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D E C I S I O N
of 1 December 2003

Case Number: T 0607/03 - 3.2.4

Application Number: 97107888.6

Publication Number: 0811767

IPC: F04C 29/02

Language of the proceedings: EN

Title of invention:

Gear oil pump for hermetic compressor

Applicant:

MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.

Opponent:

-

Headword:

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Relevant legal provisions:

EPC Art. 82, 84, 111(1), 113(1)

EPC R. 29(2), 30(1), 67

Keyword:

"Basis of the decision - opportunity to comment (no)"

"Remittal to the first instance"

Decisions cited:

T 0808/94, T 0187/95

Catchword:

-



Case Number: T 0607/03 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 1 December 2003

Appellant: MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.
1006, Oaza Kadoma
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Osaka 571-8501 (JP)

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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 11 December 2002
refusing European application No. 97107888.6
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. A. J. Andries
Members: T. Kriner
M. K. S. Aúz Castro

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal on 7 February 2003, against the decision of the Examining Division, posted on 11 December 2002, refusing the European patent application No. 97 107 888.6. The fee for the appeal was paid on 10 February 2003 and the statement setting out the grounds of appeal was received on 8 April 2003.
- II. The Examining Division held that the application did not meet the requirements of Article 82 EPC, and of Article 84 EPC in conjunction with Rule 29(2) EPC, since the independent claims 1 and 4 filed on 14 October 2002 referred to two different inventions or groups and inventions, and solved two different problems.
- III. The appellant requests that
- the appealed decision be set aside,
 - a patent be granted on the basis either of claims 1 to 13 according to the main request, or claims 1 to 12 according the auxiliary request, both requests filed with the letter of 8 April 2003, and
 - the appeal fee be reimbursed according to Rule 67 EPC.
- IV. The independent claims 1 and 4 of the main request read as follows:

"1. A gear pump (50) for use in an electrically-operated sealed compressor including a compression mechanism, an electric motor (7) for driving the compression mechanism, and a crankshaft (2) for transmitting a rotational force of the electric motor (7) to the compression mechanism, said gear pump (50) comprising:
a first gear (52a) connected to an end of the crankshaft (2) and
a second gear (52b) in mesh with the first gear characterised by
a strainer (57) for capturing foreign substances contained in oil which is introduced to the first and the second gear (52a; 52b) and
a pump cover (54) for covering the strainer (57), the pump cover (54) having a shoulder portion in which the strainer (57) is received, the strainer (57) having a height greater than that of the shoulder portion so that the strainer (57) protrudes from one end surface of the pump cover (54)."

"4. A gear pump (50) for use in an electrically-operated sealed compressor including a compression mechanism, an electric motor (7) for driving the compression mechanism, and a crankshaft (2) for transmitting a rotational force of the electric motor (7) to the compression mechanism, said gear pump (50) comprising:
a first gear (52a) connected to an end of the crankshaft (2) and
a second gear (52b) in mesh with the first gear (52a) characterised by
a cover plate (53) for covering the first gear (52a) and the second gear (52b);

a pump cover (54) mounted on the cover plate (53) and an oil suction nozzle (56) secured to the pump cover (54) such that the cover plate (53) is interposed between the oil suction nozzle (56) and the first and the second gear (52a; 52b)."

The auxiliary request comprises only a single independent claim (claim 1). The wording of this claim corresponds to the wording of claim 4 of the main request, with the exception that some reference signs in claim 4 of the main request are missing from this claim.

V. In support of his requests, the appellant relied essentially on the following submissions:

Claims 1 and 4 of the main request differed from claims 1 and 4 underlying the appealed decision only by the addition of reference signs. Each of the gear pumps defined in these claims comprised among other things a pump cover. Since the most relevant state of the art as disclosed in D1 (JP-A-02 030 998, patent abstract in English) did not comprise such an element, the pump cover had to be regarded as a special technical feature. Therefore, according to Rule 30(1) EPC, the inventions defined in claims 1 and 4 of the main request related to a group of inventions so linked as to form a single general inventive concept, as required by Article 82 EPC.

The object underlying both independent claims 1 and 4 of the main request could be regarded as being to improve the durability of a gear pump and at the same time to allow an easy and effective installation and

maintenance of the parts of the gear pump. Therefore, claims 1 and 4 were directed to two alternative solutions of a particular problem. Since it was not appropriate to cover these alternatives by a single claim, the provision of two independent claims was allowable with respect to Rule 29(2)(c) EPC.

In response to the objections of lack of unity and lack of conciseness raised in the examining division's communication dated 20 June 2002, new claims 1 to 13 had been filed. While the previous set of claims contained eight independent claims, the new set of claims contained only two independent claims, wherein the first independent claim (claim 1) corresponded to the previous claim 1 and the second independent claim was a new independent claim. Although substantial amendments had been made to the claims, the examining division did not inform the appellant why the new claims lacked unity and contravened Article 84 EPC in conjunction with Rule 29(2) EPC, before issuing the decision to refuse the application on these grounds. Since the appellant had not had any chance to present comments on the examining division's reasoning with respect to the new claims, the requirements of Article 113(1) EPC were not met. Hence the examining division committed a substantial procedural violation which justified the reimbursement of the appeal fee.

Reasons for the decision

1. The appeal is admissible

2. *Basis of the decision*

2.1 According to Article 113(1) EPC the decisions 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. With respect to the established case law of the boards of appeal, the term "grounds or evidence" under this Article has to be understood as meaning the essential legal and factual reasoning on which the EPO based its decision (see for example T 187/95).

2.2 In the present case the examining division informed the appellant with its communication of 20 June 2002 that on the basis of claims 1 to 13 filed with the letter of 3 June 2002, the application among other things lacked unity within the meaning of Article 82 EPC and that it did not meet the requirements of Article 84 EPC in combination with Rule 29(2) EPC.

With respect to the unity objection, the examining division pointed out that the eight independent claims on file referred to four separate inventions or groups of inventions which were not so linked as to form a single general inventive concept. The examining division stated that in the light of the special technical features representing the contribution over the prior art disclosed in D1, four different problems had to be solved by the subject-matter of the independent claims. Independent claim 1 served to solve a first problem, independent claims 2, 8, 11 to 13 a second problem, independent claim 6 a third problem, and independent claim 10 a fourth problem. However, no reasoning was given why the examining division

considered these problems as the ones underlying the four groups of inventions.

With respect to the conciseness objection, the examining division informed the appellant that under Article 84 EPC in combination with Rule 29(2) EPC an application could contain more than one independent claim in a particular category only if the subject-matter claimed fell within one or more of the exceptional situations set out in paragraphs (a), (b) or (c) of Rule 29(2) EPC. Since the examining division was of the opinion that this was not the case in the present application, the appellant was requested to file an amended set of claims which complied with Rule 29(2) EPC.

- 2.3 In response to the examining division's communication of 20 June 2002, the appellant filed with the letter of 15 (and not 14 as indicated by the examining division) October 2002 a set of new claims 1 to 13 which comprised only two independent claims (claims 1 and 4). The new claim 1 corresponded to the previous claim 1, and claim 4 was based on the previous independent claim 2 with some of the features omitted.

Furthermore, the appellant pointed out that the provision of a gear pump comprising a pump cover constituted a common inventive concept, and that the application contained two new independent claims as alternative solutions to a particular problem, i.e. to provide a reliable oil pump which at the same time provided a high flexibility, adaptability and ease of manufacture. Therefore the set of new claims fulfilled the requirements of unity within the meaning of

Article 82 EPC, and, in accordance with Rule 29(2)(c) EPC, could comprise two independent claims.

- 2.4 With the decision of 11 December 2002 the examining division refused the application on the ground that it did not meet the requirements of Articles 82 EPC, and 84 EPC in combination with Rule 29(2) EPC, without any further previous communication to the appellant.

The examining division held that a reasoning corresponding to both objections had already been drawn to the attention of the appellant by means of the communication dated 20 June 2002, such that the appellant could not have been caught by surprise by the decision. Therefore the requirements of Article 113(1) EPC would have been fulfilled.

- 2.5 The board does not agree with this conclusion. In its communication of 20 June 2002 the examining division merely informed the appellant that the claims filed with letter of 3 June 2002 did not meet the requirements of Article 82 EPC, and Article 84 in conjunction with Rule 29(2) EPC. However, the appellant was never informed before the decision to refuse the application that also the claims filed with the letter of 15 October 2002 did not meet these requirements.

In order to overcome the objections of the examining division with respect to the claims filed with letter of 3 June 2002, the appellant filed a new set of claims with only two independent claims instead of eight independent claims and explained why he was convinced that these claims referred to a single general inventive concept and that they defined two alternative

solutions to a particular common problem. Consequently the appellant could have expected a further communication of the examining division dealing with the new claims, in particular in the light of the appellant's explanations to these claims, and in the light of the fact that only one independent claim (ie claim 1) corresponds to one (ie claim 1) of the previous eight independent claims, so that with respect to the second independent claim (ie claim 4) no relevant comments had been previously given. However, the examining division failed to inform the appellant before issuing the decision why the two independent claims (one of which was new) do not refer to a single inventive concept, and why they do not define two alternative solutions to a particular common problem.

Even in its communication of 20 June 2002 the examining did not deal with these issues. With respect to the unity objection, the examining division merely listed the features of the independent claims which were not disclosed in the most relevant state of the art and listed the problems which in its view were solved by the present independent claims. However, the examining division gave no reason why the independent claims did not contain a common special technical feature, in particular why the pump cover cited in the independent claims and which formed the basis for the independent claims 1 and 4 filed with the letter of 15 October 2002 could not be regarded as such a special technical feature. With respect to the conciseness objection the examining division merely stated that the independent claims did not disclose alternative solutions to a particular problem as required by Rule 29(2) EPC. However, it was neither explained why the problems

cited in connection with the unity objection were the objective problems underlying the different independent claims, nor why there was no common particular problem underlying all independent claims. In particular there was no explanation why the problem cited by the appellant in his letter of 15 October 2002 could not be regarded as such a particular problem.

- 2.6 In the light of the above findings, the board comes to the conclusion that the decision of the examining division was not based on a legal and factual reasoning on which the appellant had had an opportunity to present his comments. Consequently this decision contradicts Article 113(1) EPC, and constitutes a substantial procedural violation.

Under these circumstances reimbursement of the appeal fee is justified.

Furthermore, since the examining division has not yet examined the amended claims filed by the appellant as a reaction to the contested decision, the board considers it appropriate to remit the case in accordance with Article 111(1) EPC to the first instance for further prosecution.

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 of the application on the basis of the following documents:

Claims: No. 1 to 13 filed with the letter of 8 April 2003 (main request)
No. 1 to 12 filed with the letter of 8 April 2003 (auxiliary request).

Description: Pages 1 to 7, 20 to 29 as originally filed; and
Pages 8, 9, 19 filed with the letter of 3 June 2002.

Drawings: Figures 1 to 16 as originally filed.

3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

G. Magouliotis

C. Andries