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**Datasheet for the decision
of 8 April 2008**

Case Number: T 1207/04 - 3.2.04

Application Number: 00102154.2

Publication Number: 0998963

IPC: A63C 9/08

Language of the proceedings: EN

Title of invention:
Snowboard boot binding system

Patentee:
THE BURTON CORPORATION

Opponents:
Sam Sports & Marketing AG
ATB Ing. Anton Tauber

Headword:
-

Relevant legal provisions (1973):
EPC Art. 76(1), 100(c)
EPC R. 115(2)

Keyword:
"Compliance with Article 76(1) EPC - main request and
auxiliary requests 1 to 4 (no)"

Decisions cited:
G 0001/06, T 0938/95, T 1067/97, T 0714/00

Catchword:
-



Case Number: T 1207/04 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 8 April 2008

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
28 July 2004 concerning maintenance of European
patent No. 0998963 in amended form.

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
T. Bokor

Summary of Facts and Submissions

I. In its interlocutory decision posted 28 July 2004, the Opposition Division found that, taking into account the amendments made by the patent proprietor during opposition proceedings, the European patent and the invention to which it relates (according to the auxiliary request) met the requirements of the EPC.

On 30 September 2004 Appellant I (patentee) filed an appeal and paid the appeal fee simultaneously. On 7 October 2004 Appellant II (opponent I) filed an appeal and paid the appeal fee simultaneously and on 1 October 2004 Appellant III (opponent II) filed an appeal and paid the appeal fee simultaneously. The statements setting out the grounds of appeal were received respectively on 7 December 2004 (Appellants I and II) and 2 December 2004 (Appellant III).

II. The oppositions were filed on the grounds based on Article 100(a) (54 and 56) EPC 1973.

The Opposition Division introduced on its own an objection based on Articles 100(c), 76(1) EPC 1973 and found that the main request did not meet the requirements of Article 76(1) EPC 1973.

III. Oral proceedings took place on 8 April 2008 before the Board of Appeal.

With letter dated 6 March 2008 Appellant II informed the Board that he withdraws his request for oral proceedings and that he will not attend them. As provided for in Rule 115(2) EPC the oral proceedings were continued without him.

Appellant I requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims filed as a main request, or in the alternative on the basis of the claims according to one of the auxiliary requests 1 to 4, all filed during the oral proceedings before the Board.

He mainly argued as follows: It is clear for a skilled reader that the provision of a skewed binding base plate is not linked to any other feature of the binding and is valuable information on its own. The descriptions of the originally filed divisional application, the parent and grandparent applications all disclose the highback as an "additional" feature, which therefore is not presented as essential for the invention. Furthermore, the highback or the hold-down plate are nowhere presented as essential. The configuration of the side walls of the binding is not specifically defined in the originally filed applications but it is implicit that the side walls follow the contour of the skewed base plate.

The Appellants II and III (opponents I and II) contested the arguments of Appellant I and in essence submitted that there is no indication in any of the preceding applications that providing a skewed binding base plate would be an invention per se. This feature has been disclosed in the originally filed applications only together with other features which are essential for the invention. Therefore, a skewed binding plate cannot be claimed independently of these essential features.

Appellants II and III requested that the decision under appeal be set aside and that the patent be revoked.

IV. Claim 1 according to the main request (as granted) reads as follows:

"1. A snowboard binding, characterised in that the binding (16) includes a skewed binding base plate (18), specifically designed for one of the left foot and the right foot, wherein the front of the base plate (18) is skewed to a side to accommodate the ball and large toe of the left or right foot."

Claim 1 according to the first auxiliary request reads as follows:

"1. A snowboard binding comprising a binding base plate (18) and a highback support (28) for the lower leg, characterised in that the base plate (18) is skewed, specifically designed for one of the left foot and the right foot, wherein the front of the base plate (18) is skewed to a side to accommodate the ball and large toe of the left or right foot."

Claim 1 according to the second auxiliary request reads as follows:

"1. A snowboard binding which includes a binding base plate (18) and a hold-down plate (30) adapted to engage the binding base plate (18) from above and to secure the base to a snowboard, wherein the binding base plate (18) and the hold down plate (30) include co-operating means (32, 34) for enabling step-wise rotational adjustment of the hold-down plate relative to the binding base plate (18), and further wherein the binding includes a highback leg support (28) for the back of the leg of the

rider, the binding being characterised in that binding base plate (18) is skewed, specifically designed for one of the left foot and the right foot, wherein the front of the binding base plate (18) is skewed to a side to accommodate the ball and large toe of the left or right foot."

Claim 1 according to the third auxiliary request reads as follows:

"1. A snowboard binding which includes a binding base plate (18) and a hold-down plate (30) adapted to engage the binding base plate (18) from above and to secure the binding base plate (18) to a snowboard, wherein the binding base plate (18) and the hold down plate (30) include co-operating means (32, 34) for enabling step-wise rotational adjustment of the hold-down plate relative to the binding base plate (18), and further wherein the binding includes a highback leg support (28) for the back of the leg of the rider, the binding being characterised in that binding base plate (18) is skewed, specifically designed for one of the left foot and the right foot, wherein:

for the left foot the front of the binding base plate (18) is skewed to the right side to accommodate the ball and large toe of the foot; and

for the right foot the front of the binding base plate (18) is skewed to the left side to accommodate the ball and large toe of the foot."

Claim 1 according to the fourth auxiliary request reads as follows:

"1. A snowboard binding which includes a binding base plate (18) and a hold-down plate (30) adapted to engage the binding base plate (18) from above and to secure the binding base plate (18) to a snowboard, wherein the binding base plate (18) and the hold down plate (30) include co-operating means (32, 34) for enabling step-wise rotational adjustment of the hold-down plate relative to the binding base plate (18), and further wherein the binding includes a highback leg support (28) for the back of the leg of the rider, the binding being characterised in that binding base plate (18) is skewed, specifically designed for one of the left foot and the right foot, wherein:

for the left foot the front of the binding base plate (18) is skewed to the right side to accommodate the ball and large toe of the foot; and

for the right foot the front of the binding base plate (18) is skewed to the left side to accommodate the ball and large toe of the foot, and further characterised in that

two side walls (20) rise from the plate (18) near the heel and the highback leg support (28) is connected to the two sidewalls at respective connection points (26), the sidewalls (20) having front areas provided with attachment points for straps for holding a boot in the binding."

Reasons for the Decision

1. The appeals are admissible.

2. *Compliance with the requirements of Article 76(1) EPC:*

2.1 According to G 1/06, in the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, it is a necessary and sufficient condition for a divisional application of that sequence to comply with Article 76(1), second sentence, EPC 1973 that anything disclosed in that divisional application be directly and unambiguously derivable from what is disclosed in each of the preceding applications as filed.

2.2 The contested patent EP-B-0 998 963 (00 102 154.2) is a divisional application from EP-A-0 916 371 (98 124 426.2) (parent application) which has itself been divided out of EP-A-0 624 112 (93 906 961.3) only published as WO-A-93/14835 (grandparent application).

The descriptions of the contested patent as filed, of the parent and of the grandparent applications as filed are identical.

The wording of the claims of the grandparent application is no longer present in the parent application and thus, these claims cannot serve as a basis for the claims of the contested patent. The claims of the parent application are directed to a snowboard and do not define the binding itself and accordingly cannot serve as a basis either.

The only possible basis for the claims of the contested patent are the description and the figures as originally filed.

2.3 It has thus to be determined what is directly and unambiguously derivable from the original description

and the figures, taking into account matter which is implicit to a technically minded reader.

In the present case, only one passage of the description and figures 2 to 4 disclose a skewed base plate (first paragraph of page 7 of the description of the divisional application as filed on which the patent under appeal is based; paragraph [0024] of the parent application; page 7, lines 1 to 5 of the grandparent application). This passage reads "The preferred binding 16 shown in Figs. 2, 3 and 4 is specifically designed for a left foot in that the front of the binding plate is skewed to the right side to accommodate the ball and large toe of the foot. Of course, this can simply be mirror imaged to result in a similar binding for the right foot."

This paragraph thus refers to the "preferred binding" according to the invention which should also solve the problems addressed by the invention.

In the original description the objects of the invention are defined as follows:

"Thus it is an object of the invention to provide a boot binding system for a snowboard that has several degrees of freedom along the surface of the board.

It is a further object of the invention to provide a boot binding system providing freedom about a normal to the surface of the board.

It is yet another object of the invention that the boot binding system be collapsible for storage and transport.

It is a still further object of the invention that the boot binding system be simple and cost effective to manufacture, yet reliable and efficient in use."

- 2.4 In the passage of the descriptions as filed entitled "Summary of the invention" it is stated "In accordance with a preferred embodiment demonstrating further objects, features, and advantages of the invention, a boot binding system comprises a binding plate, the bottom of which is supported on a snowboard. The plate includes a circular opening in its center which receives a disk shaped hold-down plate. The hold-down plate may be secured to the board in several different positions on the board with the binding plate assuming any rotational position with respect to the hold-down plate. Additionally, a highback support attached at the rear of the binding plate may be rotated along an axis generally normal to the binding plate (and therefore the board) and secured in its rotated position, to enable a rider to transmit forces to the snowboard from a variety of stance positions".
- 2.5 From this passage it can be derived that freedom about a normal to the support surface is obtained by providing a hold down plate with rotational adjustment of the hold-down plate relative to the base and by a highback rotatable along an axis normal to the binding plate.
- 2.6 Appellant I argued that it is not necessary to have a hold-down plate and a rotatable highback leg support to define a snowboard binding including a skewed base plate as defined in claim 1, because a skilled person would appreciate the independent nature of the skewed base plate with respect to the hold-down plate and the rotatable highback.

The Board is unable to follow this reasoning. It is not normally allowable under Article 123(2) or 76(1) EPC

1973 to extract isolated features from a set of features that have been disclosed in combination for that embodiment unless there is no functional or structural relationship between these features, see also the Case Law of the Boards of Appeal, 5th edition 2006, III.A.1.1 (T 714/00, T 1067/97 and T 938/95).

In the preferred binding shown in Figures 2, 3 and 4 "which is specifically designed for a left foot" the skewed base plate is provided with two opposite side walls which are essential for holding a foot in the binding and for defining an orientation for the foot relative to the snowboard. The highback leg support is rotatably mounted on these two opposite side walls which are integral with the skewed base plate. There is clearly a structural and functional relationship between the skewed base plate that is its side walls and the rotatable highback leg support. The same applies with the skewed base plate and the hold-down plate which is adapted to engage the skewed base plate from above and to secure it to the snowboard.

The skewed base plate was not claimed in either the parent application or the grandparent application. In the divisional application on which the European patent is based, the skewed base plate has been introduced into a new claim 1. However, since it is derivable from the parent application and the grandparent application that there is a functional and structural relationship on the one hand between the skewed base plate and the rotatable highback leg support and on the other hand between the skewed base plate and the hold-down plate, it amounts to an unallowable amendment to isolate the skewed base plate from its combination with the rotatable highback

leg support and the hold-down plate when introducing it into the new claim. It follows that claim 1 according to the main request and the first auxiliary request which does not include the rotatable high back leg support and the hold-down plate does not meet the requirements of Article 76(1) EPC 1973.

2.7 It goes without saying that there is also a structural relationship between the skewed base plate and its side walls which are, in the preferred binding shown in Figures 2, 3 and 4, integral with the skewed base plate. As has been explained, these opposite side walls are essential for holding a foot in the binding, for rotatably mounting the highback leg support on the skewed base plate and for the fastening straps for attaching the boot in the binding. It also amounts to an unallowable amendment to isolate the skewed base plate from the provision of its opposite side walls when claiming the skewed base plate. Accordingly, claim 1 according to the main request and the auxiliary requests 1 to 3 which does not comprise the provision of these opposite side walls does not meet the requirements of Article 76(1) EPC 1973 either.

2.8 Appellant I further argued that the highback is not an essential feature of the invention. He referred to the paragraph entitled "Summary of the invention" (quoted in section 2.4 above) where it is stated "... Additionally, a highback support ..." and stated that this term means that what is disclosed subsequently belongs to a separate invention. He also referred to a further passage of the description (description as originally filed, page 6, lines 17 to 27; parent application, paragraph [0022]) where it is stated

"The highback 28 may also be rotatably adjusted ..." and alleged that "may" is indicative of an optional feature.

This cannot be accepted since in paragraph [0021] the highback is said to embody the present invention. The fact that the highback is rotatable contributes to solve one of the objects of the invention, i.e. to provide freedom about a normal to the surface of the board. Therefore, a rotatable highback is an essential feature of the invention.

- 2.9 Furthermore, it is stated in claim 1 of all requests "the binding base plate is skewed, specifically designed for one of the left foot ..." However, according to the passage of the description quoted in section 2.3 above, it is the binding which is "specifically designed for a left foot" and not solely the binding plate. This implies that the side walls of the binding plate too have to be "specially designed for one of the left foot ..."

Appellant I contended that the side walls follow the rim of the binding base plate and that consequently, the side walls are implicitly skewed like the binding base plate.

This cannot be accepted. Solely the binding according to claim 1 of the fourth auxiliary request comprises side walls. According to this claim the side walls rise from the plate near the heel and have front areas provided with attachment points for straps for holding the boot. This does imply neither that the side walls follow the rim of the base plate, nor that they are specifically designed for a left or right foot. It is not even indicated whether the side walls extend along the base plate up to its front part or not.

2.10 Allowing the amendment that the base plate is provided with side walls without specifying the essential feature that these side walls are also skewed would mean that the problem solved by the present invention, that is a binding which is specially designed for the left or the right foot, could be solved by only the skewed base plate, which is clearly "new information". Thus the subject-matter generated by such an amendment is not directly and unambiguously derivable from the originally filed parent or grandparent application and therefore does not comply with Article 76(1) EPC 1973 either.

2.11 Moreover, claim 1 of the auxiliary requests 2 to 4 contains the following amendment: "the binding base plate (18) and the hold down plate (30) include cooperating means (32, 34) for enabling step-wise rotational adjustment of the hold-down plate relative to the binding base plate (18)".

What is directly and unambiguously disclosed in the parent and grandparent applications is a binding base plate having an aperture (36) shaped and sized for receiving the hold-down plate (30) in at least two rotational orientations (see claim 9 of the grandparent application). Moreover, the binding base plate is said to be attached to the snowboard 10 "through the use of a hold down plate 30 having splines, ribs or ridges 32 on at least a portion of its under surface that engage complimentary splines ribs or ridges on a central aperture 36 in the binding plate 18" (page 4, second paragraph of the grandparent application).

In the following third paragraph at the same page, the hold-down plate "preferably has an inverted frusto-

conical shape where the sloped walls include the ridges that engage the binding plate 18. The aperture 36 in the binding plate 18 has a complimentary frusto-conical shape which sloped walls 40 having complimentary ridges"

The above amendments as to "co-operating means for enabling step-wise rotational adjustment" is clearly a generalisation of the disclosed embodiment which should be regarded as introducing subject-matter extending beyond the content of the grandparent application as filed, since it covers features not specifically mentioned therein, in particular that:

- i) the step-wise adjustment can be carried out without an aperture (36) provided in the binding base plate for receiving the hold-down plate,
- ii) the co-operating means can be made without a hold-down plate having splines, ribs or ridges on at least a portion of its under surface that engage complementary splines, ribs or ridges on the aperture in the binding plate.

Thus the skilled person is presented with new information generated by this amendment which is not directly and unambiguously derivable from the originally filed grandparent application.

It follows that claim 1 of the auxiliary requests 2 to 4 which include the amendment in question does not meet also for these reasons the requirements of Article 76(1) EPC 1973.

3. All these requests were filed during the oral proceedings before the Board. Appellant III objected to their admissibility. However, since none of these

requests is allowable, it is superfluous to consider whether they are admissible or not.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The patent is revoked.

The registrar:

The Chairman:

G. Magouliotis

M. Ceyte