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Aktenzeichen / Case Number / N<sup>o</sup> du recours : T 249/84

Anmeldenummer / Filing No / N<sup>o</sup> de la demande : 81 200 792.0

Publikations-Nr. / Publication No / N<sup>o</sup> de la publication : 0 045 988

Bezeichnung der Erfindung: Extendible airfoil track assembly

Title of invention:

Titre de l'invention :

## ENTSCHEIDUNG / DECISION

vom / of / du 21 January 1985

Anmelder/Patentinhaber:

Applicant/Proprietor of the patent:

The Boeing Company

Demandeur/Titulaire du brevet :

Stichwort / Headword / Référence :

Extendible airfoil track assembly

EPÜ / EPC / CBE

Art. 56, 52(1)

Rule 67, 68(2)

"Inventive Step" "Independent Claim"

"Reimbursement of the appeal fee"

Leitsatz / Headnote / Sommaire

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number: T 249 / 84

**DECISION**  
**of the Technical Board of Appeal 3.2.1**  
**of 21 January 1985**

**Appellant:**

The Boeing Company  
P.O. Box 3707  
Seattle Washington 98124 (US)

**Representative:**

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**Decision under appeal:**

Decision of Examining Division 70  
Office dated 22 May 1984  
application No 81 200 792.0  
EPC

of the European Patent  
refusing European patent  
pursuant to Article 97(1)

**Composition of the Board:**

Chairman: G. Andersson

Member: P. Ford

Member: K. Schügerl

Summary of facts and submissions

- I. European patent application No. 81 200 792.0, filed on 8 July 1981 and published on 17 February 1982 (publication number 0 045 988) was refused by Decision of the Examining Division 070 dated 22 May 1984.
- II. The decision was based on claims 1 to 4 submitted on 17 August 1982, Claims 1 and 4 reading:
1. Mechanism for extending a high-lift device such as an auxiliary airfoil relative to a main airfoil, comprising a carrier track connected to said high-lift device, extending substantially chordwise of said main airfoil and comprising toothed section, guide means secured to said main airfoil and being in guiding contact with said track for support thereof, and a pinion gear adapted to gear in meshing engagement with said toothed section for extending and retracting the high-lift device, characterized in that the carrier track has an inverted U-shaped cross-section forming a channel along the length thereof, and in that the toothed section is formed by a separate gear rack, mounted within said track channel with its gear teeth facing downwardly.
4. Mechanism according to one of the preceding claims, characterized in that the gear rack is formed by a series of rollers mounted between the interior side walls of said track channel and having their axes transverse thereto.
- III. The reason given for the refusal was that the subject matter of the claims did not involve an inventive step having regard to the following documents:

US-A-1 912 428 (1)  
DE-A-643 682 (2) and  
US-A-2 346 424 (3).

- IV. On 26 May 1984, observations were filed under Article 115 EPC, in which reference is made to US-A-3 089 666 (not cited previously) and to citations (1) and (3).
- V. The appellant lodged an appeal against the decision on 23 July 1984. The appeal fee was duly paid and the statement of grounds was received in good time.
- VI. The appellant requested that the Decision under appeal be set aside, that the case be remitted to the first instance for further prosecution on the basis of amendments to be filed in view of the observations under Article 115 EPC and that the appeal fee be reimbursed.
- VII. The appellant argues that the skilled man, confronted with the problem of overcoming the disadvantages of the device disclosed for instance in (3), would not have come across (1). But even if he had studied (1), he would not be led to the invention because of an inherent incompatibility of the teachings of (1) and (3). The Examining Division applied a wrong criterion in assessing inventive step and acted in defiance of the Guidelines.

#### Reasons for the Decision

1. The appeal complies with Articles 106-108 and Rule 64 EPC and is, therefore, admissible.

2. The appellant's submission that "first it has to be established whether the skilled man would have looked into (1)" fails to recognise a basic principle of the Convention: According to Article 54(2) EPC, the disclosure of any document, published before the priority date of an European Application is included in the state of the art and has from that reason to be taken into account in evaluating inventive step under the provisions of Article 56 EPC. It is therefore impossible to exclude the teachings of any published document from that state of the art in view of an allegedly remote date of publication or an allegedly remote technical field.
3. The document (1) teaches a very special way to stiffen a roller chain - by incorporating it into a slotted tube - so that it may be employed as a sort of rack in combination with a pinion. In its decision the Examining Division held inter alia that claim 4, which is directed to a gear rack, formed by a series of rollers, "is considered by the applicant to be an embodiment within the scope of claim 1" and that also for that reason (1), which is concerned with a series of rollers, can be relied upon against Claim 1.
4. To the last mentioned argument, the Board has the following comments:

The characteristics "the toothed section is formed by a separate gear rack, mounted within" the "track channel" (claim 1) and "the gear rack is formed by a series of rollers mounted between the interior side walls of" the "track channel" (Claim 4) are incompatible. Only if, in the latter case, the rollers were mounted between the

side walls of an U-shaped member and this member, in turn, were mounted within the track channel, could the device be considered as a particular embodiment of the subject-matter of claim 1, although also then it would be hard to see how a "roller" could be regarded as a "gear tooth". It is, however, plainly clear that the last mentioned arrangement is not intended. Thus, Claim 1 has to be construed in conformity with its actual wording and with the particular embodiments shown in Figures 1-7, 9 and 10. It follows then that, in spite of the reference to Claim 1 in Claim 4, the latter is not a dependent claim within the meaning of Rule 29(3) EPC and should therefore be reworded accordingly. Since these two claims are in essence two independent claims, the inventiveness of the subject-matter of Claim 1 has to be assessed without having regard to Claim 4.

5. The gist of the invention as defined in Claim 1, interpreted as set out in para. 4, may be said to reside in a splitting-up of a known element (carrier track with toothed section) into two parts (carrier track proper and separate gear rack): see also original description, page 1, lines 19-31. Now, it can not be seen how the content of (1) could make this splitting-up obvious for the skilled man. Indeed, a chain composed of a large number of parts and necessarily slack, cannot be readily compared with a single-piece toothed gear rack, necessarily rigid; hence, the function of the slotted tube - to provide the necessary stiffness to the chain - is entirely absent in the invention. Thus, the two devices to be compared differ as to the problem and to the solution.

6. By suitable generalisation, features could be attributed to the device shown in (1), which indeed would be "in accordance with the features of the characteristic part of Claim 1" as stated in the decision. But it is not realistic to assume that these generalisations could be found without knowledge of the invention, in other words, without having taken the step toward the invention before. Thus, the apparent anticipation of the characteristics in question can not influence negatively the evaluation of inventiveness. In this connection, reference is also made to the Decision of the Technical Board of Appeal 3.5.1, in Case T 161/82, (Official Journal of the EPO, 1984, 551).
7. For the foregoing reasons, the Board takes the view that, insofar as only document (1) is involved, the obviousness of the subject-matter of Claim 1 is not established. Since on the other hand, the reasoning of the decision relies solely on that document, the decision of the Examining Division has to be set aside.
8. Regarding the allegation of a substantial procedural violation, it must be remembered first that an Appellant cannot raise an alleged neglect of the Guidelines as such - the Guidelines are illustrative, not mandatory in character -, but only insofar as the underlying regulations of the Convention are violated. Second, the Examining Division expressed in its decision the reasons why it was of the opinion that it was obvious to combine the features of the precharacterising portion of Claim 1, derivable from (2) or (3), with the features of the characterising portion, derivable, in its opinion, from (1). Thus, the decision is reasoned (Rule 68(2) EPC) and the Examining Division acted in

conformity with the provisions of Article 97(1) EPC. That the Board does not share the Examining Division's view regarding document (1), does not imply that the decision is marred by a procedural violation. Hence the reimbursement of the appeal fee (Rule 67 EPC) can not be ordered.

9. With respect to the observations made under Article 115 EPC, the Board chooses to remit the case to the Examining division for further prosecution (Article 111(1) EPC) in order to preserve the rights of the applicant to a normal two-tier procedure.

Order

For these reasons

it is decided that

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.
3. The request to reimburse the appeal fee is rejected.

*Sale*  
*PP.*

*Rhe*

*Andersson*