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Datasheet for the decision of 17 January 2012

Case Number: T 1448/08 - 3.2.01

Application Number: 01912301.7

Publication Number: 1266778

IPC: B60H 1/00

Language of the proceedings: EN

Title of invention:
Car air conditioner

Patentee:
Valeo Thermal Systems Japan Corporation

Opponents:
Ford-Werke GmbH
Behr GmbH & Co. KG

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)(3)
RPBA Art. 13(1)

Keyword:
"Extended subject-matter (main request, subsidiary requests 1 to 4: yes)"
"Admissibility of late filed request (subsidiary request 5: no)"

Decisions cited:
-

Catchword:
-

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Case Number: T 1448/08 - 3.2.01

D E C I S I O N
of the Technical Board of Appeal 3.2.01
of 17 January 2012

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Decision under appeal:
Decision of the Opposition Division of the European Patent Office posted 4 June 2008 revoking European patent No. 1266778 pursuant to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: G. Pricolo
Members: C. Narcisi
D. Keeling

Summary of Facts and Submissions

I. The European patent No. 1 266 778 was revoked by the decision of the Opposition Division posted on 4 June 2008. Against this decision an appeal was filed by the Patentee on 23 July 2008 and at the same time the appeal fee was paid. The statement of grounds of appeal was filed on 3 October 2008.

II. Oral proceedings took place on 17 January 2012. The Appellant (Patentee) requested that the decision be set aside and that the patent be maintained in amended form in accordance with the main request filed with letter of 11 January 2011 or in the alternative with subsidiary request No. 1 filed with letter of 3 October 2008 or subsidiary request No. 2 filed with letter of 3 October 2008 or subsidiary requests No. 3 and No. 4 filed with letter of 11 January 2011 or subsidiary request No. 5 filed during the oral proceedings. The Respondents (Opponents 1 and 2) requested that the appeal be dismissed.

Claim 1 of the main request reads as follows:

"An automotive air conditioner comprising:
a casing (1) having at least air-introducing means for introducing air and a steering member support part-accommodating portion (2) formed in said casing, for accommodating a steering member support part extending in a right-left direction of a vehicle across a space for installing the casing therein, characterized in that said steering member support part-accommodating portion (2) is a hole (TH) extending through said casing (1) in the right-left direction of the vehicle,

the hole being formed by a hollow cylindrical portion and the casing is configured such that it is divided in a front-rear direction of the vehicle into a fire panel-side part (Fp) and an instrument panel-side part (Rp) with said hole (TH) accommodating said steering member support part as a boundary, and wherein areas around said hole or a circular area surrounding the circumference of said hole is utilized as an air passage."

Claim 1 of subsidiary request 1 reads as follows:

"An automotive air conditioner comprising:
a casing (1) having at least an air-introducing means for introducing air and a steering member support part-accommodating portion (2) formed in said casing, for accommodating a steering member support part extending in a right-left direction of a vehicle across a space for installing the casing therein,
characterized in that said steering member support part-accommodating portion (2) is a hole (TH) extending through said casing (1) in the right-left direction of the vehicle, the hole being formed by a hollow cylindrical portion and the casing is divided into a fire panel-side part (FP) and the instrument panel-side part (RP) with the hole (TH) as a boundary, a dividing surface (1a) of the fire panel-side part (Fp) and a dividing surface of the instrument panel-side part (Rp) are formed with respective semi-cylindrical hollow portions, and the hollow cylindrical portion is formed when the two dividing surfaces (1a, 1b) are joined to each other."

Claim 1 of subsidiary request 2 reads as follows:

"An automotive air conditioner and a steering member support part mounted on an automotive vehicle, said air conditioner comprising:
a casing (1) having at least an air-introducing means for introducing air and a steering member support part-accommodating portion (2) formed in said casing, for accommodating the steering member support part extending in a right-left direction of a vehicle across a space for installing a casing therein,
characterized in that said steering member support part-accommodating portion (2) is a hole (TH) extending through said casing (1) in the right-left direction of the vehicle, the hole being formed by a hollow cylindrical portion and the casing is configured such that it is divided in a front-rear direction of the vehicle into a fire panel-side part (Fp) and an instrument panel-side part (Rp) with said hole (TH) accommodating said steering member support part as a boundary, and wherein areas around the steering member support part or a circular area surrounding the circumference of the steering member support part is utilized as a an air passage."

Claim 1 of subsidiary request 3 reads as follows:

"An automotive air conditioner comprising:
a casing (1) having air-introducing means for introducing air, blowing means for blowing the air from said air-introducing means, cooling means for cooling the air introduced by aid blowing means from said air-introducing means, heating means for heating the air introduced by said blowing means from said air-

introducing means, and air distributing means for distributing the cooled air or the heated air, and
a steering member support part-accommodating portion (2) formed in said casing, for accommodating a steering member support part extending in a right-left direction of a vehicle across a space for installing the casing therein,
characterized in that said steering member support part-accommodating portion (2) is a hole (TH) extending through said casing (1) in the right-left direction of the vehicle, the hole being formed by a hollow cylindrical portion and the casing is divided into a fire panel-side part (FP) and the instrument panel-side part (RP) with the hole (TH) as a boundary, a dividing surface (1a) of the fire panel-side part (Fp) and a dividing surface (1b) of the instrument panel-side part (Rp) are formed with respective semi-cylindrical hollow portions, and the hollow cylindrical portion is formed when the two dividing surfaces (1a,1b) are joined to each other, and wherein circular area surrounding the circumference of said hole is utilized as an air passage."

Claim 1 of subsidiary request 4 reads as follows:

"An automotive air conditioner comprising:
a casing (1) having air-introducing means for introducing air, blowing means for blowing the air from said air-introducing means, cooling means for cooling the air introduced by said blowing means from said air-introducing means, heating means for heating the air introduced by said blowing means from said air-introducing means, and air distributing means for distributing the cooled air or the heated air, and

a steering member support part-accommodating portion (2) formed in said casing, for accommodating a steering member support part extending in a right-left direction of a vehicle across a space for installing the casing therein,
characterized in that said steering member support part-accommodating portion (2) is a hole (TH) extending through said casing (1) in the right-left direction of the vehicle, the hole being formed by a hollow cylindrical portion and the casing is configured such that it is divided in a front-rear direction (BB) of the vehicle into a fire panel-side part (Fp) and an instrument panel-side part (Rp) with said hole (TH) accommodating said steering member support part as a boundary, said steering member support part-accommodating portion (2) is located within an air-mixing space (MX) where air from a cold air bypass passage (C) meet with air from a hot air bypass passage (H)."

Claim 1 of subsidiary request 5 reads as follows:

"An automotive air conditioner comprising:
a casing (1) having air-introducing means for introducing air, blowing means for blowing the air from said air-introducing means, cooling means for cooling the air introduced by said blowing means from said air-introducing means, heating means for heating the air introduced by said blowing means from said air-introducing means, and air distributing means for distributing the cooled air or the heated air, and
a steering member accommodating portion (2) formed in said casing, for accommodating a steering member which is a transversal beam extending in a right-left

direction of a vehicle across a space for installing the casing therein,
characterized in that said steering member accommodating portion (2) is a hole (TH) extending through said casing (1) in the right-left direction of the vehicle, the hole being formed by a hollow cylindrical portion and the casing is configured such that it is divided in a front-rear direction (BB) of the vehicle into a fire panel-side part (Fp) and an instrument panel-side part (Rp) with said hole (TH) accommodating said steering member as a boundary, said steering member accommodating portion (2) is located within an air-mixing space (MX) where air from a cold air bypass passage (C) meet with air from a hot air bypass passage (H)."

III. The Appellant's arguments may be summarized as follows:

The omission of "blowing means", "heating means", "cooling means" and "air-distributing means" in claim 1 of the main request does not contravene Article 123 (2) EPC. Claim 1 is based on granted claim 1 and the presence of the wording "at least one of" in granted claim 1 makes plain that several alternatives are implied. One of these alternatives encompasses the feature (i) "an automotive air conditioner comprising a casing having air-introducing means for introducing air", no mention being made of said "blowing means", "cooling means", "heating means" or "air-distributing means". Claim 1 includes in particular exclusively those technical features which are strictly necessary to the definition of the starting point of the invention and of the related technical problem including its solution. In the present case there

appears to be no doubt that the stated technical problem (see patent specification (hereinafter designated as EP-B)), paragraph [0015]), caused by the interfering installation of the air conditioner and of the "steering member support part" on the vehicle, likewise arises in the event that the casing should comprise only "air-introducing means" and the necessary air conduits. Further, the replacement of "steering member" (see claim 1 of the published patent application (hereinafter designated as EP-A)) by "steering member support part" in present claim 1 similarly does not extend beyond the content of the application as filed. Indeed, it appears to be obvious from the entire disclosure of EP-A, and specifically from the figures, that this constructional element constitutes an exclusively stationary element of the apparatus which is not intended to perform any kind of motion. Moreover, the specific designation of a given constructional element is in itself not of the essence, for what really matters is the technical function attributed to said element as this emerges from the figures and from the disclosure of the invention as a whole. Hence, said replacement actually amounts to an obvious and self-evident correction of the erroneous designation employed for said constructional element in EP-A.

The foregoing arguments likewise apply for claim 1 of subsidiary requests 1 and 2.

Claim 1 of subsidiary request 3 meets the requirements of Article 123 (2) EPC since the amendments are based on paragraphs [0073] and [0086] of EP-A. These paragraphs both relate to the third embodiment of the

invention as shown in figure 4. Further, the "hollow cylindrical portion" is a common feature in all the embodiments of the invention independently and regardless of the specific disposition of the "hollow cylindrical portion" according to each specific embodiment. Thus, the "hollow cylindrical portion" stands in no particular functional relation to its location within the casing of the air conditioner. Consequently, the isolation of said features from the context of paragraphs [0073], [0086] in EP-A and their introduction into claim 1 by way of amendment does not lead to an extension of the content of the application as filed.

Claim 1 of subsidiary request 4 does not offend against Article 123 (2) EPC. It is notably added to the arguments presented in respect of claim 1 of the main request that the replacement of "steering member" with "steering member support part" cannot lead to the mentioned contravention given that, in view of the wording of the claim, the "steering member" itself, or likewise "the steering member support part", does not explicitly form part of the claimed subject-matter.

Claim 1 of subsidiary request 5 should be admitted to the appeal proceedings notwithstanding the fact that it was filed at a late stage of the proceedings. This request could not have been submitted earlier since there appeared to be no necessity for such a request. Indeed, the Appellant relied on the fact that the mentioned replacement of "steering member" by "steering member support part", which had been suggested by the Examining Division, would comply with the requirements of Article 123 (2) EPC.

IV. The Respondents' arguments may be summarized as follows:

Claim 1 of the main request does not meet the requirements of Article 123 (2) EPC. The replacement of "steering member" with "steering member support part" constitutes an extension of the content of the application as filed. There is no basis for this amendment in EP-A given that throughout its description and claims the constructional element referred to in the figures with the reference sign "S" is constantly and consistently designated by the term "steering member". The illustration of said constructional element "S" in the figures, showing in particular a circular cross section, is by no means sufficient to provide a basis for said amendment and likewise to give a clear and unambiguous indication of what should be actually intended by a "steering member support part". Furthermore, the amended wording of claim 1, and in particular aforesaid feature (i), omits "blowing means", "heating means", "cooling means" and "air-distributing means", thus defining an automotive air conditioner which does not correspond to any disclosed embodiment. The omitted features are necessary and essential to allow proper functioning of the air conditioner and to define the closest prior art constituting the starting point of the invention in conjunction with its related technical problem which the invention sets off to solve. These omissions again infringe Article 123 (2) EPC.

The above arguments similarly apply to claim 1 of subsidiary requests 1 and 2.

Claim 1 of subsidiary request 3 does not comply with Art. 123 (2) EPC. The amendment implying the aforesaid replacement of features (see above) has no basis in EP-A. Further, the features introduced by way of amendment belong to different embodiments of the invention as set out in paragraphs [0073] and [0086] of EP-A and such a combination of different embodiments is not allowed. Moreover, the feature "hollow cylindrical portion" has been arbitrarily isolated from its context, as illustrated for instance by paragraph [0073], where the specific disposition of said hollow cylindrical portion is disclosed.

Claim 1 of subsidiary request 4 does not fulfil the requirements of Art. 123 (2) EPC due to the replacement of "steering member" with "steering member support part". Further to the above mentioned arguments (see claim 1 of the main request) it is also pointed out that, contrarily to the Appellant's view, the interpretation of the disputed feature "steering member support part" directly affects the subject-matter of claim 1 since the corresponding "steering member support part accommodating portion", which evidently forms part of the claimed subject-matter, has to conform to said "steering member support part".

Claim 1 of subsidiary request 5 should not be admitted to the appeal proceedings since it was late filed. The replacement of "steering member" with "steering member support part" was objected to on the grounds of Article 123 (2) EPC right from the outset of the Opposition proceedings. Therefore the Appellant had enough time and sufficient reasons to file a subsidiary request addressing this issue considering that the outcome of

the decision of the Board was open and the revocation of the patent was possible. Moreover the amendments introduced into claim 1 lead to an infringement of the requirements of Articles 123 (2) and (3) EPC.

Reasons for the decision

1. The Respondents did not make any further submissions during the oral proceedings concerning the request put forward in writing (see letter dated 18 February 2009) that the appeal be held as inadmissible on the grounds that the reasoning in the statement of grounds of appeal is insufficient.
The Board considers that the appeal is admissible since a causal link can be established between the reasons given in the decision (Reasons, 13, 13.1) and the requests submitted with the statement of grounds of appeal. In claim 1 of the main request, for instance, the term "at least one of" has been removed and the subsequent features, including a list of components of the air conditioner, have been amended, both these aspects being identified in the decision (Reasons, 13, 13.1) as being the origin of the non-compliance with Article 83 EPC. Therefore the amendments filed with the statement of grounds of appeal bear an evident link to the reasoning of the contested decision in accordance with Article 108, third sentence, EPC.

2. Claim 1 of the main request and claim 1 of subsidiary requests 1 to 4 infringes Article 123 (2) EPC since the replacement of "steering member" by "steering member support part" goes beyond the content of the application as originally filed. This replacement,

contrary to the Appellant's allegations, cannot be regarded as being equivalent to the correction of an obvious error, since this could only hold true if it were obvious that an error had occurred and what the correction should be. This is however not the case here, for said "steering member" designated with the reference sign "S" is not described in sufficient detail in the description and the drawings alike. In particular, any specific functional feature attributed to said "steering member" and disclosing the nature of said constructional element "S" is completely missing in the description of EP-A. On the other hand, figure 1 and figures 22 to 24 disclose a constructional element "S" having a cylindrical form and a limited transversal extension, however no definite conclusion being derivable from these drawings as to the functional features and the nature of said constructional element "S" (see also description of EP-A, paragraphs [0150], [0153], [0154] and [0155]). It should be borne in mind that the standard of proof to be applied here is that of a clear and unambiguous disclosure. The further figures 2-21 and 25-29 of EP-A constantly and consistently illustrate only a circular cross section of said "steering member". Hence, even if it were assumed that an error had occurred, the drawings and the description alike do not render unmistakably clear and unambiguous which technical function and technical designation should be attributed to said constructional element "S", which was allegedly wrongly designated as "steering member". Under these circumstances the replacement of "steering member" by "steering member support part" is no more than a mere guess. Finally, the nature of the "steering member" and its functional features are indeed relevant to the claimed subject-

matter, contrary to the Appellant's allegations, given that the "steering member-accommodating portion" (or "steering member support part-accommodating portion") is clearly included in the claimed subject-matter and is defined by means of said "steering member".

In addition, the term "steering member support part" is of a very broad and general nature. An amendment of this kind implying such a broad definition appears to be not justified in the absence of any hint or indication in the description and in view of the drawings of EP-A, which merely illustrate a constructional element "S" having the aforementioned specific geometric shape. Thus, said replacement of "steering member" by "steering member support part" in claim 1 also appears to imply a generalization, given that it does not take into proper account the explicit form and configuration of said constructional element "S" illustrated in the figures.

3. The Board further considers that claim 1 of the main request and claim 1 of subsidiary requests 1 and 2 present additional deficiencies leading likewise to a contravention of Article 123 (2) EPC. Specifically, the aforesaid feature (i) (see point III above), which omits "blowing means", "heating means", "cooling means" and "air distributing means", defines, in combination with the remaining features of claim 1, an automotive air conditioner which is not disclosed in any embodiment of the invention. In effect, claim 1 of said requests is directed to an automotive air conditioner comprising said feature (i) and further comprising features extracted from specific embodiments of the description of EP-A (or EP-B) (see for instance "hollow

cylindrical portion"), in which embodiments however, contrary to said feature (i), "blowing means", "heating means", "cooling means" and "air-distributing means" are present. Therefore the resulting subject-matter extends beyond the content of the application as filed.

4. The Board did not deem the Appellant's subsidiary request 5 filed during the oral proceedings to be admissible. The Appellant had sufficient time to prepare an appropriate subsidiary request in the event that the Board would consider the aforementioned amendments (see point 2: replacement of "steering member" by "steering member support part") not to be acceptable under Article 123 (2) EPC, particularly since this ground of opposition was put forward already with the filing of the opposition. The Appellant likewise cannot rely on the fact that the amendment was originally proposed by the Examining Division, for any amendment to the claims is in the responsibility of the Applicant which in the present case had to decide whether or not to accept the proposed amendment. Finally, claim 1 of subsidiary request 5 prima facie appears to contravene Article 123 (3) EPC on the grounds that the replacement of "steering member support part" by "steering member" broadens the scope of protection. For these reasons the Board decided to exercise its discretionary power (Article 13 (1) RPBA (Rules of procedure of the Boards of appeal)) not to admit subsidiary request 5 to the appeal proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registry: The Chairman:

A. Vottner G. Pricolo