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**Datasheet for the decision
of 16 April 2012**

Case Number: T 1853/10 - 3.2.08
Application Number: 04718426.2
Publication Number: 1607658
IPC: F16H 25/22, F16H 25/24
Language of the proceedings: EN

Title of invention:
Ball screw device

Applicant:
NSK Ltd.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 113(2), 122(1)
EPC R. 100(1), 111(2), 136(1)(2)(3), 137(3)(4)
RPBA Art. 11

Relevant legal provisions (EPC 1973):
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Keyword:
"Request for re-establishment of rights (granted)"
"Substantial procedural violation (decision not reasoned)"

Decisions cited:
-

Catchword:
-



Case Number: T 1853/10 - 3.2.08

D E C I S I O N
of the Technical Board of Appeal 3.2.08
of 16 April 2012

Appellant:
(Applicant)

NSK Ltd.
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 19 March 2010
refusing European patent application
No. 04718426.2 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: M. Alvazzi Delfrate
A. Pignatelli

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the examining division, posted on 19 March 2010, to refuse European patent application No. 04 718 426.2. The appeal was filed on 18 May 2010, and the appeal fee was paid on the same day.
- II. Together with communication posted on 14 September 2010 the appellant was informed that its appeal was expected to be rejected as inadmissible, because the statement of grounds for appeal had not been filed.
- III. The statement of grounds for appeal was filed on 11 November 2010, together with a reasoned request for re-establishment of rights. The fee for the request for re-establishment was paid on the same day.
- IV. The appellant requested that the decision under appeal be set aside and implicitly that a patent be granted on the basis of claim 1 as filed with the statement of grounds. As a precautionary measure it requested oral proceedings.
- V. Claim 1 reads as follows:

"A ball screw device (10) comprising a screw shaft (12) having a spiral thread groove (11) at an outer circumferential surface, a nut screw (14) coupled with the screw shaft (12) and having a thread groove (13) corresponding to the thread groove (11) of the screw shaft (12) at an inner circumferential surface as well as a ball return passage (16) extending in the axial direction of the nut screw and a recess (17) at each

end to which the end of the ball return passage (16) opens, a circulation block (18) fitted and secured to the recess (17) of the nut (14) for forming together with the recess (17) a ball circulation passage (21) that communicates with both of the thread grooves (11,13) with the ball return passage (16), and a plurality of balls (15) for circulating while rolling through both of the thread grooves (11, 13), the ball circulation passage (21), and the ball return passage (16), characterised in that an axially facing surface of the recess (17) is used as a ball running surface (23), a ball circulation groove (20) is formed at a portion of the circulation block (18) opposing to the ball running surface (23), and the ball circulation passage (21) is formed by the ball circulation groove (20) and the ball running surface (23), wherein the circulation block (18) comprises a block main body (18a) having the ball circulation groove (20) for forming together with the recess (17) the ball circulation passage (21) and a scoop-up portion (18b) for scooping up the balls rolling between both of the thread grooves (11, 13) to the ball circulation passage (21), in which the scoop-up portion and the block main body are formed as separate members, and wherein the recess (17) has a concave portion (25) fitted with a protrusion (24) in the axially facing surface for fixing the scoop-up portion (18b) of the circulation block (18)."

Reasons for the Decision

1. The request for re-establishment of rights is allowed. Therefore, the appeal is admissible.

The formal conditions for the request established under Article 122(1) together with Rule 136(1) (2) and (3) EPC are fulfilled. The request is therefore admissible.

The request is also allowable. The Board holds that the applicant is to have his rights re-established because he was not able to observe the time limit for filing the statement of grounds of appeal in spite of all due care required by the circumstances having been taken.

The applicant has submitted in a plausible manner that the time limit was missed due to an isolated mistake within a satisfactory system and that the person charged with the checking of the time limits is a very reliable and experienced person. The non-observance of the time limit was the result of a combination of unusual circumstances that were not due to negligence.

When an isolated mistake happens within a normally satisfactory system, the consistent jurisprudence of the boards of appeal considers that all due care has been taken and re-establishment is possible (cf. Case Law of the Boards of Appeal, 6th edition 2010, VI.E.7.3.3). The Board follows this jurisprudence.

2. The decision under appeal is to be set aside due to a substantial procedural violation, since it was not reasoned. The purpose of appeal proceedings is mainly to give a party adversely affected by a decision of the

first instance the possibility of challenging the decision on its merits. For this purpose and in order for the board of appeal to be able to examine whether the decision was justified or not, a decision open to appeal must be reasoned, as required by Rule 111(2) EPC. To satisfy this requirement the decision must contain, in logical sequence, those arguments which justify its tenor without the need for the board to speculate as to the possible reasons of the decision (see Case Law of the Boards of Appeal of the EPO, 6th edition 2010, VI.J.5.3.4, page 611, third full paragraph).

- 2.1 The decision under appeal was based upon the text of the application as submitted with the requests filed on 10 February 2010. According to point "4. Conclusion" of the appealed decision the application in suit was refused because it did not meet the requirements of Article 113(2) since it did not fulfil the conditions set up under Rule 137(4) EPC as then in force (in the version according to the Implementing Regulations to the Convention on the Grant of European Patents as adopted by decision of the Administrative Council of the European Patent Organisation of 7 December 2006) and therefore the Examining Division found that no claim version was filed on which it could base its decision.

No other reasons for the refusal are given in the decision under appeal. Under point "5. Further remarks" the decision also comprises some remarks concerning a possible objection under Article 123(2) EPC, of which no trace can be found in the written proceedings or in the minutes of the oral proceedings. However, those remarks are placed after the reasons for the decision

and the conclusion therefrom (see points "3. Reasons for the decision" and "4. Conclusion"). Moreover, they do not positively state that the amendments contravene Article 123(2) EPC, but merely that the application "would still seem to contravene it". Therefore, there is no doubt that said remarks do not form part of the reasons of the appealed decision but constitute merely an obiter dictum.

2.2 According to Article 113(2) EPC the European Patent Office shall examine, and decide upon, the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant or the proprietor of the patent.

In the present case the applicant had submitted with letter dated 10 February 2010 a main and an auxiliary request. There is no trace of a withdrawal of these requests during the examination proceedings. Nor does the decision state that they were not admitted into the examination proceedings. On the contrary, point "2.2 Decisive text of the application documents" states that the decision is based upon the application in the text submitted by the applicant and makes reference to said main and auxiliary requests. Indeed, a substantive examination of these requests was carried out and they were found to comprise amendments contrary to Rule 137(4) EPC (see minutes of the oral proceedings before the examining division and point 3.2 of the decision under appeal)

It is true that under point 3.3 of the "Reasons for the decision" it is stated that, since the amendments did not comply with Rule 137(4) EPC, they could not be

"allowed" into the procedure. However, the provisions of Rule 137(4) as then in force pertain to the substance of the amendments and not to their admissibility. As a consequence, they cannot justify the non admission of a request into the proceedings.

Therefore, the legal basis underlying the appealed decision cannot be seen in Article 113(2) EPC but only in a lack of compliance of the amendments with Rule 137(4) EPC.

- 2.3 According to Rule 137(4) EPC in the version then in force amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept. Therefore, a reasoned objection under this Rule should explain not only why the subject-matter was not searched but also why it does not combine with the originally claimed invention or group of inventions to form a single general inventive concept.

In the present case the decision under appeal explains that some of the features of claim 1 are derived from originally filed claim 2, which was not searched. It fails, however, to provide any reason as to why present claim 1 would not combine with the originally claimed invention or group of inventions to form a single general inventive concept.

The sentence on page 6 stating that the subject-matter of original claim 2 was not unitary with the present invention does not provide any help in this matter. First of all it does not provide any reason for the

alleged lack of unity but merely refers to the first communication, dated 8 August 2008, which is not part of the decision. Moreover, it refers to an alleged lack of unity between the presently claimed invention and originally filed claim 2, while the matter to be considered for the purpose of Rule 137(4) EPC as then in force is the unity of invention between the presently claimed subject-matter and the originally claimed invention or group of inventions, in particular the invention searched in the supplementary search report, i.e. originally filed claims 1 and 5.

The communication of the EPO dated 8 August 2008 cannot provide said reasoning either, since none of the claims considered in it corresponds to present claim 1. An attempt to infer said reasoning from the objection of lack of unity presented in said communication (see pages 1 to 3) is also doomed to fail. According to said objection the searched invention, corresponding to originally filed claims 1 and 5, was characterised by the special technical features of a ball circulation groove formed at a portion of the circulation block opposing to the ball running surface. Since these special technical features are also present in claim 1 of both requests underlying the appealed decision it cannot be understood how it may be considered that the subject-matter of those claims is not unitary with the originally claimed subject-matter.

Therefore, the decision under appeal is not reasoned.

3. The absence of reasoning in the appealed decision amounts to a substantial procedural violation. Such a procedural violation requires, in line with Article 11

RPBA (Supplement to OJ EPO 1/2012, page 39), that the decision under appeal be set aside and the case remitted to the first instance.

4. The appeal is allowable. Although the appellant has not requested reimbursement of the appeal fee, the board considers it to be equitable to reimburse the fee by reason of the substantial procedural violation that occurred.

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 for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

V. Commare

T. Kriner