

Veröffentlichung im Amtsblatt	<input checked="" type="checkbox"/> Ja / <input type="checkbox"/> Nein
Publication in the Official Journal	<input checked="" type="checkbox"/> Yes / <input type="checkbox"/> No
Publication au Journal Officiel	<input checked="" type="checkbox"/> Oui / <input type="checkbox"/> Non

Aktenzeichen / Case Number / N° du recours : T 341/86

Anmeldenummer / Filing No / N° de la demande : 82 900 697.2

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 069 951

Bezeichnung der Erfindung: Valve assembly with integral plastic spring

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : B65D 83/14

### ENTSCHEIDUNG / DECISION

vom / of / du 19 October 1987

Anmelder / Applicant / Demandeur : Knickerbocker, Michael, G.

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPO/EPC/CBE Articles 109, 111(1), Rule 86(3) EPC

Kennwort / Keyword / Mot clé : "Substantially amended claims filed with Statement of grounds of appeal" - "Remittal to Examining Division".

Leitsatz / Headnote / Sommaire

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : T 341/86

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.1**  
**of 19 October 1987**

**Appellant :** Knickerbocker, Michael, G.  
6513 Coachlight  
McHenry, Illinois 60050 (US)

**Representative :** Hallam, Arnold Vincent  
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**Decision under appeal :** Decision of Examining Division 082  
of the European Patent Office  
dated 24 April 1986 refusing  
European patent application  
No. 82 900 697.2 pursuant to  
Article 97(1) EPC

**Composition of the Board :**

**Chairman :** P. Delbecque

**Members :** C. Wilson

R. Schulte

## Summary of Facts and Submissions

- I. European patent application No. 82 900 697.2, filed on 12 January 1982 as an international application No. PCT/US 82/0025 and published under the international publication No. WO 82/02533, was refused by a Decision of the Examining Division dated 24 April 1986. The Decision was based on Claims 1 to 8 (including independent Claims 1 and 8) filed on 15 November 1985, representing the second set of new claims filed in response to the communications from the Examining Division of 3 May 1984 and 16 January 1985.

The reason given for the refusal was the same as that given for the unallowability of both the original and the first amended set of claims, namely that the subject-matter of the claims is not patentable in the light of the disclosure of DE-A-2 128 981 having due regard to the provisions of Articles 52, 54 and 56 EPC.

- II. On 23 June 1986, a notice of appeal was filed, and the appeal fee paid. On 19 August 1986 the Appellant filed a Statement of grounds of appeal together with a new set of Claims 1 to 11 (including independent Claims 1, 2, 3 and 11), and requested that the Board of Appeal set aside the impugned decision and grant a patent on the basis of the new set of claims (with such further amendments as may be considered necessary). These claims are limited by the introduction of further characteristics, some of which were only disclosed in the drawings of the application as filed, and not previously claimed. The Statement of grounds of appeal contains various submissions traversing the reasoning of the Decision under appeal.

### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is admissible.
2. The Appellant has made it plain in the Statement of grounds of appeal that he no longer wishes to apply for a European patent containing claims as previously examined and refused by the Examining Division; instead, he wishes to apply for a patent containing an amended set of claims.

An examination of these claims reveals that claims 1, 2 and 3 are amended forms of Claim 1 on which the impugned decision is based. Similarly, Claim 11 is an amended form of Claim 8. These claims have been amended essentially to refer to a recess or peripheral groove formed in the body portion of the valve stem (30) and in which the gasket (18) sealingly engages. The body portion is described as being moveable between two positions, to allow or prevent flow of the aerosol contents depending on whether or not the gasket (18) and the recess are fully engaged. These features can be clearly derived from Figures 1 to 6 of the drawings as originally filed, so that no objection under Article 123(2) EPC arises.

3. However, amendment of the claims of an application at the present stage of examination is a matter of discretion governed by the final sentence of Rule 86(3) EPC, which states "No further amendment may be made without the consent of the Examining Division", that is, no further amendment without such consent after the opportunity to amend in reply to the first communication of the Examining Division has passed.

4. In the present case, the amendments to the claims are substantial insofar as they involve inter alia the introduction into the claims of features not previously claimed and thus not previously commented on by the Examining Division, and also possibly even necessitating a further search; and the introduction of a number of independent claims possibly raising the questions of unity of invention vis-à-vis the originally claimed subject-matter (Article 82) and conciseness of claims (Article 84).
  
5. In a previous Decision of the present Board, T 63/86 (to be published), it was decided that cases in which substantial amendments were proposed on appeal, should be remitted to the Examining Division in order to maintain the applicant's right to appeal to a second instance. As set out in paragraph 2 of that Decision:-

"Once an admissible appeal has been filed, the Board of Appeal has responsibility for the case in place of the Examining Division, and "can exercise any power within the competence of the department which was responsible for the decision appealed" (Article 111(1) EPC). Nevertheless, in a case such as the present, where substantial amendments to the claims have been submitted with the grounds of appeal, in the Board's view there are good reasons why the Board should not, at this stage, exercise the discretionary power under Rule 86(3) EPC in relation to such proposed amendments. The wording of the whole of Rule 86(3) EPC points specifically to the Examining Division. In cases of minor amendments filed during the appeal, it may be appropriate for a Board of Appeal to exercise the discretion of the Examining Division under Rule 86(3) EPC. However, in a case such as the present, where substantial amendments have been proposed which require a substantial further examination in relation to both the formal and substantive

requirements of the EPC, such further examination should be carried out, if at all, by the Examining Division as the first instance, only after the Examining Division has itself exercised its discretion under Rule 86(3) EPC."

6. In the circumstances of this case, the Board has therefore also decided, in accordance with the Decision T 63/86, to exercise its power under Article 111(1) to remit this case to the Examining Division, in order that it should examine and decide:

(i) whether the further amendments to the claims, filed with the Statement of grounds of appeal on 19 August 1986, can be made under Rule 86(3) EPC;

(ii) if such amendments can be made, whether such claims are allowable;

furthermore, it should be examined

(iii) if such amendments do not give rise to objections under Article 82 EPC.

#### Order

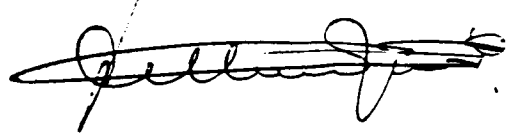
For these reasons, it is decided that

The case is remitted to the Examining Division for further prosecution in relation to the proposed amendments filed on 19 August 1986.

Registrar

  
F. Klein

Chairman

  
P. Delbecque

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*AS 28.10*  
*Sehrh 27.10.*