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**Datasheet for the decision
of 15 January 2010**

Case Number: T 0800/08 - 3.2.08

Application Number: 05076594.0

Publication Number: 1589181

IPC: E06B 3/48

Language of the proceedings: EN

Title of invention:

Sectional overhead door and apparatus for making door panels

Applicant:

WAYNE-DALTON CORP.

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 76(1), 123(2), 111
EPC R. 103

Relevant legal provisions (EPC 1973):

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Keyword:

"Extension beyond the content of the earlier application - no"
"Reimbursement of appeal fee - no"

Decisions cited:

T 0260/85, T 0331/87

Catchword:

-



Case Number: T 0800/08 - 3.2.08

D E C I S I O N
of the Technical Board of Appeal 3.2.08
of 15 January 2010

Appellant:
(Applicant)

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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 28 November 2007
refusing European application No. 05076594.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: P. Acton
E. Dufrasne

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal on 28 January 2008 against the examining division's decision posted on 28 November 2007 refusing European patent application No. 05 076 594.0. The appeal fee was paid at the same time and the statement of grounds was received on 28 March 2008.
- II. The examining division held that the subject matter of claim 1 filed on 28 February 2007 extended beyond the content of the earlier applications as filed (European patent application 01 104 489.8 parent application and European patent application 95 922 323.1 published as WO 95 34738 grandparent application) and that, therefore, the application did not comply with the requirements of Article 76(1) EPC.
- III. The appellant requests:
- that the decision under appeal be set aside,
 - that the application be granted, and
 - that the appeal fee be refunded on the basis that the examining division committed a substantial procedural violation.
- IV. Claim 1 underlying the contested decision reads as follows:
- "A panel (22) for a sectional door (20) employing a plurality of such panels joined for articulation between adjacent panels for moving between a closed vertical position and an open horizontal position, said panel comprising a generally rectangular foam core

(140) having a longitudinal length and a lateral length, an outer surface (141) extending said longitudinal length and said lateral length of said foam core (140), an inner surface (145) extending said longitudinal length and said lateral length of said foam core (140), edge profiles (40, 50) extending the longitudinal length of said foam core (140) and interconnecting said outer surface (141) and said inner surface (145), an outer skin defining said outer surface and an inner skin defining said inner surface, said outer surface being generally planar; characterized by said outer skin (142) defining said generally planar outer surface (141), and said edge profiles (40, 50); said inner skin (146) defining said inner surface (145) between said edge profiles (40,50) and overlapping said outer skin (142); the inner surface being shaped to define a recess (150, 250, 350) in said inner skin (146) and said foam core (140) extending the longitudinal length of said core (140) and laterally centered substantially medially between said edge profiles (40, 50), whereby to reduce the quantity of foam required to fill said foam core (140)."

V. The appellant argued along the following lines:

(a) Refund of appeal fee

The examining division based its decision on the Guidelines, C-VI, 5.3.10 (EPC 1973), which define the three conditions under which a replacement or a removal of a feature from a claim does not violate Article 123(2) EPC. However, contrary to the applicant's request, it refused to take into

consideration decision T 331/87, on which this part of the Guidelines is based. This led to a substantial procedural violation, since it could be expected from an examining division not only to apply the Guidelines but also to look into relevant previous decisions.

(b) Article 76(1) EPC

When assessing whether it is allowed to remove a feature from an independent claim, the Guidelines, C-VI, 5.3.10 (EPC 1973) as well as the decisions T 331/87 and T 260/85 had to be taken into account. Both decisions referred to cases where the description did not contain any positive suggestion that the feature in question could be omitted. However, in the present case the parent and grandparent applications clearly stated that the struts were optional and not essential (see page 8, line 3 and page 26, lines 1 to 2 of the grandparent application). Therefore, the "three conditions" set out in T 331/78 did not apply to the present case. Moreover, even if T 331/78 was applied to the present case, all three conditions would be satisfied.

Reasons for the Decision

1. The appeal is admissible.
2. *Compliance with Article 76(1) EPC*
 - 2.1 The applicant argues that since the omitted feature -the struts- is clearly presented as optional in the previous applications, the three conditions set

out in T 331/87 should not be applied to the present case and that therefore, obviously, this feature could be removed from the claim without contravening the requirements of Article 76(1) EPC.

Both the parent (see [0018], lines 21 to 23) and the grandparent application (see page 8, lines 2 to 3) specify that one of the objects of the invention is to provide panels "which **may have** struts". This wording clearly indicates that the presence of the struts is not compulsory and hence optional. Therefore, the removal of this feature from the independent claim is not subject to the conditions set out in T 331/87. It follows that since the removed feature was described as being optional in both the parent and the grandparent applications, it can be taken away from the independent claim of the divisional application without extending its subject-matter beyond the content of either of the previous applications as filed and hence without contravening the requirements of Article 76(1) EPC.

Even if a specific strength of the panel has to be maintained while optimising the quantity of foam to be used (see page 9, lines 19 to 23 of the grandparent application), this object is not necessarily to be associated with the presence of struts but can be achieved by other means fully compatible with the invention as claimed.

3. *Refund of appeal fee*

According to Rule 103(1)(a) EPC, the appeal fee shall be reimbursed where the Board of Appeal deems an appeal

to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

In the present case the appellant argued that the examining division committed a substantial procedural violation since it refused to take into consideration decision T 331/87.

However, the examining division is not bound by any decision of the Technical Boards of Appeal apart from the one concerning the specific case under appeal (see Article 111(2) EPC). Since examining divisions have to follow the instructions of the Guidelines, they were correct in using the conditions as set out therein. Therefore, since this conduct does not imply any procedural violation, there is no reason to refund the appeal fee.

4. Since the present application was refused exclusively for contravention of Article 76(1) EPC, it is appropriate to remit the case to the examining division (Article 111(1) EPC) for examination of the other requirements of the EPC.

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 on the basis of the following version of the application:

Claims: 1 to 6 filed on 28 February 2007

Description: pages 1 to 9 as originally filed

Drawings: Figures 1 to 3c as originally filed

3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

V. Commare

T. Kriner