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D E C I S I O N
of 4 May 2006

Case Number: T 1394/04 - 3.2.01

Application Number: 98122121.1

Publication Number: 0922625

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Language of the proceedings: EN

Title of invention:

Power steering assembly

Applicant:

TRW Automotive U.S.LLC

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 82
EPC R. 86(4)

Keyword:

"Amendment of claims - switching to unsearched subject-matter"

Decisions cited:

T 0708/00, T 0274/03, T 0141/04

Catchword:

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Case Number: T 1394/04 - 3.2.01

D E C I S I O N
of the Technical Board of Appeal 3.2.01
of 4 May 2006

Appellant: TRW Automotive U.S.LLC
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 27 May 2004
refusing European application No. 98122121.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. Crane
Members: C. Narcisi
G. Weiss

Summary of Facts and Submissions

- I. The European patent application Nr. 98122121.1 was refused with the decision of the Examining Division posted on 27 May 2004. The Examining Division decided that the subject-matter of amended claim 1 according to the main and to the auxiliary request filed on 22 December 2003 did not comply with the originally claimed invention to form a single general inventive concept (Rule 86 (4) EPC).
- II. Against this decision an appeal was filed on 6 August 2004 and the appeal fee was paid at the same time. The grounds of appeal were filed on 4 October 2004. The appellant requested the application to proceed to grant on the basis of claim 1 according to the main or to the auxiliary request filed on 22 December 2003.

Claim 1 according to the main request reads as follows:

"A power steering assembly (10) for use in turning steerable vehicles, said power assembly comprising: a valve core (40); a valve sleeve (41) encircling said valve core, said valve core and valve sleeve having surfaces which cooperate to direct flow of power steering fluid during relative rotation between said valve core and valve sleeve; and a bearing assembly (100) disposed between said valve core and said valve sleeve at a location adjacent to a first end portion of said valve core, said bearing assembly (100) includes a plurality of bearing elements which are rotatable relative to said valve core and which transmit sidewise load between said valve core (40) and said valve sleeve (41);

an end portion of said valve core opposite to said first end portion of said valve core having a bearing surface (102), said bearing surface being slidable along an inner surface area (104) on said valve sleeve to transmit a sidewise load during relative rotation between said valve core and valve sleeve; wherein the bearing elements (124) are disposed in an annular groove (126) formed in the valve core (40) and having an inner (base) surface (134) and axially facing and radially extending walls, and wherein on both sides axially adjacent to the side walls of said grooves (126) gaps are formed between surfaces of the valve core (40) and valve sleeve (41).

Claim 1 according to the auxiliary request differs from claim 1 according to the main request in that at the end of that claim the following feature has been added:

"and wherein said valve core (40) comprises a radial protrusion having a pair of axially facing side walls and wherein the side wall of the radial protrusion that is closer to the bearing assembly (100) forms an additional gap in conjunction with an axially facing end surface of said sleeve (41)".

III. The arguments presented by the appellant in the grounds of appeal may be summarized as follows:

To establish whether a violation of Rule 86 (4) EPC in conjunction with Article 82 EPC has occurred amended claim 1 now on file has to be compared with original claim 1 and it has to be determined whether the payment of a further search fee would have been necessary, had both these independent claims originally been filed

together (see T 708/00, OJ 2004, 160). The subject-matter of claim 1 according to the main request differs from that of originally filed claim 1 by the feature implying that (i) "the bearing elements are disposed in an annular groove formed in the valve core and having an inner (base) surface and axially facing and radially extending walls, and wherein on both sides axially adjacent to the side walls of said groove gaps are formed between surfaces of the valve core and valve sleeve". This amendment obviously further limits the originally claimed subject-matter and further restricts its scope of protection. Therefore, no "a priori" lack of unity could possibly arise between the subject-matter of claim 1 as amended and of claim 1 as originally filed. Hence the only possibility of an objection of lack of unity "a posteriori" is left.

But, for the same reasons as set out in T 708/00 (see headnote II and reasons for the decision, point 16), since the subject-matter of original claim 1 had already been considered by the Examining Division as lacking novelty with respect to D1 (JP-A-61 160 362), no lack of unity could possibly arise between original claim 1 and claim 1 according to the present main request. Thus, in conclusion, the decision of the Examining Division was incorrect since it relies upon an erroneous interpretation of Rule 86 (4) EPC.

Reasons for the Decision

1. The appeal is admissible since it meets the requirements of Articles 106 to 108 EPC in conjunction with Rules 1 (1) and 64 EPC.

2. It is noted first that said amendment (i) introduced into claim 1 of the main request meets the requirements of Article 123 (2) EPC since it is disclosed by figures 1-3 as originally filed and since said features (i) are obviously implied by original dependent claim 6, given that the bearing elements have to be guided by the valve sleeve, so that the surface of the valve core adjacent said groove will be normally out of contact with the valve sleeve, thus forming a gap with respect to it.

3. The question concerning the criteria to be used for the proper application of Rule 86 (4) EPC has been dealt with in various decisions of the Boards of appeal, such as for instance T 708/00, T 274/03 or T 141/04. As a general principle it was held in T 708/00 that "a subsequent amendment to limit the subject-matter of the main claim by additional features disclosed in the application as filed does not generally affect the notion of unity of invention under either Rule 86 (4) or Rule 46 (1) EPC" and that "it is normal for an applicant to make such an amendment in respect of an objection to the patentability of the subject-matter in unlimited form" (T 708/00, headnote III). In T 274/03 it was however made clear that certain conditions have to be satisfied for an amendment not to generally affect the notion of unity of invention. Thus, this notion is not affected, and therefore no post-search switching of subject-matter is involved by the amendment, if for instance features are added from the description to further define an element that was already a feature of the original main claim (see T 274/03, reasons for the decision, point 5), to

- further specify an essential aspect of the original main claim.
4. It results from the above that careful consideration of the very nature of the added feature is necessary in order to determine whether the amendment leads to a situation where lack of unity of inventive concept between the original main claim and the later claimed subject-matter arises. Such a situation in the present context would necessarily entail an implicit finding of lack of unity "a posteriori" (T 274/03, reasons for the decision, point 6) and according to the Guidelines for examination (C-III, 7.7) in the EPO this form of objection to lack of unity should be the exception.
 5. Nevertheless it cannot be excluded that such a situation may arise as a consequence of later amendments supported solely by the description. In fact, it may occur that the description of the application contains a further general inventive concept, distinct from that underlying the main claim and its dependent claims, if any, but not clearly identified or declared as such in the description. In such a case, if the subject-matter of the main claim based on the first inventive concept had to be amended, on account of lack of novelty resulting from too broad terms used in the wording, any amendment of the claim pertaining exclusively to said further inventive concept could justify an objection of lack of unity "a posteriori".
 6. In view of the above, the appellant's argument referring to point 16 of the decision T 708/00 and implying that no objection on the grounds of lack of unity ("a posteriori") between claim 1 in its original

and its amended form should have been raised by the Examining Division cannot be accepted. While it is certainly true that the fact that D1 destroys the novelty of the subject matter of original claim 1 is not sufficient reason to establish lack of unity ("a posteriori"), it cannot be seen that for there to be lack of unity the claims under consideration would have to define a group of different "inventions", "i.e. inventions which each make an inventive contribution to the state of the art". In fact, as decision T 274/03 clearly demonstrates, if it is assumed, as is usually the case, that the original main claim contains at least in very broad terms the general inventive concept of the invention as set out further in the dependent claims, if any, and in the description, then it is certainly possible to determine whether later amendments form part of said general inventive concept, quite independently of the question whether the subject-matter of the main claim lacks novelty. If the latter is however the case, then lack of unity ("a posteriori") pursuant to Rule 86 (4) EPC and Article 82 EPC possibly ensues.

The example under point 5 elucidates that situations may actually occur where the amendment of the main claim, whose subject-matter lacks novelty, based on features supported exclusively by the description, may affect the notion of unity of the invention. Although such situations occur very rarely in practice, as already noted above, in such cases Rule 86 (4) EPC would have to be applied in order to avoid a possible circumvention of Article 82 EPC.

7. In the present case however it is clear that, much the same way as in the decision T 274/03 (see reasons for the decision, points 5 and 6) the introduced amendment including said features (i) merely constitutes a further specification of original features of the claim which are essential to the invention, such as (ii) "said bearing assembly includes a plurality of bearing elements which are rotatable relative to said valve core and which transmit sidewise load between said valve core and said valve sleeve". This constitutes an essential aspect of the invention as it appears particularly from the published patent application, column 1, lines 15-18 and lines 31-42. Consequently, features (i) are to be regarded as being part of the constructional measures which are necessary to implement feature (ii). Therefore, following the general principles set out under point 3 above, no lack of unity pursuant to Rule 86 (4) EPC in conjunction with Article 82 EPC can be found between the subject-matter of claim 1 according to the main request and that of originally filed claim 1.

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 examination.

The Registrar:

The Chairman:

A. Vottner

S. Crane