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D E C I S I O N
of 13 July 2005

Case Number: T 0060/03 - 3.2.3

Application Number: 95919557.9

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IPC:

Language of the proceedings: EN

Title of invention:
Mobile screening apparatus

Patentee:
Douglas, Patrick J.

Opponents:
I. Powerscreen International Distribution Ltd.
II. Metso Minerals Industries, Inc.

Headword:
-

Relevant legal provisions:
EPC Art. 100(c), 123(2)

Keyword:
"Amendments - added subject-matter (no) "

Decisions cited:
-

Catchword:
-



Case Number: T 0060/03 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 13 July 2005

Appellant: Douglas, Patrick J.
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Respondent I: Powerscreen International Distribution Ltd.
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Respondent: Metso Minerals Industries, Inc.
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Representative: Price, Nigel John King
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 7 November 2002
revoking European patent No. 0721383 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: U. Krause
Members: G. Ashley
J. P. B. Seitz

Summary of Facts and Submissions

I. The appellant (patentee) filed international patent application PCT/GB95/01189 (WO-A-9603225), which after entering the regional phase before the EPO, was granted as European Patent No. 0 721 383. The grant was opposed by respondent I (opponent I) and respondent II (opponent II), and all the grounds contained in Article 100 EPC were cited. The opposition division concluded that the subject-matter of claim 1 according to the main and auxiliary requests of the appellant extends beyond the content of the application as originally filed (Article 100(c) EPC), and according to the decision dispatched on 7 November 2002, revoked the patent on this basis without dealing with any other ground of opposition relied upon by the opponents.

Notice of appeal, together with the appeal fee, was filed by the patentee on 7 January 2003. A statement of the grounds of appeal, together with a retyped claim 1 as a main request, was filed on 7 March 2003. Oral proceedings were held on 13 July 2005, during which the appellant submitted an auxiliary request for maintenance of the patent on the basis of the claims filed as the third auxiliary request before the opposition division.

II. Claim 1 of the main request reads as follows:

"1. A self-propelled screening apparatus (10) which comprises:
a support frame (11) having a longitudinal axis and a pair of opposed sides;

power-driven moving means (15) supporting said frame (11) and operable to move the apparatus over the ground, the moving means comprising endless tracks (15); a screening device (12) located above said moving means; a hopper (13) mounted above the screening device (12) and arranged to receive a supply of bulk material and to discharge the material to said screen so that the latter can separate the bulk material into screened portions comprising a portion which is too large to pass through the screen and a portion which passes through the screen; the hopper (13) and the screening device (12) being located directly above the endless tracks (15); and, a discharge conveyor (14) mounted on said support frame (11) and being arranged to project from the screening device (12) in a direction longitudinally of the support frame (11), the discharge conveyor having a receiving end which is arranged to receive material which has passed through the screen and being operable to discharge such material via its discharge end (14a); the discharge conveyor being operable to discharge at least one separated portion of screened material while the apparatus is stationary as well as along a required deposition zone while the apparatus is being moved by said means;

characterised in that:

the screen is arranged to discharge the material which is too large to pass through the screen directly onto the ground adjacent one of the sides of the support frame."

III. The opposition division held that the characterising feature of claim 1 is not disclosed in the application as originally filed, which in this case is the PCT application mentioned in paragraph I above. The opposition division argued that the requirement that the material is discharged directly onto the ground has two meanings. Firstly, no further treatment of the material is foreseen between the screen and the ground, and secondly, the material is discharged by the shortest distance between the screen and the ground. The opposition division concurred with the submissions of the respondents that the latter meaning is not derivable from the original PCT application, and consequently upheld the objection under Article 100(c) EPC.

IV. The appellant argued that support for the amendment can be found by considering the entirety of the original application, and in particular, the following:

(a) Page 3:

"The screen(s) preferably is arranged to extend generally perpendicular to the longitudinal axis of the apparatus (and of the endless track) so that the material which is too large to be screened i.e. which does not pass through the screens, can be discharged to one side of the apparatus, and therefore will not obstruct the movement of the apparatus and of its endless tracks."

(b) The specific embodiment described in Figs. 2 and 4 in combination with the paragraph bridging pages 4 and 5 of the description:

"...the screen(s) 12 extends generally perpendicular to the longitudinal axis of the apparatus (and of the endless tracks) and therefore oversize material which does not pass through the screens can be discharged laterally of the endless tracks and therefore will not obstruct the movement of the apparatus."

The appellant emphasized that in defining a feature in the claim, there is no requirement to use the exact wording of the description. It is clear that the tracks of the vehicle rest on the ground, and neither the figures nor the description indicate that there is anything between the screen and the ground. Thus, when material is discharged laterally of the vehicle, it must hit the ground. Further, since the claim is directed to an apparatus, it is immaterial what happens to the material once it has left the screen, so long as the screen is arranged so that the defined result can be achieved.

- V. The respondents argued essentially that nowhere in the original application, and in particular in the above passages cited by the appellant, is it directly and unambiguously disclosed that the material is discharged directly onto the ground. Some of the stones falling from screen 12, as shown in figure 2 of the application, would inevitably hit tracks 15, and in the arrangement shown in figure 6, it is clear that the stones would land on the base frame 20 of the vehicle. In addition, the material must not necessarily be discharged onto the ground, but can be directed into, for example, a separate chute, conveyor or truck.

VI. Requests

The appellant requested that the decision under appeal be set aside and the patent maintained according to either the main request filed on 7 March 2003 together with the statement of the grounds of appeal, or the auxiliary request presented during the oral proceedings (corresponding to the third auxiliary request filed before the opposition division).

The respondents requested that the appeal be dismissed; they further requested that the case be remitted to the department of first instance for further prosecution in the event that the decision under appeal were to be set aside.

Reasons for the Decision

1. The appeal is admissible.

Article 100(c)

2. Article 100(c) is directed to the extension of the subject-matter of a patent beyond the content of the application as filed, as set out in Article 123(2) EPC. The question facing the Board is thus whether the amended feature, which forms the characterising portion of claim 1, introduces new subject-matter not originally disclosed in the PCT application.

As pointed out by respondent II, the test to determine whether new matter has been added is strict, and is

defined by the case law, set out in the EPO Guidelines C-VI 5.3.1:

"An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art".

It is true that nowhere in the application is it explicitly stated that the material is discharged directly onto the ground. The passages cited by the appellant (see above) merely state that the screen is arranged so that the material is discharged laterally of the tracks or to one side of the apparatus, so as not to obstruct the movement of the apparatus and its tracks. However, the Board considers it important to consider what the skilled person would in practice derive from the disclosure in the application.

The skilled person is told that the arrangement of the screen should be that the oversized material is discharged from the screen to the side of the vehicle, so as not to impede its movement. Figure 2 shows an end elevation of the vehicle, with the screen 12 in an inclined position and tracks 15; although it is not depicted, the tracks must be in contact with the ground. No conveyor belt, truck or chute for collecting the discharged oversized material is either depicted in the figure 2 or mentioned in the application, so would not

occur to the skilled person. In the Board's view, the skilled person looking at figure 2 and interpreting it in light of the above cited passages would most readily understand it to mean that the oversized material falls from the side of the screen to the ground, alongside and out of the way of the tracks.

The respondents have argued that, because some stones may hit the tracks, the vehicle frame, or be collected by a conveyor belt, container or a truck, the feature of material being discharged directly onto the ground is only one of several possibilities, none of which are disclosed in the application. Respondent II applied the novelty test referred to in the Guidelines, Part C-VI, 5.3.1, concluding that the disputed feature is novel when compared with all the possibilities facing the skilled person, and hence does not comply with Article 123(2) EPC.

The Board is of the view that it matters not that the material could, after leaving the screen, follow a different route from that defined in the claim; the question is still whether discharge of the material directly onto the ground is directly and unambiguously disclosed to the skilled person reading the application as a whole, rather than considering figure 2 on its own. Whereas the "novelty test" may assist in determining the allowability of an amendment, it cannot override the basic criteria. Furthermore, the disputed feature cannot establish novelty over the original application, because it corresponds exactly to the way a skilled reader would interpret figure 2 in light of the relevant passages in the text (as set out above). The Board agrees that the embodiment shown in figure 6

would result in material falling on the vehicle frame and not directly on the ground, as required by claim 1. An embodiment falling outside the scope of the claim is, however, not a matter relevant for Article 123(2) EPC. Whereas it may be true that there are several ways for dealing with the oversize material that is discharged from the screen, the one that leaps from the cited passages and figure 2 is that the material simply falls to the ground alongside the vehicle. Since it is this that is immediately apparent to the skilled person, it can be said that the feature is directly and unambiguously derivable from the application.

The appellant argued that, since the claim is directed to an apparatus, it is immaterial what happens to the material once it has left the screen, so long as the screen is arranged so that the defined result can be achieved. The Board is of the view that whilst the appellant's approach might be relevant when construing a claim for purposes of novelty or inventive step, for the purpose of Article 123(2) EPC, a feature, irrespective of its nature, must nevertheless be directly and unambiguously derivable from the original application.

3. The Board therefore concludes that claim 1 of the main request does not contain added subject-matter; it is not necessary to deal with the auxiliary request. The case will, however, have to be remitted to the opposition division for consideration of the other grounds cited by the respondents.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

A. Counillon

U. Krause