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**Datasheet for the decision
of 13 March 2009**

Case Number: T 1891/07 - 3.2.01

Application Number: 03017029.4

Publication Number: 1526006

IPC: B60C 23/00

Language of the proceedings: EN

Title of invention:

System for predetermining the operating threshold of a device surveying the radial deformation state of a tire

Applicant:

Barbanti, Giovanni

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC R. 137(3)

Relevant legal provisions (EPC 1973):

EPC Art. 108, 109(1), 111(1)

EPC R. 67

Keyword:

"Interlocutory revision"

"Decision re appeals - remittal (yes)"

Decisions cited:

T 0041/97

Catchword:

-



Case Number: T 1891/07 - 3.2.01

D E C I S I O N
of the Technical Board of Appeal 3.2.01
of 13 March 2009

Appellant: Barbanti, Giovanni
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Representative: Rinaldi, Carlo
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 26 July 2007
refusing European application No. 03017029.4
pursuant to Article 97(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 26 July 2007 refusing European patent application No. 1 526 006.
- II. In response to communications from the examining division the applicant had twice filed amended claims, latterly on 24 November 2006. The examining division in its decision found that claim 1 did not involve an inventive step in the light of the following state of the art:

D1: US-A-4 606 391;

D2: EP-A-0 893 284.

- III. Claim 1 on which the decision was based reads as follows:

"A system for predetermining the operating threshold of a device surveying the radial deformation state of a tire, the system comprising a movable closure member (50), and a diaphragm (53) acting on the movable closure member (50),
the system being characterized by the fact that:
four forces keeping in equilibrium the movable closure member (50), a first force is due to the pressure existing inside the tire (that is inside the chamber 36), the pressure acting on the diaphragm (53) on the side of the chamber (36), a second force, opposite to the first force, is due to the environmental pressure existing in a chamber (64), a third elastic force is due to springs (49) contrasting the action of the

pressure on the diaphragm (53) on the side of the chamber (36), and a fourth reaction force of a gasket (56) acts on the side of the chamber (64), the dimension of the section of the closure member (50), on which the forces of the pressure and the springs (49) act, determines the value of the pressure inside the tire, the value being capable of upsetting the equilibrium of the forces when the pressure value is identical or lower than a pre-established threshold value, a stopping plate (48) being used as limit stop for the movable closure member (50) if the device is in loading condition and if the pressure in the chamber (36) exceeds the pre-established threshold value."

IV. Notice of appeal was received on 26 September 2007. The notice of appeal was accompanied by three pages of reasoning in support of patentability of the subject-matter of the application.

V. By an order of 30 October 2007 the examining division found that the appeal was not to be rectified and that it was to be referred without delay to the Boards of Appeal.

VI. With a letter of 27 November 2007 the appellant filed *inter alia* a set of "new" claims together with further reasoning in support of patentability. No explicit request was filed but it is implicit that the appellant is requesting that the contested decision be set aside and that prosecution be continued on the basis of the most recently filed documents, namely:

- claims 1 to 16 filed with letter of 27 November 2007;

- description pages 1, 1a, 1b, 1c, 3 filed with letter of 27 November 2007;
- description pages 4 to 10 as originally filed;
- drawings figures 1 to 4 as originally filed.

VII. Claim 1 filed with the letter of 27 November 2007 reads as follows:

"System for predetermining the operating threshold of a device surveying the radial deformation state of a tire, wherein, when the system is loaded and the tire pressure is higher than a pre-established threshold value, a first chamber (36) communicates with the inner part of the tire and a second chamber (64) is connected to the atmosphere, the system is characterised by the fact that an operating threshold is provided, said threshold being defined by the equilibrium of a movable closure member (50) stressed by at least four forces, a diaphragm (53) realizes a seal without friction between the movable closure member (50), which has a central hub (51), drilled in its middle, to connect the first chamber (36) to the inner part of the tire, and a guiding plate (52), the force due to the pressure in the first chamber (36) acting on the movable closure member (50) is proportional to the surface externally delimited by the dimension of an external contour (68) of the member (50), which mates by means of a free axial movement with the centring obtained in the guiding plate (52), said surface being internally delimited by the effective sealing section of a first gasket (56), the planning of the surface, externally delimited by

the dimension of the external contour (68) of the movable closure member (50) and internally delimited by the effective sealing section of the first gasket (56), allows to regulate the force of the pressure in the first chamber (36) acting on the movable closure member (50), elements are further provided which generate forces when the system is loaded, said forces acting on the movable closure member (50) to maintain said member (50) in equilibrium in the loading state."

VIII. The appellant's submissions in as far as they are relevant to the present decision may be summarised as follows:

D1 discloses a tyre valve cap which continuously provides an analogue indication of a change in pressure in a tyre to which it is fitted. It does not indicate whether the pressure has fallen below a pre-determined value. By comparison, the system as presently claimed may be set in accordance with a pre-determined threshold pressure and will monitor if the pressure in the tyre falls below that value. Moreover, whilst the device according to D1 and the system as presently claimed both depress the tyre valve in order to measure the pressure, in the event that the pressure drops below the set value the present system closes the tyre valve. If a leak were to occur in the device attached to the valve, therefore, it would not cause the pressure to drop below the set value. A similar fault in the device according to D1, however, would cause the tyre pressure to drop.

Reasons for the Decision

The present decision was taken after the revised European Patent Convention (EPC) entered into force on 13 December 2007. Since the application was pending at that time, the board has applied the transitional provisions in accordance with Article 7(1), second sentence, of the Act revising the EPC of 29 November 2000 and the Decisions of the Administrative Council of 28 June 2001 (Special edition No. 1, OJ EPO 2007, 197) and 7 December 2006 (Special edition No. 1, OJ EPO 2007, 89). Articles and Rules of the revised EPC and of the EPC valid until that time are cited in accordance with the Citation Practice (see the 13th edition of the European Patent Convention, page 4).

1. Article 108 EPC 1973 requires *inter alia* that a notice of appeal must be filed within two months after the date of notification of the decision and that a written statement setting out the grounds of appeal must be filed within four months after that date. In accordance with Article 109(1), first sentence, EPC 1973 if an examining division whose decision is contested considers the appeal to be admissible and well founded it shall rectify its decision. It is evident that receipt of the statement of grounds of appeal is a prerequisite for an examining division when applying the provisions of Article 109(1), first sentence, EPC 1973 to consider whether the appeal is well founded.
 - 1.1 In the present case it appears that the examining division considered the reasoning filed with the notice of appeal to constitute the statement of grounds of appeal. As a result, the file was referred to the Boards of Appeal before the new claims and further

reasoning were filed with the letter of 27 November 2007, although these were filed within the four month time limit for filing the statement of grounds. The further reasoning together with the amended claims were clearly intended by the appellant to serve as the statement of grounds. This is derivable from the letter of 27 November 2007 in which the representative explains that *inter alia* the new claims and further reasoning were being filed "according to the article 108 EPC" and "in order not to lose any right of appeal". Also from the reference to "following claims" in the three pages accompanying the notice of appeal (page 3, first and final paragraphs) it appears that a set of claims was to be filed.

- 1.2 It is customary that an appealing party takes advantage of the two time limits provided for in Article 108, first and third sentences respectively, EPC 1973 by firstly filing a notice of appeal and later filing the statement of grounds and it has the right to fully exhaust those time limits. It may, of course, choose not to do so and file the statement of grounds together with the notice of appeal. If in such a case there is an explicit statement to that effect whereby the appellant foregoes its right to fully exhaust the four month time limit or this is clearly implicit in the circumstances, the board can see no legal barrier to issuing the order on interlocutory revision without delay. If, on the other hand, in a case such as the present where these conditions do not prevail it is incumbent on the examining division to wait until the filing of the full content of the statement of grounds or the expiry of the four month time limit, whichever comes first. In the present case the issuance of the

order to refuse interlocutory revision before receipt of the statement of grounds deprived the applicant of the possibility of a fore-shortened appeal procedure provided by Article 109 EPC 1973 and amounts to a substantial procedural violation, see T 41/97 Reasons point 5.

1.3 Despite the presence of a substantial procedural violation the board considers that it would not be equitable to reimburse the appeal fee (Rule 67 EPC 1973). The violation cannot have been causative in filing the appeal since it occurred after the notice of appeal had been filed.

1.4 In accordance with Article 11 RPBA (OJ EPO 2007, 536 to 547) if fundamental deficiencies are apparent in the first instance proceedings a case is to be remitted to the department of first instance unless special reasons present themselves for doing otherwise. In the present case not only are no such special reasons apparent but remittal is appropriate also for the reasons set out below.

2. Rule 137(3) EPC provides that "after receipt of the first communication from the examining division the applicant may, of his own volition, amend once the ... claims No further amendment may be made without the consent of the examining division."

2.1 The claims on which the contested decision was based were the subject of a second amendment in response to communications pursuant to Article 96(2) EPC 1973 from the examining division. At the time of filing the appeal the appellant therefore had exhausted his rights

under Rule 86(3) EPC 1973 to amend the claims without the consent of the examining division.

2.2 It is established case law of the boards that in an *ex parte* case where claims are significantly amended on appeal which require substantial further examination, the case should be remitted to the examining division, see Case Law of the Boards of Appeal, 5th edition 2006, VII.D.9, 5th paragraph. The appellant's right to appeal to a second instance is thereby maintained, both in relation to the exercise of discretion under Rule 137(3) EPC and in relation to the formal and substantive allowability of the claims. In the present case it is evident that the examining division did not consider the most recently filed amended claims before ordering that the case be referred. The amendments made to claim 1, however, are such that not only the substantive assessment contained in the decision would have to be reviewed but also the question would have to be addressed of whether the amendments made to both claim 1 and the dependent claims affect formal allowability.

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