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**Datasheet for the decision
of 31 January 2012**

Case Number: T 0549/09 - 3.2.01
Application Number: 02009045.2
Publication Number: 1232912
IPC: B60R 13/02, B60R 21/20
Language of the proceedings: EN

Title of invention:

Arrangement and construction of crew protective device for automobile

Patent Proprietors:

Toyota Jidosha Kabushiki Kaisha
TOYODA GOSEI CO., LTD.

Opponent:

Johnson Controls GmbH

Headword:

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Relevant legal provisions:

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Relevant legal provisions (EPC 1973):

EPC Art. 100(c), 111(1)

Keyword:

"Extension beyond the content of the earlier application as filed (no)"
"Remittal to first instance for further prosecution"

Decisions cited:

G 0001/05, G 0001/06, T 0605/93, T 0687/05, T 0873/94,
T 2175/09

Catchword:

-



Case Number: T 0549/09 - 3.2.01

DECISION
of the Technical Board of Appeal 3.2.01
of 31 January 2012

Appellants:
(Patent Proprietors) Toyota Jidosha Kabushiki Kaisha
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and

TOYODA GOSEI CO., LTD.
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Representative: TBK
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Respondent: Johnson Controls GmbH
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Representative: Wolff, Felix
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 22 December 2008
revoking European patent No. 1232912 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: G. Pricolo
Members: W. Marx
T. Karamanli

Summary of Facts and Submissions

- I. On 27 February 2009 the Appellants (Patent Proprietors) lodged an appeal against the decision of the Opposition Division posted on 22 December 2008 on the revocation of the European patent No. 1 232 912 and paid the appeal fee. The patent in suit was filed as divisional application No. 02009045.2 to the parent European patent application No. 97909735.9, the latter being based on international application PCT/JP/97/04006, published as WO-A-98/19893 and the translation thereof as EP-A-0 872 390. The statement setting out the grounds of appeal was received on 29 April 2009.

In its decision the Opposition Division held that the subject-matter of claim 1 as granted extended beyond the content of the parent application as originally filed because of the presence of the feature "boundary portion". Furthermore, auxiliary requests 1 to 3 contained the same undisclosed feature so that the patent could not be maintained in amended form.

- II. In the oral proceedings, held on 31 January 2012, the Appellants requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, in the alternative, that the patent be maintained in amended form in accordance with one of the first to third auxiliary requests, all filed with the statement of grounds of appeal, or the fourth and fifth auxiliary requests, both filed with letter dated 8 December 2011.

The Respondent (Opponent) requested that the appeal be dismissed.

III. Claim 1 as granted according to the main request reads as follows:

"An automotive vehicle protection apparatus for an automotive vehicle having an interior compartment, a pillar portion (20), a vehicle body side portion, and a roof side rail (28), said apparatus comprising:

- an inflator (14) for jetting gas upon an occurrence of a side collision;
- a bag (16) operatively connected to said inflator (14) so as to expand during jetting of the gas, said bag (16) being housed in a folded state and constructed and arranged to permit placement thereof between the pillar portion (20) and the roof side rail (28) so that expansion occurs beneath the roof side rail and within the interior compartment; **characterized in that** it further comprises
- a pillar garnish (40) including a trim member disposable at an inner side of the pillar portion (20) and extending in a longitudinal direction by a sufficient length to cover at least a portion of said bag (16) in the folded state; and
- a deformable member hingedly connected to said pillar garnish (40) and provided in the vicinity of said bag (16), said deformable member being (i) formed of a portion of said pillar garnish (40) and (ii) configured to form an opening for expansion of said bag (16) without braking or scattering said pillar garnish (40);
- wherein the deformable member includes an unhinged end portion positioned in the vicinity of the vehicle body side portion, the unhinged end portion moving

- away from the vehicle body side portion when the bag starts to expand;
- wherein said pillar garnish (40) covers a vehicle front side of said pillar portion (20) and is formed by a vehicle front side support portion (42), which is disposed at a vehicle front side and is supported by the pillar portion, and an unfolding portion (42B), which is disposed at a vehicle rear side and covers said bag (16) and has one end continuous with said support portion and another end which is a free end, and
 - a boundary portion between the support portion and the unfolding portion becomes a hinge (46) for the unfolding portion when the bag expands, and the bag expands from a portion between the free end and the pillar portion;
 - wherein said bag (16) is disposed in a space (48) substantially defined by the unfolding portion (42B) and the pillar portion (20)."

IV. The Appellants' arguments may be summarised as follows:

Acknowledging that the term "boundary portion" was not literally disclosed in the parent application as filed, said term had to be construed in the light of the description and the drawings.

The term "portion" defined a part (or synonymous with that: a piece, an area, a region) having a certain extension in three dimensions, not a one-dimensional line or limit. The attributive term "boundary" was used to describe where this portion was situated, defined in claim 1 as granted by "between the support portion and the unfolding portion"; the "support portion"

corresponded to the "base portion 42A" as described in paragraph [0074] of the patent in suit, as agreed by the Opposition Division, and the "unfolding portion" corresponded to the "bag housing portion 42B". Therefore, the term "boundary portion" specified a portion which was situated in the area **between** two other portions or regions. With paragraph [0074] of the patent referring to a "connecting portion between the base portion 42A and the bag housing portion 42B", the "boundary portion" as claimed corresponded to said "connecting portion". The corresponding passages in the parent application as filed were to be found on page 32 and also on pages 36 to 37. The term "boundary portion", however, did not provide any quantitative information as to the extension of the boundary portion or the distance between the support portion and the unfolding portion.

Moreover, paragraph [0074] of the patent in suit described the connecting portion as a "rigidity-suddenly-changing portion", e.g. a portion between the base portion 42A having a high rigidity and the bag housing portion 42B having a lower rigidity, as described for the first embodiment (see paragraph [0073]). Thus the term "boundary portion" provided a distinction with regard to rigidity and such kind of regions were disclosed in the described embodiments as portion 46 in Fig. 1, portion 64 in Fig. 5, portion 70 in Fig. 6, portion 84 in Fig. 7 and portion 97 in Fig. 8.

Hence, the term "boundary portion" corresponded to the "intermediate portion" as disclosed on page 5 of the originally filed description of the parent application, in particular since the term "intermediate" implied that the respective portion was arranged between two other

portions, and since the skilled person understood "intermediate" as something having a more or less smooth change of material characteristics.

After all, claim 1 of the patent specified that the "boundary portion ... becomes a hinge (46) for the unfolding portion when the bag expands", thereby describing the function of the boundary portion. In this respect, the skilled person would know that any kind of technical "hinge" included a three-dimensional extension and could not be represented by a clear limit line.

Since the embodiments depicted in Fig. 9 or Fig. 10 of the patent specification did not show a transitional region having a certain extension between portions of different rigidity, said embodiments were outside the scope of claim 1 and should have been deleted.

What was more, before specifying the feature of a "boundary portion", granted claim 1 defined that the "unfolding portion (42B) ... has one end **continuous** with said support portion". With respect to the embodiment according to Fig. 9, the patent clearly described (paragraph [0102]) that a base member comprising a hard member and a soft member was separated at a portion corresponding to a hinge, without mentioning any "connecting portion". As to the embodiment according to Fig. 10, although mentioning a "connecting portion", a slight gap was formed between the base portion and the bag housing portion so that said embodiment did not fall under the scope of granted claim 1.

The case should be remitted to the Opposition Division for further prosecution because the allowability of

several further contested features as well as novelty and inventive step of claim 1 as granted had not yet been discussed.

V. The arguments of the Respondent may be summarised as follows:

The feature "boundary portion" was not originally disclosed and not interchangeable with "intermediate portion", in particular because a "boundary portion" defined a clear limit between two regions whereas an "intermediate portion" related to a region of changing material characteristics having a certain extension so that said region became a hinge.

Assuming that the term "boundary portion" was construed as meaning "connecting portion", which excluded the embodiments according to Fig. 9 or 10 of the patent in suit, as argued by the Appellants, said interpretation was not directly and unambiguously derivable from the original application documents. In particular, the term "connecting portion" was also mentioned with respect to the fourth embodiment according to Fig. 8 or 9 of the patent in suit (paragraph [0098]) or with respect to the fifth embodiment according to Fig. 10 (see paragraph [0104] of the patent in suit). Therefore, a "connecting portion" also existed when the support portion and the unfolding portion were separated from each other. Moreover, with respect to the embodiment according to Fig. 9, it was disclosed in the description (see paragraph [0102] of the patent in suit or page 43 of the earlier parent application as filed) that the "hard member 104 and the soft member 106 are integrally formed by an adhesive (not shown) or the like", meaning that

the hard and the soft members were connected and therefore continuous with each other.

Since the term "boundary" denoted a limit, the term "boundary portion" had to be construed as meaning an unextended limit or a limit area having, at the most, a small extension. The skilled person, not adhering strictly to the wording of the original disclosure, would take into account at least the idea of the invention and therefore assume only a small limit area and not a transitional region. Such kind of limit area was shown in the patent in suit by the adhesive in Fig. 9 or the gap in Fig. 10.

Therefore, at least the embodiment according to Fig. 9, which also showed two members connected to each other ("integrally formed"), showed the disputed features of a boundary portion between the support portion and the unfolding portion continuous with each other.

A remittal of the case to the first instance appeared appropriate if the finding of the Opposition Division on granted claim 1 was considered by the Board as incorrect.

Reasons for the Decision

1. The appeal is admissible.
2. Main request (patent as granted)

In the Board's view, the presence of the term "boundary portion" in claim 1 does not result in subject-matter extending beyond the content of the originally filed parent application so that, in this respect, the ground for opposition based on Article 100(c) EPC 1973 does not prejudice the maintenance of the European patent.

- 2.1 When the amendments examined as to their admissibility under Article 100(c) EPC 1973 concern a divisional application, these may not extend beyond the content of the "earlier application as filed".

In the present case, in which the application documents of the earlier European patent application as filed are a translation of an international application filed in Japanese, the content of the "earlier application as filed" is that of the international application as it was filed (published as international application WO-A-98/19893). It is assumed that the translated application documents of the earlier application filed upon entry into the regional phase before the EPO as well as the published earlier European application, EP-A-0 872 390, are identical in content to the published international application (see also T 605/93, point 3.1 of the Reasons). This was not contested. Therefore, in the following, reference is made to the translation of the earlier application filed upon entry

into the regional phase before the EPO, unless stated otherwise.

However, it has been noted that the translated set of claims of the above translation comprises claims 25 to 29, which were added during the international phase and must therefore be disregarded for the purpose of Article 100(c) EPÜ 1973.

- 2.2 According to the established case law the findings of the Enlarged Board of Appeal in G 1/05 (OJ EPO 2008, 271) and G 1/06 (OJ EPO 2008, 307), although made with regard to European patent applications, are also valid for European patents granted in respect of a divisional application (see decision T 687/05, which was followed by several decisions e.g. T 2175/09). The Board agrees with the statement in T 687/05 that in order to meet the requirements of Article 100(c) EPC 1973, it is a necessary and sufficient condition that anything disclosed in the granted patent must be directly and unambiguously derivable from not only the application on which the patent has been granted but also from what is disclosed in each of the preceding applications as filed (see point 3.1 of the Reasons). Moreover, it is the total information content of the original application as filed that matters (see T 873/94, OJ EPO 1997, 456) and, in the Board's view, the same applies to the earlier application as filed. In other words, when taking into account the total information content of the earlier application as filed, the content of the earlier application is established on the basis of the description, claims, and drawings.

2.3 If the above requirements are not met, the ground for opposition according to Article 100(c) EPC 1973 prejudices the maintenance of the European patent. In the present case, it is not disputed that the originally filed European patent application on which the patent in suit was granted discloses the term "boundary portion" of granted claim 1. However, the Respondent contested that said term is disclosed in the originally filed parent application.

2.4 In the present case, the term "boundary portion", in particular the term "boundary", is not literally disclosed in the earlier application as filed. What is disclosed is the term "intermediate portion" (see page 5, lines 5 to 6 of the earlier application). "Boundary portion" is however different from "intermediate portion":
Claim 1 defines a "boundary portion between the support portion and the unfolding portion". Since the "portion between the support portion and the unfolding portion" already corresponds to an "intermediate portion", for the skilled reader the further attribute "boundary" clearly implies a further limitation.

2.5 The attribute "boundary" must be seen in the context in which it is used in granted claim 1 when it is being considered whether the claimed subject-matter extends beyond the disclosure of the earlier application as filed. First of all, claim 1 defines a "boundary portion **between** the support portion and the unfolding portion", which means that the boundary portion is situated between two other portions. In addition, prior to this, claim 1 specifies that the "unfolding portion (42B) ... has one end **continuous** with said support

portion", which means that the support portion and the unfolding portion are not separated but connected to each other. As a consequence, the "boundary portion" defined in this context corresponds to a portion between (i.e. "intermediate") two adjacent portions (i.e. between the "support portion" and "unfolding portion") that are connected to each other. Thus, the "boundary portion" can only itself be continuous with the adjacent portions.

As disclosed in the earlier application as filed (see page 5, lines 5 to 6), the unfolding portion is "capable of unfolding around the intermediate portion". Therefore, an unfolding portion adjacent to an intermediate portion is disclosed. And as agreed by the Opposition Division and not contested by the parties, a "support portion" is originally disclosed as well, the support portion corresponding to the "base portion 42A" and the unfolding portion corresponding to the "bag housing portion 42B" as described on page 32 of the earlier application. In addition, said parent application discloses on page 32, line 24 to page 33, line 5 that a "connecting portion between the base portion 42A and the bag housing portion 42B ... is a hinge portion 46 when the bag housing portion 42B unfolds". From this it follows that there is a basis in the earlier application for "an intermediate portion connecting the support portion and the unfolding portion". Such intermediate portion is also visible in the embodiments according to Fig. 1 or Figures 4 to 8, where the support portion and the unfolding portion are formed as one piece showing a transitional region in between them. Since said connecting portion is further specified to be a hinge portion, it is also clear for

the skilled person that the connecting portion has an extension in three dimensions, in particular since any technical "hinge" is not represented by a pure limit line but relates to an object having an extension in three dimensions.

It remains to be discussed whether the earlier application provides a basis for the attributive term "boundary" used in this context and not literally disclosed:

The earlier application as filed describes the connecting portion (see page 32, lines 24 to 26) as a "rigidity-suddenly-changing portion formed in the middle portion", e.g. a portion between the base portion 42A having a high rigidity and the bag housing portion 42B having a lower rigidity as described with regard to the first embodiment (see page 32, lines 12 to 19; portion 46 in Fig. 1), but also in relation to further embodiments (portion 64 in Fig. 5, portion 70 in Fig. 6, portion 84 in Fig. 7, portion 97 in Fig. 8). Therefore, the parent application discloses that the connecting portion is a region which separates two portions of different rigidity, i.e. of different material characteristics.

In the Board's view, a region or portion which separates two adjacent portions of different material characteristics constitutes a "boundary" in respect of these material characteristics. What is more, a "boundary" in the general meaning of the term serves to "indicate the bounds or limits of anything whether material or immaterial" (see Oxford English Dictionary), i.e. not only relating to geometrical or geographical limits but also applicable e.g. to a change in material

characteristics (such as stiffness, rigidity, material composition). Therefore, a region separating adjacent regions of different material characteristics can be qualified by using the attributive term or qualifier "boundary". In this sense, the "portion between the support portion and the unfolding portion" as defined in granted claim 1 is a boundary for the support portion (having a high rigidity) as well as for the unfolding portion (having a low rigidity) in respect of their material characteristics.

Since a "boundary portion" intended as a portion between two adjacent portions and itself continuous with said adjacent portion can only be an intermediate portion connecting two adjacent portions having different material characteristics and since this is disclosed in the earlier application as filed, the Board concludes that the subject-matter of claim 1 does not extend beyond the original disclosure of the earlier application.

- 2.6 Contrary to the argument of the Respondent, the combined feature "boundary portion" must relate to a region extending in three dimensions and not to a clear limit in terms of a one-dimensional limit line or a two-dimensional area between two portions extending in three dimensions. On the one hand, in the contested patent the term "portion" is always used in conjunction with a three-dimensional object (in the present case: a pillar garnish formed by a support portion and an unfolding portion) and therefore defines a region having a certain extension in three dimensions, and this interpretation also holds true when the attributive term "boundary" is added. On the other hand,

claim 1 of the granted patent defines the function of the "boundary portion" that "becomes a hinge (46) for the unfolding portion when the bag expands". For the skilled person a technical "hinge" has a three-dimensional extension and is not represented by a clear limit line as argued by the Respondent.

It is agreed that the term "boundary portion" is not synonymous with the terms "intermediate portion" or "connecting portion", which are originally disclosed. The attributive term "boundary" provides a further restriction in respect of said intermediate or connecting portion, specifying a limiting characteristic of said intermediate portion. And in this respect the earlier application as filed provides a basis for such kind of limiting characteristic of the intermediate portion, disclosing in fact a change in material characteristics with regard to the adjacent portions, as explained above.

- 2.7 The Respondent further argued that the fact that the term "boundary portion" was not directly and unambiguously derivable from the original parent application documents could also be inferred from the diverging opinions of the Appellants and the Respondent on whether the embodiments according to Fig. 9 and 10 of the patent in suit had to be excluded since in these embodiments the support portion and the unfolding portion were separated from each other whereas the "boundary portion" as claimed was required to be a "connecting portion".

However, the fact that embodiments are not covered by the claims does not necessarily imply that the claimed

subject-matter was not disclosed in the original parent application documents. As argued above, claim 1 as granted defines a boundary portion being, on the one hand, an intermediate region between two adjacent portions (i.e. the support portion and the unfolding portion), and being, on the other hand, continuous with said two adjacent portions, the attribute "boundary" implying that the boundary portion forms a limit with respect to the material characteristics of the two adjacent portions.

The term "connecting portion" is indeed mentioned with respect to the fifth embodiment according to Fig. 10 (see paragraph [0104] of the patent in suit), but there the connecting portion refers to the region where a slight gap is formed between the base portion 114 and the bag housing portion 116 and which is used as a hinge 118. As indicated in Fig. 10, said hinge 118 belongs to the outer skin 44 that **covers** and connects the base portion and the bag housing portion. However, said "connecting portion" does not correspond to a boundary portion between (i.e. "intermediate") two adjacent portions (the base portion and the bag housing portion) and continuous with said two adjacent portions. Accordingly, the embodiment of Fig. 10 does not fall under the wording of granted claim 1.

The term "connecting portion" is also mentioned with respect to the fourth embodiment, but only with reference to the example depicted in Fig. 8, whereas Fig. 9 describes a modified example of the fourth embodiment of the patent in suit (see paragraph [0102]). The support portion and the unfolding portion in this modified example (denoted as hard member 104 and soft

member 106 of the base member 102) are explicitly described as being "separated at a portion corresponding to a hinge". The further characterization that "the hard member 104 and the soft member 106 are integrally formed by an adhesive (not shown) or the like" might show that the two portions are connected and continuous in this sense.

- 2.8 Even the embodiment according to Fig. 9 does not justify that, as alleged by the Respondent, the term "boundary portion" had to be construed as meaning an unextended limit or a limit area having, at the most, a small extension, i.e. not relating to a transitional region having a certain extension. On the contrary, all the embodiments depicted in Fig. 1 or Figures 4 to 8 show a region between the support portion and the unfolding portion having a certain extension to provide a transition in material characteristics.

3. The impugned decision to revoke the European patent as granted was based only on the conclusion of the Opposition Division that the term "boundary portion" was not disclosed in the originally filed parent application documents. The Board, however, finds that the feature "boundary portion" of granted claim 1 is disclosed in the earlier application as filed and that, therefore, the subject-matter of claim 1 does not extend beyond the original disclosure of the earlier application (see item 2 above). Consequently, the appealed decision must be set aside.

4. The Board also notes that, in its decision, the Opposition Division - except for the term "support portion" - neither dealt with further features of

granted claim 1 objected by the Opponent as having no basis in the original disclosure of the parent application, nor considered the grounds for opposition under Article 100(a) EPC 1973 raised in the notice of opposition.

For these reasons, and since this was agreed upon by the parties during the oral proceedings before the Board, the Board considers it appropriate to remit the case to the department of the first instance for further prosecution in accordance with Article 111(1), second sentence, EPC 1973.

Order

For these reasons it is decided that:

1. The appealed decision is set aside.
2. The case is remitted to the first-instance department for further prosecution.

The Registrar:

The Chairman:

A. Vottner

G. Pricolo