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**Datasheet for the decision
of 26 November 2008**

Case Number: T 1123/07 - 3.2.01

Application Number: 02002767.8

Publication Number: 1231402

IPC: F16F 1/04

Language of the proceedings: EN

Title of invention:

Helical compression spring for a vehicle suspension

Patentee:

CHUO HATSUJO KABUSHIKI KAISHA

Opponents:

Ikuo SAKAI
Verband der Deutschen Federnindustrie

Headword:

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Relevant legal provisions:

-

Relevant legal provisions (EPC 1973):

EPC Art. 108
EPC R. 65

Keyword:

"Admissibility (no)"

Decisions cited:

J 0010/07, T 0220/83, T 0455/92, T 0493/95

Catchword:

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Case Number: T 1123/07 - 3.2.01

D E C I S I O N
of the Technical Board of Appeal 3.2.01
of 26 November 2008

Appellant:

(Patent Proprietor)

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Decision under appeal: Decision of the Opposition Division of the European Patent Office posted 23 April 2007 revoking European patent No. 1231402 pursuant to Article 102(1) EPC 1973.

Composition of the Board:

Chairman: J. Osborne
Members: P. L. P. Weber
T. Karamanli

Summary of Facts and Submissions

- I. The appeal is lodged by the patent proprietor against the decision of the opposition division dated 23 April 2007 to revoke the patent because of lack of novelty.

The notice of appeal was filed on 2 July 2007 and the statement of the grounds on 3 September 2007.

- II. Claim 1 as granted reads as follows (feature identification according to the decision of the opposition division):

"1) A helical compression spring (5) for a vehicle suspension

2) to be compressed between an upper seat (3) and a lower seat (4),

3) said spring being formed to provide a coil axis (CA) to be substantially curved at a predetermined radius (R) of curvature in an unloaded state of said spring,

*4a) wherein a pitch of a lower end coil (5a) of said spring (5) is set to tilt a lower end plane (LS) of said spring (5) seated on said lower seat (4) at a first predetermined angle (α) to said lower seat (4) in a direction for shortening the longitudinal length of said spring at the inside of the curvature in the unloaded state of said spring (5),
and/or*

4b) a pitch of an upper end coil (5b) of said spring (5) is set to tilt an upper end plane (US) of said spring (5) seated on said upper seat (3) at a second predetermined angle (β) to said upper seat in a direction for shortening the longitudinal length of said spring (5) at the outside of the curvature in the unloaded state of said spring (5),

characterised in that

5a) the pitch of said lower end coil (5a) is set to tilt the lower end plane (LS) of said spring (5) at a third predetermined angle (γ) to said lower seat (4) on a plane including an end coil center line (OF) connecting the centers of said upper end coil (5b) and said lower end coil (5a) perpendicular to a plane including said end coil center line (OF) and said curved coil axis (CA), in the unloaded state of said spring (5),

and/or

5b) the pitch of said upper end coil (5b) is set to tilt the upper end plane (US) of said spring (5) at a fourth predetermined angle (δ) to said upper seat (3) on the plane including said end coil center line (OF) perpendicular to the plane including said end coil center line (OF) and said curved coil axis, (CA) in the unloaded state of said spring (5)."

III. The opposition division considered in its decision that features 4a, 4b, 5a, 5b (hereafter "contested features") did not serve to define the features of the helical compression spring claimed in claim 1 since their wording defined a relative position of the spring and

its seats, which seats were not part of the claimed subject-matter which was the spring alone. According to the opposition division the contested features had thus to be ignored and a spring having the features 1 to 3 was known from D1 or D2, so that the subject-matter of claim 1 was not new.

In the decision it can be read:

"The further features 4a, 4b, 5a and 5b of claim 1 are concerned with a relationship of said spring with respect to the seats of a strut on which the ends of said spring are seated.

An orientation of the lower and upper end coil in an unloaded state towards the respective lower and upper seat of the suspension is given. The pitch of the end coil is set to achieve this orientation.

The orientation of the end coils, which is only defined in relation to the orientation of the seats as in features 4a, 4b, 5a and 5b of claim 1, is not a feature of the spring per se.

For discussion of novelty, therefore, only features 1), 2) and 3) which relate to the spring per se have to be taken into account.

The patentee referred repeatedly to the Guidelines, Part C Chapter III, 4.8 a) saying that a definition of the spring with respect to other elements is allowed and that the relationship with respect to the vehicle suspension and its seats is a restriction.

In view of the Opposition Division there is no restriction.

Although reference is made to an entity, a vehicle suspension with a lower and an upper seat, that is known, the relevant features of this entity, the angles of tilt of the lower seat and the angles of tilt of the upper seat are not in any way given. These features are necessary to define the deformation of the spring when it is mounted and loaded.

Although a vehicle suspension with a lower and an upper seat is known, it is by no means a standard product wherein the angles and the direction of tilt of the seats are always the same.

Although it is said in the Case Law English Edition 2006 p.188, T 455/92 that the exact values are not necessary for the present case such values are necessary; the difference between the angle of the end plane and the angle of the seat determines the side at which the spring is shortened when it is mounted and loaded."

- IV. In its statement of the grounds of appeal the appellant considered that the opposition division was wrong in not considering the contested features as belonging to the claimed subject-matter and that if the opposition division had considered these features the subject-matter of claim 1 would have been novel over D1.

The statement of the grounds of appeal essentially consisted of 7 paragraphs and reads as follows:

"According to the decision of the Opposition Division, the opposed patent has been revoked because of lack novelty of the subject matter of claim 1. In item 3. of their decision, the Opposition Division have stated

that features 4a, 4b, 5a and 5b of claim 1, which relate to a relationship of the claimed spring with respect to the seats of a strut on which the spring ends are seated, do not limit the scope of the claim and have therefore been excluded from consideration for the examination of novelty.

Irrespective of the fact that, during the oral proceedings, the Opposition Division did not clearly inform the patentee about their new opinion so as to give the patentee any chance to cancel claim 1, this opinion is not in line with various Decisions made by different Technical Boards of Appeal of the European Patent Office. Therefore, it was more than surprising.

Reference is made to the following Decisions:

- T 0031/01-3.4.2*
- T 0733/02*
- T 0455/92-3.2.4*
- T 0458/96-3.4.2.*

All the Decisions cited are based on the problem that claim 1 contested respectively contains features of the claimed subject-matter which relate to a cooperation with another subject-matter and therefore would have to be left unconsidered according to the present contested Decision. In all of these former Decisions as stated above, the Technical Boards of Appeal have regarded these features as restricting the scope of protection and therefore as being relevant for the judgment of novelty and inventive step.

Hence, the appellant takes the view that, following the established legal practice of the EPO, features 4a, 4b, 4a und 5b should have been considered.

In this case, the appellant would like to refer to its statement of May 4, 2006. By this, the appellant has provided its detailed technical comments on the question of novelty and inventive step compared to the prior art filed. Nothing about these technical observations has changed so far, so that, for the time being, the appellant will refrain from repeating its arguments here.

For this reason, the appellant maintains its original opinion, namely that, if all features of the subject-matter of the invention according to the granted claim 1 are considered, the requirements of Art. 100a EPC are fulfilled at least according to the granted claim 3 taken individually (cf. 1. auxiliary request)."

V. In response to the statement of grounds of appeal the respondents I and II submitted inter alia that the appeal was inadmissible.

VI. On 26 November 2008 oral proceedings took place.

The appellant requested that the decision be set aside and the patent be maintained as granted or in the alternative that the patent be maintained in amended form on the basis of the auxiliary request filed with the statement of grounds of appeal.

The respondents I and II requested that the appeal be rejected as inadmissible or be dismissed.

VII. The arguments of the respondents I and II in as far as they relate to admissibility of the appeal can be summarised as follows:

For a statement of the grounds of appeal to satisfy the requirements of admissibility it must be immediately apparent without further investigation why it is alleged that the impugned decision should be set aside. This requirement is not fulfilled by the present statement of the grounds of appeal which expresses nothing else than a wish of the appellant that something of claim 1 should have been considered. There is no explanation as to why the decision is wrong and why it should have been considered in another way.

There is no explanation in the present statement of the grounds of appeal as to why in the particular case of claim 1 of the patent in suit the opposition division should have considered the features which attempt to define the spring in relation to the seats of the spring on the strut. There is no explanation as to why the cited decisions should support the view of the appellant. One of the cited decisions is even about clarity when the patent has been revoked because of lack of novelty.

As to the argument presented for the first time in the oral proceedings that the patent proprietor's right to be heard had not been respected, this is not understandable even after having heard the appellant's subsequent explanations since already in the respondents' notices of opposition the objection was raised that the features in question did not define any

limitation. Also, in the oral proceedings held during the opposition procedure before the deliberation of the opposition division took place the parties were asked whether they had further requests, as can be seen from the minutes of the oral proceedings on file. Moreover, it is impossible to know from the relevant paragraph of the statement of the grounds of appeal what the intention of the appellant was. There is in particular no associated request. Simply mentioning that the patent proprietor was surprised does not necessarily mean that it requests the decision be set aside because it considers that its right to be heard has not been respected.

VIII. The reply of the appellant can be summarized as follows:

A statement of the grounds of appeal is present in the file and it is clear from it what the appellant wants. The features at stake are mentioned, it is mentioned that the opposition division simply ignored these technical features, four decisions are mentioned which support the appellant's view that these features cannot be ignored, and if the features are considered the situation would be completely changed and this would be sufficient to set aside the decision.

A complete reasoning explaining why the subject-matter of claim 1 would then be new is therefore not necessary in the statement of the grounds of appeal, since the decision would have to be set aside on the sole ground that the situation were completely different. Novelty is not the subject of the appeal. It is to be noted that in its decision the opposition division did not

properly substantiate its lack of novelty objection, so that there is no reason why the appellant should do so.

The appellant nevertheless referred to its response to the notices of opposition in which it explained why the subject-matter of claim 1 was considered to be new. In the auxiliary request claim 1 has been deleted, so that the grounds for the revocation clearly do no more apply to the auxiliary request.

An explanation of the content of the four cited decisions and an explanation as to why they support the appellant's request is also not necessary, the board of appeal knowing the decisions. Citing decisions is equivalent to citing articles or rules of the EPC for which it would equally be unnecessary to recite their wording. They belong to the knowledge of the European Patent Office.

In addition the second paragraph of the statement of the grounds of appeal clearly shows that the appellant considers that the opposition division did not respect the appellant's right to be heard. In its annex to the summons to oral proceedings the opposition division gave a positive opinion on the patentability of claim 1 and reversed this opinion during the deliberation in the oral proceedings without informing the appellant. The appellant had thus no chance to react to the change of opinion of the opposition division for instance by cancelling claim 1. There was no apparent reason as to why the opposition division should have changed its mind and the chairman of the opposition division should have given a hint if it intended to do so. For the

appellant there was thus no basis for filing an auxiliary request.

This is clearly expressed in the second paragraph of the statement of grounds of appeal since it refers to the surprise of the appellant when the new opinion was announced.

The statement of the grounds of appeal thus fulfils the requirement to make the appeal admissible.

Reasons for the Decision

1. Since all the time limits for complying with the conditions for filing an appeal had expired before the entry into force of the revised version of the EPC on 7 December 2007, the articles and rules governing admissibility of the appeal of the EPC 1973 apply to the present case (see J 10/07, to be published in OJ EPO, point 1 of the reasons).
2. Pursuant to Article 108 EPC 1973 a statement of the grounds of appeal has to be filed within four months of the date of notification of the decision. Pursuant to Rule 65 EPC 1973 if the appeal does not comply with inter alia Article 108 EPC 1973 the board shall reject the appeal as inadmissible.
3. Extensive case law has defined what the aim and the content of such a statement of the grounds should be.

According to established jurisprudence expressed in many decisions (e.g. T 220/83, OJ EPO 1986, 249,

T 493/95, not published in OJ EPO), the statement of the grounds of appeal should specify the legal or factual reasons on which the case for setting aside the decision is based. The arguments must be clearly and concisely presented to enable the board and the other party or parties to understand immediately why the decision is alleged to be incorrect, and on what facts the appellant bases his arguments, without first having to make investigations of their own.

The novelty line of argumentation

4. In its decision the opposition division considered that the contested features 4a,4b,5a,5b of claim 1 going from "wherein a pitch of a lower end coil (5a)" to the very end of the characterising portion did not define features of the spring per se.

It is stated under point 3.1 of the decision :

" The orientation of the end coils, which is only defined in relation to the orientation of the seats as in features 4a, 4b, 5a and 5b of claim 1, is not a feature of the spring per se.

For discussion of novelty, therefore, only features 1), 2) and 3) which relate to the spring per se have to be taken into account. "

The opposition division further considered that although in the claim reference was made to a known entity, a vehicle suspension, the features of this entity which it considered would be necessary to define the spring itself, namely the angles of tilt of the

upper and lower seats, were not known, such a vehicle suspension not being a standard product.

It considered that in the present case, contrary to the situation in T 455/92 (not published in OJ EPO) which relates to a different technical field, exact values of the angles were necessary as they determined the side at which the spring would be shortened when it is mounted and loaded.

5. In the first paragraph of its statement of the grounds of appeal the appellant simply states that the opposition division came to its conclusion of lack of novelty because it ignored the contested features.

In the third and fourth paragraphs of the statement of the grounds the appellant cites four decisions of the EPO Boards of Appeal which in its opinion determine established legal practice of the EPO according to which the opposition division in the present case was wrong in not considering the reference made in the definitions of the contested features to the seats of a strut on which the claimed spring is intended to be seated. According to the appellant all of the cited decisions would prove that the boards of appeal have already considered the definition of features by reference to non-claimed subject-matter as limiting and therefore the opposition division in the present case should have done the same.

However, in these paragraphs there is no explanation as to why in the particular case of the subject-matter of the present patent a definition of the spring relative to the seats on which the springs are intended to be

seated when in use is appropriate and should have been allowed and properly considered by the opposition division.

Further, neither an analysis of the cited decisions nor any detailed explanation as to why and how these decisions correspond to the situation in the present case can be found in these paragraphs.

This is also not apparent from the decisions themselves as none of them is concerned with the definition of a spring relative to its seats as in the present case.

6. The appellant considered that the board knows the decisions and that the simple mentioning of them, therefore, should be enough for the board to understand its reasoning.

The board cannot agree with the appellant. Each of the decisions relates to a particular case for which the circumstances may or may not parallel those of the present case. It is not for the board to ascertain for itself by reading the decisions for which particular reasons the appellant thought it appropriate in the present case to consider the contested features. On the contrary the appellant must explain its line of reasoning in order to make it immediately apparent why it thinks that the appealed decision should be set aside.

7. A critical analysis of the main arguments of the opposition division is also absent from the statement of the grounds of appeal.

For instance, the appellant has not explained why in its opinion the opposition division was wrong in considering that a vehicle suspension was not a standardised product so that a more precise definition of the claimed subject-matter was necessary. There is also no explanation of why the opposition division was wrong in not following the approach of T 455/92 which is cited in the contested decision although the appellant apparently considers that same decision T 455/92 to support its opposite view.

8. By not presenting a logical chain of argument as to why the opposition division was wrong and as to why the cited case law supports the appellant's view, the reader is at a loss as to the reasons why the appellant considers that the opposition division should have considered the contested features in the present case and as to why the decision consequently should be set aside. The board would need to analyse both the decision of the opposition division and the cited case law in order to try and understand what could have been the line of reasoning of the appellant.

9. In the statement of the grounds of appeal there is, furthermore, no indication as to how the contested features should be interpreted and as to why they are not present in the documents D1 and D2 considered novelty destroying by the opposition division.

The appellant referred to its letter of 4 May 2006 in response to the notices of opposition. In this letter of twelve pages the appellant dealt with objections under Article 100(b) and (a) EPC 1973 raised by opponents I and II in their notices of opposition.

It dealt with the objections of each opponent in separate sections but without dividing each section according to the objection being treated.

Here again the board would have to find out which of the arguments concerning novelty could have been considered to be relevant in appeal.

10. The respondent considered that in the present case it was not necessary to present in the statement of the grounds of appeal an argumentation as to why the subject-matter of the claim was novel, since a consideration of the contested features would sufficiently change the situation to justify setting aside the decision.

The board cannot share this opinion.

The opposition division revoked the patent because of lack of novelty of the subject-matter of claim 1. Taking the contested features into consideration when determining the subject-matter of the claim is merely one step in examining novelty. If the subject-matter including those features still would not have been new there would be no reason to set aside the decision of the opposition division.

For this reason it is obvious that a critical analysis of novelty is necessary to come to the conclusion that the decision should be set aside. Without such analysis the reasoning which should lead to the setting aside cannot be considered complete.

11. The main request filed with the statement of the grounds of appeal is identical with the sole request

rejected in the appealed decision. Therefore the reasons for the decision are still relevant against the main request in the appeal procedure and the appellant had to state the reasons why the impugned decision was wrong and to be set aside.

Therefore the fact that in the present case an auxiliary request has been filed with the statement of the grounds of appeal which may remove the basis of the objections raised in the decision is not relevant to admissibility of the appeal.

The right to be heard line of argumentation

12. In the second paragraph of its statement of the grounds of appeal the appellant mentions that it was not informed about the final opinion of the opposition division so that the decision came as a surprise. It considers that it is implicit from this second paragraph that it requests the decision to be set aside because its right to be heard was not respected.

Here again the appellant does not explain the detail of its reasoning nor does it indicate the whole of the facts relevant to understanding its reasoning. It does not define which opinion it considers not to have been informed about and why the decision came as a surprise. There is mention of a new opinion of the opposition division but no identification of either the former opinion or how it was considered to have changed.

It is also not immediately apparent from the file that the contested decision should be set aside because of the alleged breach of the appellant's right to be heard.

13. Admissibility of an appeal has to be analysed on a case by case basis. In the present case, as explained above, the board is of the opinion that the statement of the grounds of appeal sets out neither the legal or factual reasons nor the arguments so clearly as to enable the board and the respondents to understand immediately without the need for further investigations, why the decision is alleged to be incorrect. The amount of investigation and number of assumptions the board and the respondents would have to make to try to understand the appellant's case is considered detrimental to the admissibility of the appeal.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

A. Vottner

J. Osborne