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**Datasheet for the decision  
of 10 October 2006**

**Case Number:** T 1178/05 - 3.2.01

**Application Number:** 99303882.7

**Publication Number:** 0961056

**IPC:** F16J 3/04

**Language of the proceedings:** EN

**Title of invention:**  
Omnidirectional bellows

**Applicant:**  
Nemoto, Takeshi, et al

**Opponent:**  
-

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 108, 84  
EPC R. 78, 83, 67

**Keyword:**  
"Form of appeal - time limit"  
"Claims - clarity (no)"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 1178/05 - 3.2.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.01  
of 10 October 2006

**Appellant:**

Nemoto, Takeshi et al  
4-32, Johmyoji 1-chome  
Kamakura 248 (JP)

**Representative:**

Downing, Michael Philip  
Fry Heath & Spence LLP  
The Gables  
Masset Road  
Horley,  
Surrey RH6 7DQ (GB)

**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 2 June 2004  
refusing European application No. 99303882.7  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** S. Crane  
**Members:** J. Osborne  
C. Heath

## Summary of Facts and Submissions

I. The appeal is directed against the decision to refuse European patent application No. 99 303 882.7 (EP-A-0 961 056).

II. The application as originally filed included a set of claims 1 to 9 including a claim 1 which reads as follows:

"An omnidirectional bellows for reciprocal displacement, comprising:

in a combination of a guide-rail with the bellows formed of multiple concaved sheets of same size and same shape communicating each with other for covering flexibly longitudinally along with one side of the guide-rail,

a contour along with each inner border of said multiple concaved sheets being formed to follow cross-sectional profile in a direction perpendicular to the longitudinal direction of the guide-rail, and at least said each inner border being surface treated with material having small slipping resistance and large friction strength."

III. The examining division issued a single communication based on the claims as originally filed in which it objected *inter alia* that it was not clear from claim 1 whether the subject-matter of the claim should include the guide-rail and that, moreover, the subject-matter of the claim was not new in comparison with a document CH-A-44 84 46 which it designated 'CH'.

IV. In a letter dated 22 January 2004 the applicants replied to the communication and stated:

"We refer to the official communication issued 29 September 2003 in regard to the above referenced European patent application. In response we file herewith an amended claim set consisting of new claims 1 to 8 in which claims 1 to 6 correspond to claims 1 to 6 as originally filed and claims 7 and 8 to claims 8 to 9 as originally filed. Claim 7 as originally filed has been deleted. In addition, the claims have been amended to improve clarity and to include reference numerals.

The Examiner gave a provisional opinion on patentability suggesting that claims 1 and 7 lacked novelty in the light of CH-A-448646. We understand this to be an equivalent of US Patent No. 3,381,361 which shares the same priority as the cited Swiss application and make the following observations as to the relevance of US 3,381,361. If the Examiner is of the opinion that CH-A-448646 includes matter not set out in US 3,381,361, we shall be grateful if he could identify specifically which portions of the prior art document are relevant to the applicant's claimed invention.

US 3,381,361 relates to a method of manufacturing bellows type seals. Figures 3 and 4 illustrate a method of machining the outer face of the bellows. We can find no description or illustration in this prior publication of any arrangement where the contour along the inner border of the concave sheets which form the bellows is specifically shaped to compliment the cross sectional profile of the guide rail. On the contrary, Figure 1 suggests the absence of such a feature.

We believe claim 1 now more clearly identifies the novel feature and respectfully request favourable re-examination of the application."

The new claim 1 reads:

"An omnidirectional bellows for reciprocal displacement, comprising:

in a combination of a guide-rail (4) with a bellows, the bellows formed from multiple concaved sheets (51, 51a, 51b,) of the same size and shape communicating with each other for covering flexibly longitudinally along one side of the guide-rail (4) characterised by: a contour along each inner border (6) of said multiple concaved sheets said contour being formed to complement the cross-sectional profile of the guide-rail (4) in a direction perpendicular to the longitudinal direction of the guide rail (4), and each inner border (6) being surface treated with material (8) having small slipping resistance and large friction strength."

- V. In the contested decision, which was based on the new claims filed with the letter dated 22 January 2004, the examining division found that claim 1 was not clear. It further indicated that it was of the opinion that the subject-matter of claim 1 contained no feature which would render it novel in comparison with the disclosure of CH. It additionally stated in the final paragraph of 1.2:

"For the sake of completeness it may be noted, as already done in the first communication, that any special surface treatment method equivalent to the

assembly insert-groove of CH, like for instance the application of a covering layer, lies within the scope of normal practise for the person skilled in the art and would thus not define an inventive subject-matter (Art.52 and 56 EPC)."

- VI. The decision was posted on 2 June 2004. No advice of delivery of the decision or acknowledgement of receipt was received by the EPO and with a communication dated 11 October 2004 the applicants were requested to acknowledge receipt of the decision. The applicants returned the enclosed acknowledgement of receipt EPO Form 2936 duly signed and acknowledging receipt of the "document" on 15 October 2004. The "document" was identified on the form as being EPO Form 2007. Following receipt of a renewal fee for the application the EPO informed the applicants with a communication dated 8 June 2005 that it would refund the fee since the application had been considered as closed with legal effect from 12 June 2004.
- VII. Notice of appeal was filed on 1 July 2005 and the appeal fee was paid on the same day. The appellants submitted that although the notice of appeal apparently was filed after expiry of the time limit according to Article 108 EPC, first sentence, it was filed within two months after notification of the contested decision to the applicants. As a precautionary measure the appellants applied for *restitutio in integrum* (re-establishment of rights) in accordance with Article 122 EPC and paid the appropriate fee. The grounds of appeal were filed on 15 August 2005 in a letter of five pages received in a fax transmission of the same length. Confirmation of the letter was

received on the following day. In the letter the appellants stated that they enclosed a set of claims marked "Auxiliary request 1".

VIII. The appellants requested that the contested decision be set aside and a patent granted on the basis of:

- claims 1 to 8 filed with the letter of 27 January 2004 (main request) or in the alternative
- claims 1 to 8 filed with the letter of 15 August 2005 (auxiliary request).

They furthermore requested refund of the appeal fee due to a substantial procedural violation.

IX. The appellants were summoned to oral proceedings to be held on 10 October 2006. In a communication accompanying the summons the board indicated that it considered the appeal to be admissible. It further indicated its provisional opinion that no substantial procedural violation had occurred and that claims 1, 2 and 7 according to the appellants' main request were unclear. It further informed the appellants that it appeared that the claims according to the auxiliary request had not been received by the EPO.

X. With a letter dated 12 September 2006 the appellants informed the board that they did not wish to be represented at the oral proceedings. They provided no response to the objections of lack of clarity raised by the board in its communication and were also silent in respect of the missing documents according to the

auxiliary request. The oral proceedings took place in the absence of the appellants.

- XI. The appellants' submissions in respect of admissibility of the appeal, clarity and substantial procedural violation may be summarised as follows:

The decision has never been received at the representative's offices. The EPO duly noted that the reply card had not been returned and with an official letter of 11 October 2004 sent a fresh reply card. The member of staff who signed the reply card intended to acknowledge receipt of the letter of 11 October 2004, not the decision of 2 June 2004. The return of the 7<sup>th</sup> renewal fee by the EPO prompted the representative to investigate the matter and a copy of the decision was downloaded on 15 June 2005 which accordingly is the date on which it was notified to the applicants. Rule 78(2) EPC is clear in stating that the ten day period allowed for delivery applies unless the letter has failed to reach the addressee or has reached him at a later date. The Rule goes on to say that in the event of dispute it shall be for the EPO to establish the date of delivery.

As regards clarity of claim 1, if the claim covers only a bellows and the guide rail does not need to be present in order for there to be a direct infringement then the claimed definition cannot be complete. However, claim 1 explicitly contains the wording "in a combination of a guide rail with a bellows". It is therefore clear that the guide rail is part of the claim.

The decision is defective in a number of respects which represent a substantial procedural violation justifying refund of the appeal fee. Firstly, the application was refused without having issued a second examination report, as is the usual practice of the EPO. The decision justifies this by noting that it was not considered meaningful to repeat objections already raised. This is not mentioned in the EPO Guidelines as a reasonable basis for immediate refusal of an application. Moreover, the decision contains reasoning in paragraph 1.3 which had not previously been presented to the applicants. The decision is also internally inconsistent. In the penultimate paragraph of 1.2 it is stated that the subject-matter of claim 1 would lack novelty but in the following paragraph it states that the claim lacks inventive step. This is not an acceptable quality of reasoning.

## **Reasons for the Decision**

1. Admissibility of the appeal
  - 1.1 As a consequence of difficulties associated with the return of advices of delivery by the postal authorities of the contracting states the EPO has for many years enclosed a standard acknowledgement of receipt in the form of a white card (EPO Form 2936) with notifications by registered letter with advice of delivery (see "Information from the European Patent Office", OJ EPO 1991, 577). The recipient is asked to acknowledge receipt and return the acknowledgement to the EPO by return of post. In all normal circumstances the EPO and any interested third parties can therefore rely on the

date entered by the recipient on EPO Form 2936 as being the date when the letter it accompanies was delivered to the addressee, the EPO thereby having discharged its duty to establish this date.

- 1.2 The date on the front page of the contested decision indicates a posting date of 2 June 2004. Since no advice of delivery or acknowledgement of receipt of the decision was entered into the file the EPO issued a communication on 11 October 2004 informing the applicants that the advice of delivery of the decision was missing and requesting acknowledgement of the receipt of the decision by completing and returning the enclosed EPO Form 2936. The form was returned to the EPO indicating a date of receipt of 15 October 2004.

In accordance with Rule 78(1) EPC decisions incurring a time limit for appeal shall be notified by registered letter with advice of delivery. According to Rule 78(2) EPC where notification is effected by registered letter it shall be deemed to have been delivered to the addressee on the tenth day following its posting, unless the letter has failed to reach the addressee or has reached him at a later date. In the event of any dispute it shall be incumbent on the EPO to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be.

- 1.3 It is clear from Form 2936 that the date to be entered by the addressee is the date on which the document in question, in this case the decision identified by its cover sheet EPO Form 2007, was received. Once Form 2936 had been returned by the appellants proper handling of

it by the EPO would imply a check that the date entered on it (i.e. 15 October 2004) lay before the deemed date of delivery of the decision of ten days after posting (i.e. 12 June 2004), since if not it would be necessary correspondingly to adjust the time limits according to Article 108 EPC. It is apparent that no such check took place in the present case since 12 June was retained as the date of notification of the decision and the starting point for the calculation of the time limits, as can be seen from the notice closing the procedure (EPO Form 2058) dated 9 November 2004. If that check had been made then it can be assumed that the implausibility of the date actually entered on Form 2936 (more than four months after the date of posting the decision) would have become apparent and that in the normal course of events the Office would then again have sought to establish the actual date of notification of the decision, whereupon the fact that the decision had in fact never reached the addressee would have come to light and been rectified in the appropriate manner. Be that as it may, it is manifestly clear that the "acknowledgement of receipt" returned by the appellant could not be used by the EPO to establish the deemed date of delivery of 12 June 2004. Nor, for the sake of argument would it have been in the very particular circumstances of this case safe for the EPO to rely on the date actually entered on Form 2936 as establishing a date of delivery as required by Rule 78(2) EPC.

- 1.4 It results from the foregoing that the EPO failed to correctly establish the date of receipt of the notification of the decision for the purposes of calculating the time limits set out in Article 108 EPC.

Under these circumstances it is necessary for the board to determine that date and then to assess whether the time limits were met.

2. The appellants state that the communication dated 8 June 2005 informing them that the renewal fee for the application would be refunded was received on 14 June 2005. One day later, on 15 June 2005 they investigated why the application had been considered closed and so became aware of the contested decision. 15 June 2005 therefore must be taken as the date of receipt of the notification for calculation in accordance with Rule 83(2) EPC of the time limit for filing the appeal. Since the notice and grounds of appeal were received within two and four months respectively after that date the appeal is deemed to satisfy the time limits according to Article 108 EPC.
3. Since the appeal also fulfils the remaining requirements of Articles 106 to 108 EPC in conjunction with Rules 1(1) and 64 EPC it is admissible. Under these circumstances the appellants' precautionary application for re-establishment of rights is redundant.

*Main request*

4. Claim 1 defines "An omnidirectional bellows ..." but then further defines this as "comprising: in a combination of a guide-rail with a bellows ... ". The board agrees with the examining division that the wording of the claim is unclear because it raises doubts whether the guide-rail is intended to form part of the subject-matter of the claim.

4.1 The appellants take the view that since the claim contains the wording "in a combination of a guide-rail with a bellows" it is clear that the subject-matter of the claim is the combination. However, this is in contradiction to the first line of the claim. The reader is therefore unable to determine whether the applicants are attempting to protect only a bellows which is defined by reference to a guide rail or whether they are intending to protect the combination of the bellows and a guide rail. As a result the reader is faced with uncertainty as regards the subject-matter which is intended to be protected.

4.2 In accordance with Article 114(1) EPC the board finds the claims to lack clarity also in the following respects on which the appellants did not take the opportunity to present their comments:

- it is unclear what the term "concaved" sheet is intended to define since this neither appears to be a normal term in the art nor is it defined in the application;
- the term "complement" does not have its normal meaning and no other meaning is apparent from the application;
- the specification of a "small" slipping resistance is imprecise;
- the term "friction strength" neither is defined in the application nor appears to have a normal meaning in the art. Even if the term itself were known, the specification of it as being "high" is

imprecise. Moreover, the disclosure of an example of such a material having such a property is merely in the form of a trade mark, "Teflon". The constitution of a material designated by a trade mark may be changed and the material is therefore inadequately defined;

- claim 1 requires that "each" inner border is surface treated whereas the description and claim 3 state that this may be omitted at the ends.
- claims 2 and 7 specify the trade mark "Teflon" and "low" friction material respectively.

4.3 Since the claims fail to satisfy the requirement of Article 84 EPC in respect of clarity the main request must be refused.

*Auxiliary request*

5. The EPO has no record of having received the claims according to the auxiliary request and the appellants were informed of this in the communication annexed to the summons to oral proceedings. They failed to provide a copy of the claims or to address the matter in any other way and the board is therefore unable to consider this request.

*Substantial procedural violation*

6. As regards the appellants' request for refund of the appeal fee due to an alleged substantial procedural violation there are three matters to be considered.

- 6.1 The examining division made the objections that it was not clear from the claim whether the subject-matter of the claim should include the guide-rail and that the subject-matter of the claim was not new in comparison with the document CH. Although the basis of the applicants' reply as regards novelty was that the guide-rail does form part of the subject-matter, they made no attempt to explain how the wording of the (amended) claim clearly defined the presence of this feature. Despite the statement in the letter of reply that "the claims have been amended to improve clarity" the amendments were essentially unrelated to the objection raised by the examining division in this respect. Indeed, the amendment in the relevant part of claim 1 was merely the addition of a reference numeral and the change of "the bellows" to "a bellows". Moreover, the applicants chose to rely solely on reference to another document (US) than used by the examining division, albeit a family member, thereby effectively ignoring the objection made in respect of novelty and putting the onus on the examining division to search for differences in the documents.
- 6.2 The appellants reason that refusal after only one communication results in a substantial procedural violation. However, the examining division used the same grounds (lack of clarity, lack of novelty), the same evidence (CH) and essentially the same arguments in the decision as were given in the communication and the applicants had not requested oral proceedings so that the requirements of Article 113(1) EPC were fulfilled. Additional arguments in paragraph 1.3 of the decision served only to counter those given in the appellants' reply. According to established case law if

an examining division feels that an applicant has made no real attempt to overcome the objections which had been raised it is right to exercise its discretion according to Article 96(2) EPC to terminate the procedure by issuing the decision without further communication. In the present case not only had the applicants failed to adequately deal with the objection of lack of clarity but they had failed completely to deal with the objection of lack of novelty with respect to document CH.

6.3 Another objection made by the appellants concerns the reasoning of the decision. Up to and including the penultimate paragraph of 1.2 the examining division set out its case why the subject-matter of claim 1, and explicitly the feature of surface treatment of each inner border, was not new. The tenor of the final paragraph of 1.2 does not relate to the content of CH anticipating a feature of the claim but to an equivalent of it. This is merely an attempt by the examining division to anticipate amendment of the claim to define a feature which although new with respect to CH nevertheless would not involve an inventive step. There is no part of this statement which contradicts the content of the previous paragraphs.

6.4 On the basis of the foregoing the board sees no procedural violation and the request for refund of the appeal fee must be refused.

**Order**

**For these reasons it is decided that:**

1. The appeal is dismissed.
2. The request for refund of the appeal fee is refused.
3. The fee for re-establishment of rights is to be refunded.

The Registrar:

The Chairman:

A. Vottner

S. Crane