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D E C I S I O N
of 5 October 1994

Case Number: T 0560/93 - 3.2.1

Application Number: 85201385.3

Publication Number: 0174690

IPC: B61H 15/00, F16D 65/56, F16D 65/66

Language of the proceedings: EN

Title of invention:
A rail vehicle slack adjuster

Patentee:
SAB WABCO Holdings B.V.

Opponent:
KNORR-BREMSE AG

Headword:
-

Relevant legal provisions:
EPC Art. 123(2) and (3), 84, 92(1)
EPC R. 68(2), 67

Keyword:
"Amendments - added subject-matter (no) - broadening (no)"
"Substantial procedural violation (yes)"
"Remittal"

Decisions cited:
T 0169/83

Catchword:
-



Case Number: T 0560/93 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 5 October 1994

Appellant:
(Opponent)

KNORR-BREMSE AG
Moosacher Strasse 80
D-80809 München (DE)

Representative:

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Respondent:
(Proprietor of the patent)

SAB WABCO Holdings B.V.
Marconistraat 18
P.O. Box 120
NL-1700 AC Heerhugowaard (NL)

Representative:

Petri, Stellan, et al
Ström & Gulliksson AB
Box 4188
S-20313 Malmö (SE)

Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office dated 26 April 1993
concerning maintenance of European patent No. 0
174 690 in amended form.

Composition of the Board:

Chairman: F. A. Gumbel
Members: P. Alting van Geusau
J. C. M. de Preter

Summary of Facts and Submissions

I. European patent No. 0 174 690 was granted with effect from 11 May 1988 on the basis of European patent application No. 85 201 385.3, filed on 4 September 1985.

II. With Notice of Opposition filed on 6 February 1989 the Appellant (Opponent) requested revocation of the patent for the reason of non-compliance with the provisions of Article 100(a) EPC.

In respect of an alleged lack of novelty and inventive step the opposition was essentially based on

D4: US-A-3 610 376

III. By decision dated 26 April 1993 the Opposition maintained the patent in amended form on the basis of Claims 1 to 7 filed with letter dated 12 July 1989.

The Opposition Division took the view that novelty of the subject matter of Claim 1 followed from the fact that the essential feature of Claim 1, stating that the barrel spring, the spindle, the piston rod and the locking spring have increasing diameters and are arranged coaxially outside each other, was neither disclosed in the closest prior art document D4 nor in any other cited document.

The Opposition Division further concluded that, starting from the underlying technical problem derivable from the patent, it was not obvious to the skilled person to arrive at the claimed solution.

IV. An appeal was lodged against this decision on 16 June 1993, with payment of the appeal fee and filing of the Statement of Grounds of Appeal on the same day.

The Appellant based his appeal essentially on the following three points:

- (a) The features of the characterising part of the amended Claim 1 have been taken from the drawings and no indication is derivable from the application as filed that these features belong to or are otherwise essential to the invention as it was originally disclosed. In view of the decision T 169/83 (OJ EPO 1985, 193) such amendment infringes Article 123(2) EPC.

Furthermore, the characterising features do neither specify nor clarify features of the granted Claim 1 nor have any relation with the subject matter of the granted Claim 1.

- (b) The features of the characterising part of the amended Claim 1 have not been the subject of the European search and since no additional search has been carried out the Opposition Division committed a substantial procedural violation by accepting such non-searched subject-matter in a claim. This procedural violation justifies reimbursement of the appeal fee.
- (c) When compared to the subject matter claimed in the granted Claim 1 the amended Claim 1 is extended in scope and is thus not acceptable under Article 123(3) EPC.

V. In a communication dated 25 July 1994 the Board expressed the opinion that, when comparing the subject-matter of the amended Claim 1 to the slack adjuster arrangement known from D4, the amended Claim 1 did not appear to meet the requirements of Article 84 and Rule 29(1) EPC and for these reasons alone Claim 1 was not considered acceptable.

It was further noted that Claim 2 was added without any necessity resulting from the Grounds of Opposition. In accordance with the case law of the Boards of Appeal such a claim is not acceptable and should be deleted.

In respect of the Appellant's objections the Board considered that, in so far as the requirements of Articles 123(2) and (3) EPC were involved, there appeared to be no valid reason for objection to the now claimed subject-matter.

However, the Board noted that the contested decision did not deal with the Appellant's objection concerning subject-matter now claimed that had not been the object of a search, which objection was broadly set out in the Appellant's letters dated 25 October 1989 (pages 3 and 4) and 4 November 1991 (point III). Moreover there appeared to be no reasoning in the decision for the conclusion that the subject-matter of Claim 1 involved an inventive step.

In view of these deficiencies the Board concluded that the decision appeared to lack sufficient reasoning as required by Rule 68(2) EPC, which amounted to a substantial procedural violation. Because of the procedural violation the case should be sent back to the first instance for further prosecution of the opposition proceedings. The Appellant was requested to inform the

Board whether under these circumstances he maintained his auxiliary request for oral proceedings.

VI. With letter dated 8 September 1994 the Respondent filed new Claims 1 to 6 and requested that the further prosecution should be based on these amended Claims.

Current Claim 1 reads as follows:

"1. A clearance-sensing slack adjuster for a rail vehicle brake rigging, including non-rotatable, axially movable, tubular means (7, 17) for introducing a force in the braking direction, a non-rotatable, threaded spindle (8) arranged coaxially inside the tubular means to deliver a brake force from the adjuster; an adjuster nut (26), which is in non-self-locking engagement with the spindle, in the braking direction abuts a bearing (18) in the tubular means and is clutchable over a main clutch (27) to the tubular means (1) for transmitting brake force; a barrel spring (29), which is stronger than a return spring (6) for the tubular means and acts in the braking direction between the tubular means and the spindle; and a non-rotatable locking sleeve (20), which is axially movable in the braking direction only a distance corresponding to a set control distance (A) under the action of a locking spring (21) and is clutchable to the adjuster nut over a control clutch (28), characterised in that the slack adjuster is built into a rail vehicle brake unit, the tubular means comprises a piston rod (7, 17) attached to a piston (3) in a fixed housing (1) of the unit, and the barrel spring (29), the spindle (8), the piston rod (7) and the locking sleeve (20) with its locking spring (21) are arranged coaxially outside each other".

In respect of the Appellant's objections the Respondent submitted the following arguments:

The coaxial arrangement of the parts defined in the characterising part of Claim 1 is not only based on the drawings, as was submitted by the Appellant, but the description also contains at various places references to this design. Moreover, the jurisprudence of the Boards of Appeal confirms that features shown in the drawings are an integral part of the application as filed and may be incorporated in the claims during the course of the proceedings, as long as the provisions of Article 123(3) EPC are fulfilled. As regards this point new Claim 1 clearly has a more limited scope of protection, as the entire former main Claim is the preamble of Claim 1 upheld by the Opposition Division.

It further cannot be seen that not having had carried out an additional search for the characterizing features including the coaxial arrangement of the parts forms a serious mistake committed by the Opposition Division. After amendment of the main claim the Appellant had ample time to perform a more in-depth search to find material pertinent to the new Claim 1. Obviously this attempt has been in vain.

- VII. With telefax dated 27 September 1994 the Appellant withdrew his auxiliary request for oral proceedings.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is admissible.
2. *Amendments*
 - 2.1 The pre-characterising part of the current Claim 1 is now correctly based on the closest prior art as shown in D4 and thus Claim 1 satisfies the requirements of Rule 29(1) EPC.

It is now apparent that the piston rod 7 is part of the tubular means 7, 17 for introducing a force in the braking direction. However, in this respect obviously the reference numeral 17 is erroneously added to the first reference to the piston rod occurring in the characterising part of Claim 1. This reference numeral should be deleted.

In respect of the clarity of the feature that the barrel spring 29 acts between the piston rod 7 and the spindle 8 the Board is satisfied that the skilled person would interpret the term "acts" to imply not only direct actuation but also an indirect biasing between these two parts, i.e. between the piston part mounted to the piston rod and the spindle as shown in drawing 1.

- 2.2 Considering the Appellant's objection with respect to the non-allowability of the introduction of the characterising features relating to the coaxial arrangement of the barrel spring, the spindle, the piston rod and the locking sleeve, the Board observes that, contrary to the opinion expressed by the

Appellant, there is indeed a close relation between these features and the features of the granted Claim 1. In particular the position of the barrel spring, the spindle, the piston rod and the locking sleeve with its spring - all these features being themselves already defined in the granted Claim 1 - is further specified in a manner to clarify the compact design of the slack adjuster which is one of the objects of the invention mentioned in the granted patent.

The decision T 169/83 (OJ EPO 1985, 193), referred to by the Appellant, does not forbid the limitation of the subject matter of a granted claim by features taken from the drawings if the respective features are fully derivable from the drawings in terms of structure and function by a person skilled in the art and can be related to the content of the specification as a whole as to be part of the invention.

It will be clear from the above assessment with respect to compact design of the slack adjuster that all these conditions are met in the present case. Moreover the coaxial arrangement at least of the spindle, piston and locking sleeve with its spring is also mentioned in the description.

Thus, considering the disclosure of the application as filed no objections as regards Article 123(2) EPC arise against the subject matter of the current Claim 1.

- 2.3 In respect of the Appellant's objection based on Article 123(3) EPC the Board observes that the entirety of the subject-matter of the granted Claim 1 is contained and is further specified in the current Claim 1. This new Claim 1 is therefore of a more limited scope than the granted Claim 1 and therefore the conditions of Article 123(3) EPC are also fulfilled.

- 2.4 Claims 2 to 6 concern essentially repetitions of the originally filed, respectively granted Claims 2 to 6. No objections arise in respect of Articles 123(2) and (3) EPC.

However, considering that in accordance with the embodiment disclosed in Figure 1 the spring washer 19 is arranged between the bearing 18 and the piston rod sleeve 17 and not between the bearing 18 and the piston rod 7 such as stated in Claim 2, this inconsistency of Claim 2 should be dispensed with in order to comply with the requirements of Article 84 EPC.

3. *Procedural matters*

- 3.1 It appears from the file of the opposition proceedings that, in response to an amendment of Claim 1 to the form as allowed by the Opposition Division in the contested decision, the Appellant put forward in a submission dated 25 October 1989 (pages 3 and 4) and also in a further response dated 4 November 1991 (point III) the objection that the coaxial arrangement of the barrel spring, the spindle, the piston rod and the locking sleeve did not have an antecedent in the claims so far and that therefore obviously these features have not been the subject of the search in accordance with Article 92(1) EPC and cannot, therefore, without an additional search, form the basis for the maintenance of the patent.

- 3.2 The Board observes that the Opposition Division's decision fails to deal with this essential point in the Appellant's argumentation for the non-acceptability of Claim 1.

It is further to be noted that when dealing with the question of inventive step of the subject matter of Claim 1, there is simply stated (see point 4 in the decision) after defining the objective problem underlying the subject-matter of Claim 1 that it was not obvious for a person skilled in the art to arrive at the claimed solution but no reasons are given as to why the Opposition Division arrived at this conclusion.

Even considering that when assessing the novelty of the subject-matter of Claim 1 (point 3 of the decision), it is stated that the feature concerning the coaxial arrangement of the barrel spring, the spindle, the piston rod and the locking spring is not disclosed in D4 or any other document, such a statement purely concerns novelty and cannot be seen as a sufficient reason for the non-obviousness of the feature in question.

The Board therefore concludes that the decision lacks sufficient reasoning as required by Rule 68(2) EPC.

- 3.3 The non-compliance of the contested decision with the provisions of Rule 68(2) EPC is considered to constitute a serious procedural violation such that the decision must be set aside and the case remitted to the first instance for further prosecution.

As a result of the substantial procedural violation it is considered to be equitable to reimburse the appeal fee, as requested by the Appellant.

Order

For these reasons it is decided that:

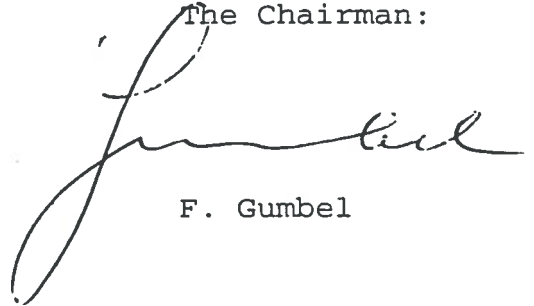
1. The contested decision is set aside.
2. The case is remitted to the first instance for further prosecution.
3. The fee for appeal shall be reimbursed.

The Registrar:



S. Fabiani

The Chairman:



F. Gumbel

