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**Datasheet for the decision
of 3 December 2008**

Case Number: T 0516/07 - 3.2.01

Application Number: 99200838.3

Publication Number: 0943503

IPC: B60R 21/26

Language of the proceedings: EN

Title of invention:

Inflator initiator with insert member

Patentee:

AUTOLIV ASP, INC.

Opponent:

TRW Airbag Systems GmbH
Hirtenberger Automotive Safety GmbH & Co KG

Headword:

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Relevant legal provisions:

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Relevant legal provisions (EPC 1973):

EPC Art. 100(c)

Keyword:

"Opposition grounds - extension of subject-matter (no)"

Decisions cited:

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Catchword:

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Case Number: T 0516/07 - 3.2.01

D E C I S I O N
of the Technical Board of Appeal 3.2.01
of 3 December 2008

Appellant:
(Patent Proprietor)

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 22 February 2007
revoking European patent No. 0943503 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

Chairman: S. Crane
Members: J. Osborne
G. Weiss

Summary of Facts and Submissions

I. The appeal is directed against the decision posted 22 February 2007 revoking European patent No. 0 943 503. The opposition division found that claim 5 as granted contained subject-matter which extended beyond the content of the application as originally filed.

II. The patent was granted on the basis of an application which as originally filed contained *inter alia* the following claims:

"1. An initiator assembly for use in a vehicle, comprising:
an initiator including at least one conductive pin; and
a collar assembly for holding the initiator and including:
an injection-molded insulating material surrounding at least portions of said initiator;
an insert member joined by injection molding to said insulating material and including a body member and a shoulder integral therewith, said body member having an interior section with an inward length extending inwardly within said insulating material and said shoulder having an outward length, extending outwardly from said insulating material;
wherein said outward length of said shoulder is less than twice said inward length of said interior section."

"9. A method for molding an insert member in an initiator assembly for use in a vehicle, comprising:
providing an initiator assembly including at least a first conductive pin having a tip and with a length;

and injection molding said insert member with said initiator assembly using insulating material including extending said insulating material along said length of said first conductive pin, said insulating material extends along said length defining a mating interface that receives portions of said first conductive pin."

"10. A method, as claimed in Claim 9, wherein: said mating interface has a wall and a cavity, said cavity being bounded by said wall and said first conductive pin having portions that are located in said cavity and spaced from said wall."

- III. With letters of 5 September 2008 and 1 December 2008 the respondents (opponents I, II) withdrew their oppositions.

- IV. At oral proceedings held 3 December 2008 the appellant requested that the decision under appeal be set aside and the patent maintained as granted (main request) or in the alternative that it be maintained in amended form on the basis of respective sets of claims filed with a letter of 8 June 2007 (first to fifth auxiliary requests).

- V. Independent claim 5 as granted reads as follows:

"5. An initiator assembly (28,100,200) for use in a vehicle that includes at least a first conductive pin (54,136,228) having a tip (58,144,232) and a length, injection-molded insulating material (36,160,212) surrounding at least portions of said initiator assembly and extending in the direction of said first conductive pin, and an insert member joined to said

insulating material by injection molding said initiator assembly characterized by:

a mating interface that receives portions of said first conductive pin and being defined using said insulating material (36,160,212) that extends in the direction of said length of said first conductive pin (54,136,228), said mating interface having a wall and a cavity, said cavity being bounded by said wall and said first conductive pin (54,136,228) having portions that are located in said cavity and spaced from said wall."

- VI. The appellant's arguments as regards addition of subject-matter in claim 5 as granted were essentially as follows:

The features which were present in the product claim as originally filed but which are absent from granted claim 5 were not presented in the original application as being essential. Moreover, they are neither necessary for solving the problem set nor does their deletion require modification of other technical features. In accordance with case law of the boards their deletion therefore does not result in an addition of subject-matter.

Reasons for the Decision

Main request (claims as granted)

1. The application as originally filed contained a claim 1 directed towards an initiator assembly and independent claims 9, 15 directed towards a method of moulding an initiator assembly and a method of manufacture of an

inflator including an initiator assembly respectively. In the granted claims claim 1 is the only independent method claim whilst claim 5 is the only independent product claim, directed towards an initiator assembly. In the decision under appeal the opposition division found that features included in original claim 1 but not present in claim 5 as granted had been disclosed as being essential and their deletion was found to result in an extension of subject-matter beyond the content of the application as originally filed. The features in question (hereafter "contested features") are:

"a collar assembly for holding the initiator, ... including a body member and a shoulder integral therewith, said body member having an interior section with an inward length extending inwardly within said insulating material and said shoulder having an outward length, extending outwardly from said insulating material; wherein said outward length of said shoulder is less than twice said inward length of said interior section."

2. The opposition division reasoned that the contested features had been deleted from the independent product claim and that since the features had been disclosed as essential this resulted in addition of subject-matter. However, the matter at issue is the change not in the content of the independent product claim but in the overall content of the application, cf. Article 100(c) EPC: "the subject-matter of the European patent extends beyond the content of the application as filed..." (emphasis added).

- 2.1 Original claims 9, 10 specify a method for moulding an insert member in an initiator assembly. The inevitable result of the specified steps of the method would be an initiator assembly including an insert member and comprising the other features set out in those claims. However, the contested features did not appear in the subject-matter of original claims 9, 10, thereby implicitly teaching that they were not essential. Indeed, within the method claims they appeared only in claim 19 which was dependent from claim 15.
- 2.2 In the contested decision the opposition division did consider whether original claims 9, 10 would be an implicit disclosure of the subject-matter of granted claim 5. It argued that this would be the case if the product of granted claim 5 could be produced only by the method of original claims 9, 10. However, it took the view that this was not the case since granted claim 5 did not exclude that the insert member would be joined to the insulating material by injection moulding of a second material.
- 2.2.1 The board disagrees with the opposition division's reasoning concerning manufacture of the product only by the disclosed method. If an originally disclosed method inevitably results in a product then that product is implicitly disclosed. Whether the product could be produced by another method is not relevant to the matter of original disclosure of the subject-matter of a claim directed to the product *per se*. The opposition division referred to case law of the boards regarding change of category of a claim. However, that case law relates to a different situation, namely amendment of a claim in a granted patent and therefore subject to the

provisions of Article 123(3) EPC. The matter at issue in the present case relates to amendment made only before the patent was granted.

2.2.2 As regards the opposition division's view that granted claim 5, in particular the wording "an insert member joined to said insulating material by injection molding", does not exclude that the insert member would be joined to the insulating material by injection moulding of a second material the board notes that original claims 9, 10 also do not exclude such a possibility. The initiator assembly could have been subjected to an injection moulding operation prior to being joined to the insert in a further moulding step. Moreover, there is no disclosure in the application as originally filed of any functional relationship between the contested features and any particular number of injection moulding operations and none would be apparent to the skilled person. It follows that whether or not granted claim 5 excludes the possibility of two injection moulding steps, it is of no consequence to the matter at issue. Finally, the board notes that the wording of granted claim 5 to which the opposition division's argument relates was present in almost identical form in original claim 1: "an insert member joined by injection molding to said insulating material".

2.3 The opposition division also argued that the contested features were disclosed in the application as originally filed as being essential for the solution of the disclosed problem.

2.3.1 In paragraphs [0002], [0003] of the application as originally filed an earlier initiator assembly is described as comprising an outer metal casing having a

collar for coupling to the inflator housing. The collar was located at the outer surface of insulating material surrounding conductive pins on the initiator assembly. The expressed wish was to improve on the state of the art to provide an initiator assembly that would facilitate a suitable connection with the inflator housing while reducing the size of the injection moulded part. In paragraph [0007] in which, as in the method claims as originally filed, cf. particularly claims 1, 19, the author used the term "insert" in place of "collar", it is stated that: "the injection molding of the insert member to the insulating material facilitates the assembly process" and "the design or structure of the insert member results in lower cost and less material being required than the previous design where the insert member was not injection molded".

- 2.3.2 There was no clear statement that the contested features would help to achieve the desired reduction in size of the injection moulded part. Moreover, the skilled person reading the relevant parts of the description as originally filed would not discern any such relationship. On the contrary, the essential teaching was that the use of injection moulding reduced the amount of metal used and avoided the need for a separate fixing arrangement. It is therefore the use of injection moulding to attach the insert member and initiator assembly which the skilled person would have understood as leading to the possibility of a reduction in size, particularly since that feature was common to all three original independent claims.

- 2.4 In a section headed "further remarks" the opposition division treated a further objection of extension of subject-matter in the content of granted claim 1 and found in favour of the patent proprietor (appellant). The board concurs with that finding.
3. On the basis of the foregoing the board concludes that the subject-matter of claims 1, 5 as granted does not extend beyond the subject-matter of the application as originally filed (Article 100(c) EPC 1973).
4. Although the opposition division has indicated opinions on further objections raised by the opponents, they do not form part of the decision. Since the opponents have withdrawn from the procedure the board considers it appropriate to remit the case to the first instance for further examination.

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.

The Registrar:

The Chairman:

A. Vottner

S. Crane