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**Datasheet for the decision
of 22 June 2007**

Case Number: T 0763/04 - 3.2.04

Application Number: 01915434.3

Publication Number: 1269891

IPC: A47C 7/02

Language of the proceedings: EN

Title of invention:

Seat furniture

Patentee:

Badia I Farre, Jordi

Opponent: -

Headword:

-

Relevant legal provisions:

EPC Art. 52 (1), 54, 111 (1), 113(1)

EPC R. 51 (3), 67, 68 (2)

Keyword:

"Novelty (yes, after amendment)"

"Disregarding facts and arguments which may speak against the decision taken"

"Substantial procedural violation (yes)"

"Reimbursement of appeal fee (yes)"

"Remittal for further prosecution"

Decisions cited:

J 0007/82, T 0094/84, T 0135/96

Catchword:

"The right to be heard in accordance with Article 113(1) EPC is contravened if the decision of the first instance fails to mention and to take into consideration important facts and arguments which may speak against the decision in question."



Case Number: T 0763/04 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 22 June 2007

Appellant: Badia I Farre, Jordi
Applicant: Europe 12
E-08028 Barcelona (ES)

Representative: Ponti Sales, Adelaida
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 March 2004
refusing European application No 01915434.3
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: A. de Vries
T. Bokor

Summary of Facts and Submissions

I. The Appellant lodged an appeal, received at the EPO on 13 May 2004, against the decision of the Examining Division posted 17 March 2004, refusing the European patent application no. 01 915 434.3 filed as an international patent application PCT/ES01/00115 and published as EP-A-1 269 891.

The Examining Division held that the application did not meet the requirements of Articles 52(1) and 54 EPC having regard to the following document

D1: WO-A-00 02470.

II. With a communication of 18 January 2007 pursuant to Article 100(2) EPC the Board suggested a clarification of the characterizing part of claim 1 (all requests) which would render the claimed seat distinct from the prior art. With letter of 22 May 2007, the Appellant stated his approval of the suggested amendment.

III. The Appellant requests that the decision under appeal be set aside and a patent be granted based on the following documents in accordance with main, first, and second auxiliary requests.

Main request

Claims

No.: 1 as amended with letter of 22 May 2007

No.: 2 to 11 as filed with letter of 25 February 2004

Description

Pages: 3-8 as published

Pages: 1,2 as filed with letter of 25 February 2004

Figures

Sheets: 1/2, 2/2 as published

1st Auxiliary request

Claims

No.: 1 as amended with letter of 22 May 2007

No.: 2-11 as filed with letter of 25 February 2004

Description

Pages: 3-8 as published

Pages: 1,2 as filed with letter of 25 February 2004

Figures

Sheets: 1/2, 2/2 as published

2nd Auxiliary request

Claims

No.: 1 as amended with letter of 22 May 2007

No.: 2-8 as filed with letter of 25 February 2004

Description

Pages: 3-8 as published

Pages: 1,1a,2 as filed with letter of 25 February 2004

Figures

Sheets: 1/2, 2/2 as published

In addition, the Appellant requests that the appeal fee be reimbursed. As a subsidiary request, he requests oral proceedings.

- IV. The wording of the independent claims of the requests is as follows :

Main request

"1. A seat, particularly to one incorporating part of the features characteristic of seats of the high stool

type, insofar as it constitutes an individual seat that is taller than a normal chair, where the seat as such is situated at a such height as to allow the user to rest the user's feet on the floor or on a footrest and is constituted by a body that at the upper end thereof, on the surface of use, is differentiated into in a rear seat portion for the user's buttocks and a higher front portion which, inserted between the user's thighs, allows the user to sit astride it, said front portion being differentiated, lengthwise down the centre, into two parallel portions, said parallel portions, being mirror images, spaced apart to define therebetween an open space, characterized in that said open space is located in correspondence with the user's genital area and allowing the latter to be accommodated therein".

First Auxiliary Request

With respect to claim 1 of the main request the lines of claim 1 pertaining to the rear seat portion are amended to read : "... a rear seat portion for the user's buttocks, *said rear portion including a gently concave surface*, and a higher portion ..." (italics added by the Board to indicate text inserted)

Second Auxiliary Request

With respect to claim 1 of the main request the final lines of the claim 1 are amended to read : "... to define therebetween a *frontal open space which constitutes a deep notch that extends across the full thickness of said seat body*, characterized in that ..." (italics added by the Board to indicate text inserted).

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. *Allowability of amendments under Article 123(2) EPC*

The amendment of the final line of claim 1 of all three requests by the insertion of "and allowing the latter to be accommodated therein" is based on lines 2-4 of page 6 of the original description, and this amendment is thus allowable under Article 123(2) EPC.

3. *Novelty with regard to D1*
 - 3.1 The invention concerns a seat of saddle type, which comprises a rear portion for the user's buttocks, and a higher front portion for insertion between the user's thighs, which in turn comprises two parallel, spaced apart, mirror-shaped portions, between which an open space is formed. It is undisputed that such a seat is known from D1, see figures 2 and 4, lines 10-19, with the open space identified by reference 5. These features in fact appear in the preamble of claim 1 of each of the three requests.
 - 3.2 In dispute is the sole characterizing feature of claim 1 (all requests), namely that the open space *is located in correspondence with the user's genital area and allowing the latter to be accommodated therein*. The Board notes that, though this feature is drafted in reference to a user's anatomy rather than in terms of concrete limitations of the claimed seat itself, it nevertheless considers it to be a sufficiently clear

instruction to the skilled person as to where the open space must be located on the seat. In view of variations in anatomy that occur between individuals the Board considers a more concrete definition unduly limiting.

3.3 D1 does not explicitly disclose the characterizing feature of claim 1, nor does it provide precise details of the location of the space 5. However, from the shape and placement of the side parts on either side of the open space 5 as explained in the description and shown in figures 2 and 4 in particular, the Board infers that the open space 5 is located at a position *forward of* the genital area. In use this open space therefore does not allow a user's genital area to be accommodated therein, as required by the claim.

3.3.1 As convincingly argued by the Appellant, the side parts, in the form of "troughs" that fit the contours of the inner thighs, partially raising them to the front (page 3, line 19-21; page 5, lines 5-8), descend some 25-30 cm in the direction of the thighs from the supporting point of the seat bone (page 5, lines 4-5). As may also be inferred from figure 4 the innermost edge of the space 5 is thus located at a relatively large distance in front of the seat bone supporting point, which is commensurate with a location of the space *in front of* the groin. The desired increase in air circulation in the inner thigh and pelvic area (page 3, lines 8-10) results at least in part from this location (though the Board believes that the down- and forward position of the thighs, which results in a loosening of the clothing in the groin area, may also play a role).

3.3.2 The location of space 5 in D1 forward of the groin of the seated user also is circumstantially supported by document

D2: WO-A-02/063998

submitted by the Appellant. D2 claims a later priority date and is by the same inventors as D1. It teaches a further development of the D1 seat, namely the provision of an open space extending the length of the seat (page 2, lines 10-14), to eliminate genital compression (page 2, lines 16-19). This open space must thus be below the genital area, whereas space 5 in D1, on which D2 improves, is *not*.

3.4 In conclusion, the location of the open space 5 differs from that required by claim 1 in all requests, as does its function. The seat of claim 1 of each of the requests is therefore novel with respect to the prior art of D1.

4. *Request for reimbursement of the appeal fee*

4.1 D1 is included in a set of 27 documents first introduced and cited as prejudicial to novelty and inventive step in the second communication issued 31 July 2003 under Article 96(2) EPC. That communication followed an initial communication of 28 February 2003 referring briefly to the positive International Preliminary Examination Report issued in the PCT phase by the same Examiner. The second communication does not provide any discernable chain of reasoning, much less specific passages of the documents and thus fails to meet the requirement of Rule 51(3)

EPC that a communication under Article 96(2) contain a reasoned statement.

- 4.1.1 At the behest of the Appellant (letter of 27 October 2003), the Examining Division issued a further communication, dated 7 November 2003, which included a brief paragraph for each of the then current requests.
- 4.1.2 In response, the Appellant with letter of 27 February 2004 submitted new main, first and second auxiliary requests. The amendments concerned exclusively the two-part form; the claims remained unchanged in substance. In the accompanying letter, the Appellant gives lengthy and detailed arguments as to why he considers the location of the open space in the seat to be different from that in D1, and why this location is, in his opinion, not obvious.
- 4.1.3 The Examining Division thereupon, without issuance of a further communication, issued its decision to refuse. The reasons of the decision, apart from minor editorial changes, are identical to those given in the final communication. There is no mention or consideration of the arguments submitted by the Appellant. The refusal, reasons point 4, merely states: "this objection has not been overcome by the amended claims as filed with the applicant's letter of 25.02.04".
- 4.2 The Board notes that the final communication of 7 November 2003 is the *first* communication to contain a reasoned statement in the sense of Rule 51(3) EPC with regard to the sole objection of lack of novelty with regard to D1. D1 was itself introduced by the Examining

Division at a late stage in the procedure, which up to that point had led the Appellant to believe in a positive outcome. Under these circumstances, the Appellant, who, as his last set of detailed arguments show, had made a bona fide attempt to address the sole objection raised, could have legitimately expected the Examining Division out of fairness to use the discretion afforded by Article 96(2) EPC to offer at least one further opportunity to address the objection. For this reason alone, the Board considers the refusal after the third communication, which was the first Rule 51(3) EPC compliant communication as regards the ground of lack of novelty, without the issuance of a further communication, to represent a violation of the general principles of good faith and fair proceedings underlying proceedings before the EPO.

- 4.3 Article 113(1) EPC enshrines a party's right to be heard before a decision is issued against it. In accordance with established jurisprudence of the Boards of Appeal (see J 7/82, OJ 1982, 391 and T 94/84, OJ 1986, 337) this right also guarantees the right to have the relevant grounds fully taken into account in the written decision, that is, see further T 135/96, in the case of a decision rejecting the opposition, the ground(s) for opposition as well as facts, evidence and arguments presented in support of these grounds for opposition. In that latter case, Article 113(1) was seen to be contravened as documents and further alternative arguments based thereon had been disregarded in the decision. In the present Board's view, the above principles apply equally to the consideration of facts and arguments submitted by an applicant in support of his case in decisions in

examination proceedings. Article 113(1) EPC will then be contravened where, as is the present case, facts and arguments, which from the appellant's submissions are clearly central to his case and which may speak against the decision taken, are completely disregarded in the decision in question.

The facts and arguments submitted with letter of 27 February 2004 deal extensively and exclusively with the feature of the location of the open space, which the Appellant identifies as the sole distinguishing feature vis-à-vis D1, and which thus, in the Appellant's view, rendered the claimed subject-matter novel over this prior art. The length and detail of the Appellant's arguments show clearly that this was, from the Appellant's point of view, a crucial point in the issue of novelty.

There is no evidence in the decision that shows that the examining division took these facts and arguments into consideration. The decision is wholly silent as to these facts and arguments. Nor can it be argued that they have been implicitly considered by the first instance in its decision. Except for some minor editorial amendments, the content of this decision is essentially the same as that of the last communication dated 7 November 2003, issued prior to Appellant's detailed letter of reply of 27 February 2004.

By way of example, the first paragraph of the decision dealing with the issue of lack of novelty over D1 having regard to the subject-matter of claim 1 of the main request differs from the first paragraph of the final communication merely by the addition of the word

"whereby" between "two parallel portions 3" and "said parallel portions 3, being mirror images". In fact, the decision has been drafted as if the examining division had overlooked the facts and arguments submitted with the letter of 27 February 2004.

- 4.4 In point 4 of its decision, the examining division does refer to the amended claims filed with that letter, by stating that "the objection has not been overcome by the amended claims". The sole amendment to the claims was to put them into the two-part form. Clearly, such an amendment of a purely formal nature could not by itself overcome the lack of novelty raised by the examining division. Exactly for this reason the Appellant included in his letter extensive and detailed facts and arguments to demonstrate to the examining division that the feature in the second part of claim 1 was not known from D1. It is all the more reprehensible, that these facts and arguments were then not taken into consideration by the examining division. Article 113(1) EPC is not a formal provision, but rather one of substance. Hence it is not sufficient to observe Article 113(1) merely formally by granting the Applicant the **procedural** possibility for presenting comments, as this was the case here. This procedural step falls short of its legislative purpose and remains a pure formality, if there is no trace in the file that such comments were indeed read and discussed on the merits, beyond a mere acknowledgement of their existence. In summary, Article 113(1) requires not merely that a party be given an opportunity to voice comments, but more importantly it requires that the deciding instance *demonstrably hears and considers* these comments.

Accordingly, the board finds that the failure of the Examining Division to mention and to take into consideration these facts and arguments in the decision taken constitutes a substantial procedural violation within the meaning of Rule 67 EPC and for reasons of equity calls for reimbursement of the appeal fee.

5. So as not to deprive the Appellant of the right to have all issues decided before two instances, the Board, pursuant to Article 111(1) EPC, remits the case to the Examining Division for further prosecution based on the currently valid requests. Examination should proceed with regard to the requirements of novelty in view of the remaining citations other than D1, and of inventive step with respect to all citations.

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 request for reimbursement of the appeal fee is allowed.

The Registrar

The Chairman

U. Bultmann

M. Ceyte