the appeal fee is ordered.

The Registrar: The Chairman:

G. Magouliotis C. Andries