

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 17 October 2006**

Case Number: T 0533/04 - 3.2.03

Application Number: 99109781.7

Publication Number: 0936421

IPC: F25B 1/00

Language of the proceedings: EN

Title of invention:

Strategic modular commercial refrigeration

Applicant:

HUSSMANN CORPORATION

Opponent:

-

Headword:

Generalisation of a specific embodiment

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Lack of enabling disclosure"

Decisions cited:

-

Catchword:

-



Case Number: T 0533/04 - 3.2.03

D E C I S I O N
of the Technical Board of Appeal 3.2.03
of 17 October 2006

Appellant:

HUSSMANN CORPORATION
12999 St. Charles Rock Road
Bridgeton, MO 63044 (US)

Representative:

Moreland, David
Marks & Clerk Scotland
19 Royal Exchange Square
Glasgow G1 3AE (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 1 December 2003
refusing European application No. 99109781.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: J.-P. Seitz
Members: C. Donnelly
Y. Jest

Summary of Facts and Submissions

I. European Patent application number 99109781.7 was filed on 18 May 1999 as a divisional application to European application number 94915916.4 filed on 26 April 1994. The application was rejected by a decision of the examining division dated 1 December 2003 on the grounds that the subject-matter of claim 1 according to the request indicated in letter of 2 May 2003, corresponding to claim 1 of the third auxiliary request filed with letter of 28 February 2002, contravened the requirements of Article 123(2) EPC.

II. The appellant filed a notice of appeal on 30 January 2004 and paid the appeal fee the same day. By letter of 31 March 2004 the appellant set out the grounds of appeal and requested that the impugned decision be set aside. With the same letter the appellant also filed first and second auxiliary requests and made a request for oral proceedings pursuant to Article 116(1) EPC to be held should the Board be inclined to maintain the impugned decision in any form.

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

"A modular commercial refrigeration unit (10) comprising a condensing unit rack (10,10H) configured to accommodate the maximum aggregate refrigeration loads of at least two product cooling zones (33,33A-33K) provided in a food store area, said condensing unit rack comprising closed refrigeration circuit components including a plurality of multiplexed compressor means (21) and associated refrigerant high side delivery (27) and low side suction means (26A),

the unit rack being constructed and arranged for placement, in use, in strategic proximity to the at least two product cooling zones, and being operatively connected to evaporator means (29) for the respective corresponding zones, and said refrigeration unit also including condenser means (12,24) as a component of the closed refrigeration circuit, at least part of the condenser means being on the rack and said at least part of the condenser means further being , in use, operatively associated with a remote cooling source (11) to provide a heat exchange relationship with at least part of the condenser means."

IV. In its decision the examining division argued that there is no basis in the originally filed application documents for the feature specifying "at least part of the condenser means being on the rack". In the examining division's view, the introduction of this feature is a generalisation of the situation shown in figure 2 since it covers embodiments not originally disclosed, namely:

- (a) the condenser can now be located off the rack with the heat reclaim coil positioned on the rack; and
- (b) both the condenser and the heat reclaim coil can be located on the rack.

V. In letter of 31 March 2004, setting out the grounds of appeal, the appellant mainly relied on the disclosure of the refrigeration circuit shown in figure 2 to counter this argument. In the appellant's view the condenser means of the claim cannot be construed as being solely the system condenser, but should be understood also to include the heat reclaim coil. The

appellant points out that the examining division explicitly accepted this interpretation in the impugned decision.

Therefore, according to the appellant, since the heat reclaim coil is part of the condenser means and as figure 2 shows that the heat reclaim coil (24) is not positioned on the condenser unit rack, there is a basis in the originally filed documents for the contested feature.

The appellant also referred to page 12, lines 7 to 19 of the divisional application as filed in order to support the contention that the heat reclaim coil is optional.

VI. In a communication annexed to the summons to oral proceedings in accordance with Article 11(1) RPBA, the Board indicated that it tended not to accept the appellant's arguments. In particular, it was mentioned that the appellant did not appear to have provided a response to the argument that the contested feature is a generalisation of the specific configuration represented in figure 2.

Oral proceedings were held on 17 October 2006 in the absence of the appellant who had informed the board by letter of 13 October 2006 that he would not be attending.

Reasons for the Decision

1. In the Board's view, figure 2 only explicitly shows an embodiment wherein the system condenser (12) is placed on the condenser unit rack and the heat reclaim coil (24) is placed off the condenser unit rack. The Board agrees with the appellant that it would be apparent to the skilled person that the heat reclaim coil is optional, as suggested by the passage at page 12, lines 7 to 19 of the divisional application as filed. Thus, an embodiment comprising the system condensing unit (12) alone on the rack is also disclosed.

However, as argued by the examining division, the amendment introduced by the appellant goes beyond these two configurations and allows for the following further embodiments:

- (a) the condenser can now be located off the rack with the heat reclaim coil positioned on the rack; and
- (b) both the condenser and the heat reclaim coil can be located on the rack.

The Board would add that the amendment also allows for the main system condenser to be split on and off the rack.

2. The appellant has argued that since in the impugned decision it is accepted that the heat reclaim coil is part of the condensing means and that figure 2 of the application shows the heat reclaim coil is not located on the rack, it is incoherent to conclude that there is

no support for the contested feature in the originally filed documents.

3. However, in the Board's view it is the appellant's reasoning that is flawed since it fails to take into account that the heat reclaim coil is a separate and distinct unit intended to fulfil the specific function of recovering heat for secondary purposes such as space heating. The heat reclaim coil, especially as regards its position within the overall system, cannot therefore be equated with the system condenser itself. The fundamental difference between the two units is also borne out by the fact that, as argued by the appellant, the heat reclaim coil is optional. The formulation of any claim based on the configuration of figure 2 must therefore preserve a distinction between the two units, however, this is not the case with the present wording.

4. In conclusion, it is the Board's opinion that the contested feature constitutes a generalisation of the originally disclosed subject-matter and therefore claim 1 of the main request is in breach of Article 123(2) EPC.

This feature is also present in both of the auxiliary requests, hence the same objection applies.

Order

For these reasons it is decided that:

The appeal is dismissed.

Registrar:

Chairman:

A. Counillon

J.-P. Seitz