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**Datasheet for the decision  
of 7 November 2008**

**Case Number:** T 1391/07 - 3.4.02

**Application Number:** 03000571.4

**Publication Number:** 1304551

**IPC:** G01F 1/684

**Language of the proceedings:** EN

**Title of invention:**

Thermal-type air flow measuring instrument

**Applicant:**

Hitachi, Ltd., et al

**Headword:**

-

**Relevant legal provisions:**

Guidelines C-VI, 9.1.6; C-IV, 6.4

**Relevant legal provisions (EPC 1973):**

EPC Art. 76(1)

EPC R. 67

**Keyword:**

"Divisional application - "double-patenting" (no)"

"Reimbursement of appeal fee (no)"

**Decisions cited:**

G 0001/05, G 0001/06, T 0058/86, T 0118/91, T 0399/96,  
T 0080/98, T 0587/98, T 0500/00, T 0475/02, T 0411/03,  
T 0425/03, T 0467/03, T 0468/03, T 0579/05

**Catchword:**

"see points 2.5, 2.6 and 4"



Case Number: T 1391/07 - 3.4.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.02  
of 7 November 2008

**Appellant:**

Hitachi, Ltd.  
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**Representative:**

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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 9 March 2007  
refusing European application No. 03000571.4  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** A. G. Klein  
**Members:** F. J. Narganes-Quijano  
B. Müller

## Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the examining division to refuse European patent application No. 03000571.4 (publication No. 1304551). The application was filed under Article 76 EPC 1973 as a divisional application of the earlier European patent application No. 01112976.4, now a granted patent (European patent No. 1146320, in the following "the granted parent patent") including an independent claim 1 and a series of dependent claims. This earlier application in turn was filed as a divisional application of the earlier European patent application No. 95116354.2 (in the following "the root application") granted as European patent No. 0708315.
- II. In its decision the examining division held that the application as amended complied with the requirements of Articles 76(1), 123(2), 52(1), 54 and 56 EPC 1973, but that the subject-matter of the sole claim 1 then on file was not clearly distinguishable from that of claim 1 of the granted parent patent so that, in accordance with the prohibition of "double patenting" set out in the Guidelines for Examination in the EPO, chapter C-VI, paragraph 9.1.6, no patent could be granted.
- III. With the grounds of appeal the appellant submitted an amended claim 1 and requested that the decision under appeal be set aside and that a patent be granted on the basis of the amended claim together with pages 1 and 3 to 23 of the description as originally filed, pages 2 and 2a as filed with the letter dated 05.04.2004 and the drawings as originally filed.

The appellant also requested the reimbursement of the appeal fee and, on an auxiliary basis, oral proceedings. In a letter dated 25.09.2008 the appellant made clear that oral proceedings were requested only if the Board did not intend to allow the request for grant.

IV. The sole claim 1 of the application as amended according to the present request of the appellant is worded as follows:

"A thermal-type air flow measuring instrument comprising:  
two temperature sensing resistors (1a; 1b) for measuring a flow rate of a fluid in a fluid passage (5); and  
an auxiliary passage (3) provided in the fluid passage (5), the auxiliary passage (3) comprising a first passageway (302), in which the two temperature sensing resistors (1a, 1b) are disposed, and a second passageway (304) through which most of a fluid which entered the first passageway (302) in a forward direction flows, wherein the first passageway (302) has a fluid inlet port (301) and the second passageway (304) has a fluid outlet port (305), wherein an overall length L of the flow passage through which the fluid flows in the auxiliary passage (3) is longer than a distance l between the inlet port (301) and the outlet port (305) in a direction parallel to the main flow in the fluid passage (5);  
characterized by  
a third passageway (309) extending between said auxiliary passage (3), downstream of said temperature sensing resistors (1a, 1b) with respect to a direction

of the forward flow in said auxiliary passage (3), and said fluid passage (5), wherein the third passage (309) has an opening being arranged downstream of the temperature sensing resistors (1a, 1b), the third passageway (309) has a cross-sectional area being smaller than that of the second passageway (304) and is arranged for allowing an introduction of an amount of reverse flow from the fluid passage (5) into the auxiliary passage (3) for allowing the reverse flow to be led toward the temperature-sensing resistors (1a, 1b)."

Claim 1 of the granted parent patent reads as follows:

"A thermal-type air flow measuring instrument comprising:  
two temperature sensing resistors (1a, 1b) mounted within a fluid passage (5) in close proximity to each other for measuring a flow rate of the fluid in said fluid passage (5); and  
an auxiliary passage (3) provided in the fluid passage (5), the auxiliary passage (3) comprising a first passageway (302), in which the two temperature sensing resistors (1a, 1b) are disposed, a second passageway (304) through which most of the fluid which entered the first passageway (302) in a forward direction flows, wherein the first passageway (302) has a fluid inlet port (301) and the second passageway (304) has a fluid outlet port (305); and  
an overall length L of the flow passage through which the fluid flows in the auxiliary passage (3) is longer than the distance l between the inlet port (301) and the outlet port (305) in a direction parallel to the main flow in the fluid passage (5);

characterized in that  
a third passageway (309) for directing a reverse flow  
of the fluid to said temperature sensing resistors (1a,  
1b), having an opening, which is arranged downstream of  
said temperature sensing resistors (1a, 1b) inside the  
auxiliary passage (3), wherein the third passageway  
(309) has a transverse cross-sectional area smaller  
than that of said second passageway (304)."

- V. In support of its requests the appellant submitted that  
claim 1 requires that the third passageway extends  
between the auxiliary passage, downstream of the  
temperature sensing resistors with respect to a  
direction of the forward flow in the auxiliary passage,  
and the fluid passage, and that this feature is not  
present in claim 1 as granted in the parent patent. The  
appellant concluded that the two claims define  
different subject-matter and do not have substantially  
identical scope and that, consequently, the  
requirements indicated in the passage of the Guidelines  
referred to by the examining division are fulfilled.

Relying on decisions T 80/98, T 587/98 and T 118/91,  
the appellant also submitted that there is no legal  
basis for prohibiting the grant of a divisional  
application relating to an invention different from  
that of the granted parent patent, even if there is  
partial overlap in the respective scopes of protection.  
The appellant referred in this respect to the fact that  
the EPC does not prohibit overlaps between an  
application and earlier patents constituting prior art  
within the meaning of Article 54(2) or Article 54(3)  
EPC 1973, to the way a possible danger of double  
patenting has to be handled according to Article 54(3)

EPC 1973, and to the narrow concept of novelty to be used in the application of Article 54(3) EPC 1973, and concluded that an application of the Guidelines must not lead to the situation that a divisional application and the corresponding granted parent patent are judged differently than a patent and an application unrelated to each other.

The appellant also submitted that it was obliged to file the appeal to overcome the refusal of the application and that consequently the reimbursement of the appeal fee was equitable.

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Objection of "double-patenting"*
  - 2.1 The examining division refused the present divisional application on the grounds that
    - the subject-matter of claim 1 then on file was not clearly distinguishable from that of claim 1 of the granted parent patent and
    - consequently, as provided for in the Guidelines for Examination in the EPO, chapter C-VI, paragraph 9.1.6, a patent could not be granted on the basis of claim 1 then on file in order to avoid the grant of a second patent for the same invention.

Claim 1 amended according to the present request of the appellant differs from claim 1 relied upon by the

examining division in its decision only in minor amendments (replacement of the expressions "in order to allow" and "to allow" by "for allowing") which have no effect on the issues under consideration.

The appellant essentially submitted that

- the subject-matter of claim 1 on file is substantially different from that of claim 1 of the granted parent patent and
- there is no legal basis for rejecting a divisional application relating to an invention different from that of the corresponding granted parent patent, even if there is partial overlap in the respective scopes of protection.

2.2 Before considering the legal issues addressed by the appellant, the Board finds it appropriate to first address the issue of whether the subject-matter of claim 1 on file is the same as that of claim 1 of the granted parent patent as held by the examining division or whether, on the contrary, there is a clear distinction between the inventions defined in both claims as submitted by the appellant.

2.3 In its decision the examining division held that the differences in wording between claim 1 of the application in suit and claim 1 of the granted parent patent related to equivalent formulations, to features that were implicitly present in the other one of the claims, and to features that did not have any affect on the scope of protection, and concluded that the differences in wording between the two claims did not translate into differences between the claimed subject-



matters or between the scopes of protection conferred by the claims.

The Board, however, cannot agree with this finding of the examining division for the following reasons:

Present claim 1 and claim 1 of the granted parent patent are each directed to a thermal-type air flow measuring instrument for measuring the flow rate of a fluid in a fluid passage by means of temperature sensing resistors arranged within an auxiliary passage provided in the fluid passage. According to each of the claims, the instrument comprises a passageway having an opening arranged downstream of the resistors for directing a reverse flow of the fluid to the resistors. However, while claim 1 of the granted parent patent requires that the opening is arranged inside the auxiliary passage, contrary to the examining division's view the subject-matter of present claim 1 leaves open whether the opening is arranged inside the auxiliary passage. As a matter of fact, present claim 1 notionally encompasses embodiments in which the opening is arranged inside the auxiliary passage but, unlike the subject-matter of claim 1 of the granted parent patent, also encompasses embodiments in which the opening is not properly arranged inside the auxiliary passage, but at its boundary as it is the case of the embodiments disclosed in the description of the application with reference to Figures 1 and 1A and in which the opening for allowing the reverse flow to reach the resistors is an aperture 309 formed in one of the walls delimiting the auxiliary passage.

In addition, while the subject-matter of present claim 1 requires that the passageway leading the reverse flow from the fluid passage into the auxiliary passage for directing the reverse flow toward the resistors extends between the auxiliary passage, downstream of the resistors with respect to the direction of forward flow in the auxiliary passage, and the fluid passage, claim 1 of the granted parent patent only requires that the opening of the passageway is arranged downstream of the resistors inside the auxiliary passage. Thus, although in claim 1 of the granted parent patent the opening of the passageway is downstream of the resistors, contrary to the view expressed by the examining division in the contested decision the passageway itself does not necessarily extend as required by present claim 1 and consequently claim 1 of the granted parent patent notionally encompasses embodiments in which the passageway extends from the opening located downstream of the resistors in a direction different from the downstream flow direction.

- 2.4 It follows from the above analysis that there is at least one technical feature in each of present claim 1 and claim 1 of the granted parent patent clearly distinguishing the subject-matter of the respective claim from that of the other one of the claims, and that these distinguishing features are such that the scope of protection sought by the invention claimed in the application as presently amended is notionally different from the scope of protection conferred by claim 1 of the granted parent patent.

In view of this conclusion, the question of whether the remaining differences in the wording of the two claims

translate or not into further distinguishing features is not relevant for the purposes of the present decision.

The same conclusion as reached above is drawn if a comparison is made between the subject-matter of the sole claim presently on file and that of the dependent claims of the granted parent patent or that of the claims of the patent granted on the root application (point I above).

- 2.5 In these circumstances, the Board concludes that, contrary to the view expressed by the examining division in its decision, the grant of a patent on the basis of present claim 1 would not lead to "double patenting" within the meaning of the passage of the Guidelines referred to by the examining division. The Board emphasizes in this respect that the passages of the Guidelines for Examination relating to the prohibition of "double patenting" are all confined to the grant of a second patent claiming "the same invention" (Guidelines, chapter C-IV, paragraph 6.4) and more specifically claiming, even if in different words, "the same subject-matter" (Guidelines, chapter C-VI, paragraph 9.1.6) [emphasis added by the Board]. It is also under this standard that the Boards generally assess the issue of "double patenting" (see for instance decisions T 118/91, point 2.4.1 of the reasons, T 80/98, point 9, T 587/98 (OJ EPO 2000, 497), point 3.3, T 475/02, point 8.6, T 411/03, point 4.2, T 425/03, point 4.2, T 467/03, point 4.2, T 468/03, point 4.2 and T 579/05, point 2.2) and that the Enlarged Board of Appeal has recently endorsed by way of *obiter dictum* in decisions G 1/05 and G 1/06 (OJ EPO

2008, 271 and 307) the practice of the EPO in this respect (see point 13.4 of the reasons: "The Board accepts that the principle of prohibition of double patenting exists on the basis that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses one granted patent therefor. Therefore, the Enlarged Board finds nothing objectionable in the established practice of the EPO that amendments to a divisional application are objected to and refused when the amended divisional application claims the same subject-matter as a pending parent application or a granted parent patent." [emphasis added by the present Board]).

2.6 As present claim 1 would not lead to "double patenting" according to the aforementioned standard, there is no need for the present Board to address the issue of "double patenting" any further at this stage and to address, in particular, the issue of the legal basis for the practice set out in the Guidelines.

In addition, as the practice of prohibition of "double patenting" under consideration is confined to patents and applications directed to the same invention as defined by the subject-matter of the corresponding claims and is therefore confined to claims conferring notionally the same scope of protection, the Board sees no basis for extending this practice to cover claims not defining the same subject-matter but conferring - as is the case with the application in suit and the corresponding granted parent patent, see point 2.3 above - a scope of protection overlapping with each other only partially in the sense that some, but not

all of the embodiments notionally encompassed by one of the claims would also be encompassed by the other one of the claims. In particular, the lack of legitimate interest of an applicant in obtaining two patents for the same subject-matter invoked by the Enlarged Board of Appeal in decisions G 1/05 and G 1/06 *supra* (point 13.4 of the reasons reproduced in part in point 2.5 above) in endorsing the above mentioned practice cannot be invoked in the case in which the scopes of protection conferred by the respective subject-matters overlap only partially with each other as there is no manifest objective reason to deny the legitimate interest of the applicant in obtaining a protection different from - although partially overlapping with - that of the parent patent already granted. In addition, as also pointed out by the appellant by reference to decision T 587/98 *supra*, point 3.4 of the reasons, the EPC, as a matter of fact, does not even prohibit a partial overlap between the scope of protection notionally conferred by a claimed invention and that attributable to a prior art patent as long as the claimed invention defines patentable subject-matter over the prior art patent within the meaning of Articles 52(1), 54 and 56 EPC.

Accordingly, the Board agrees with the appellant that the mere fact that the scope of protection notionally conferred by present claim 1 would partially overlap with that of the granted parent patent does not prejudice the grant of a patent.

- 2.7 In view of the above, the Board sees no reason in the relationship between the invention presently claimed and that of the granted parent patent or that of the

patent granted on the root application for refusing the grant of a patent on the basis of the divisional application as presently amended.

3. *Patentability*

In its decision the examining division already held that the amended application documents complied with the requirements of Articles 76(1), 123(2), 52(1), 54 and 56 EPC 1973. After consideration of the application documents presently on file, the Board has no reason to deviate from this finding of the examining division, even less so as claim 1 under the Board's interpretation is further distinguished from the prior art than according to the view of the examining division. The Board is also satisfied that the application documents amended according to the present request of the appellant and the invention to which they relate meet the remaining requirements of the EPC within the meaning of Article 97(2) EPC.

In these circumstances, the Board concludes that the decision under appeal is to be set aside and a patent to be granted on the basis of the application documents amended according to the appellant's request (Article 97(1) EPC and Article 111(1) EPC 1973).

4. *Request for reimbursement of the appeal fee*

The appeal having been found allowable, the question arises as to whether the examination procedure culminating in the contested decision was tainted with a substantial procedural violation that would justify

the reimbursement of the appeal fee under Rule 67 EPC 1973 as requested by the appellant.

The Board first notes that the examining division found that claim 1 then on file and claim 1 of the granted parent patent both defined substantially the same subject-matter and that this finding contested by the appellant and reversed by the Board in the present decision constituted an error of judgment on the part of the examining division in the assessment of the subject-matter of the claims. An inappropriate or incorrect substantive assessment of the subject-matter of a claim, however, does not constitute a procedural violation, let alone a substantial one within the meaning of Rule 67 EPC 1973 (see for instance decision T 399/96, point 6 of the reasons).

On the basis of the aforementioned finding now reversed by the Board, the examining division then refused the application relying on the practice of prohibition of "double patenting" set out in the Guidelines for Examination in the EPO. The Guidelines do not establish any rule of law (T 500/00, points 2.6.1 and 2.6.2) and do not constitute "requirements" of the Convention within the meaning of Article 97(1) EPC, i.e. requirements on the basis of which an application could be refused if not met. Nonetheless, the departments of first-instance are supposed to act in normal circumstances in accordance with the Guidelines for Examination and, in addition, the prohibition of "double patenting" set out in the Guidelines, chapter C-IV, paragraph 6.4 and chapter C-VI, paragraph 9.1.6 has at least implicitly been supported by some Boards in the past (see for instance T 58/86, point 10 of the

reasons) and more recently been endorsed by way of *obiter dictum* by the Enlarged Board of Appeal in decisions G 1/05 and G 1/06 *supra* where it also indicated a basis for the prohibition (see point 13.4 of the reasons of these decisions reproduced in part in point 2.5 above).

In these circumstances, the fact that the department of first instance has followed such a practice the legal basis for which might not (yet) have been completely clarified or definitely established in the case law is in the Board's view not open to objection. In any case, the question at issue is not procedural in nature but concerns the application of the law and in the Board's opinion - and in contrast to decision T 587/98 *supra*, point 5 of the reasons - it would not justify the reimbursement of the appeal fee.

Therefore, the Board is unable to see in the contested decision a substantial procedural violation that would justify under Rule 67 EPC 1973 the reimbursement of the appeal fee as requested by the appellant.

5. *Procedural matters*

The appellant requested oral proceedings on an auxiliary basis only in the event that the Board would not be inclined to allow the appeal and to order the grant of a patent as requested, and not - as confirmed by the appellant, point III above - if the Board merely considered the rejection of the request for reimbursement of the appeal fee. Under these circumstances, the Board considered suitable and



appropriate to issue the present decision without holding oral proceedings.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to grant a patent in the following version:
  - description pages 1 and 3 to 23 as originally filed and pages 2 and 2a as filed with the letter dated 05.04.2004,
  - claim 1 as filed with the letter dated 19.07.2007 and
  - drawing sheets 1/8 to 8/8 as originally filed.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

M. Kiehl

A. G. Klein