

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 22 March 2001

Case Number: T 0951/98 - 3.2.1

Application Number: 93104678.3

Publication Number: 0562519

IPC: B60J 7/057

Language of the proceedings: EN

Title of invention:
Operating device for a sunroof

Patentee:
ZANI S.R.L.

Opponent:
FARMONT Produktion GmbH & Co. KG
WESTMONT Technik GmbH & Co. KG

Headword:
-

Relevant legal provisions:
EPC Art. 84, 123(2), 123(3)

Keyword:
-

Decisions cited:
T 0260/85

Catchword:
-



Case Number: T 0951/98 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 22 March 2001

Appellant: ZANI S.R.L.
(Proprietor of the patent) via G. Mameli, 10
I-25066 Lumezzane (Brescia) (IT)

Representative: Lusuardi, Werther Giovanni, Dr.
Dr. Lusuardi AG
Kreuzbühlstrasse 8
CH-8008 Zürich (CH)

Respondent I: FARMONT Produktion GmbH & Co. KG
(Opponent 01) Blomberger Weg 6a
D-13437 Berlin (DE)

Representative: Metman, Karel Johannes
De Vries & Metman
Overschiestraat 184
NL-1062 XK Amsterdam (NL)

Respondent II: WESTMONT Technik GmbH & Co. KG
(Opponent 02) Willstätterstrasse 6
D-40549 Düsseldorf (DE)

Representative: Schumacher, Horst, Dr. Dipl.-Phys.
König-Palgen-Schumacher-Kluin
Patentanwälte
Frühlingstrasse 43A
D-45133 Essen (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 30 July 1998
revoking European patent No. 0 562 519 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: F. Gumbel
Members: M. Ceyte
P. Mühlens

Summary of Facts and Submissions

- I. The appellant is the proprietor of European patent No. 0 562 519 (application No. 93 104 678.3).
- II. The patent was opposed by the respondents I and II (opponents 01 and 02) on the grounds of added subject-matter under Article 100(c) EPC and insufficiency of disclosure under Article 100(b) EPC.
- III. By its decision posted on 30 July 1998 the Opposition Division revoked the European patent arguing that the generalization of the term "toothed circular segments (14) engaged with racks" in claim 1 as originally filed to "rotating drawing means" or "drawing means" did not meet the requirement of Article 123(2) EPC.
- IV. An appeal against this decision was filed on 19 September 1998. The appeal fee was paid on the same day and the statement of grounds of appeal was filed on 12 November 1998.

In response to two communications by the Board the appellant (patentee) now requests that the decision under appeal be set aside and the patent be maintained as granted with the following amendments in claim 1:

- at lines 48, 49, column 4, amend "and with rotating drawing means (27)" to read "and with rotating means (14) engaged with racks (27)";
- at lines 4 to 6, column 5, amend "at one end, with means engaging with said drawing means" to read "at one end, with said rotating means (14) engaged with said racks (27)".

V. The respondents requested that the appeal be dismissed.

In support thereof they made essentially the following submissions:

- (i) Contrary to the appellant's contention, there is no basis in the application as originally filed for the replacement of the term "toothed circular segments (14) engaged with racks" in claim 1 as originally filed by "rotating means (14) engaged with racks (27)".

The mere fact that as a result of the engagement of the racks with the toothed circular segments, the latter are said to "rotate" is not a sufficient basis for the proposed amendment. A skilled person would not derive from the original disclosure that something different than toothed circular segments could have been meant. It follows that such amendment contravenes Article 123(2) EPC.

- (ii) Furthermore, according to e.g. "The New International Webster's Dictionary of the English Language" 1995 Edition a "rack" is a "bar or rail with teeth which gear into those of a cogwheel or worm".

The proposed wording "rotating means" is improper to define the toothed circular segment which meshes into the rack and therefore also lacks clarity (Article 84).

VI. By letter of 11 August 2000, the respondent I withdrew its request for oral proceedings. Respondent II did not

answer to the Board's first communication requesting clarification whether it still maintains its subsidiary request for oral proceedings and did not take any part in further discussion of the case. The Board understands this as meaning that it is no longer interested in oral proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. It is solely concerned with the issue of added subject-matter under Article 123(2) and 100(c) EPC which was the sole ground for the revocation of the patent.

Consequently, the sole question at stake in the present appeal is whether the generalization of the term "toothed circular segments (14) engaged with racks (27)" in claim 1 as originally filed to "rotating means (14) engaged with racks (27)" is allowable under Article 123(2) EPC.

Generally speaking, it is necessary for the purpose of ascertaining whether a generalization of a specific feature may or not violate Article 123(2) EPC to determine whether there is a basis in the application as originally filed for such generalization:

The description and the drawings as originally filed clearly disclose a toothed rack (27) and a toothed circular segment (14) adapted to gear in meshing engagement with said toothed rack, for rotating the lever (13) formed integral with the toothed circular segment (see in particular Figures 1 and 3).

It is expressis verbis stated that "during pulling of the trucks the toothed segments (14) rotate on the rack (27), the levers (13) rise" (page 7, lines 1 to 3 of the application as filed). There is thus no doubt that the function of the toothed segment (14) is "to rotate" the lever (13) in order to raise or lower it. Hence there is a clear basis in the application as originally filed for "rotating means (14)" whose function is to rotate the claimed lever (13).

It is also observed that rack and pinion mechanisms intended for transforming a sliding movement of the rack into a rotation of the pinion or gear-wheel are well known to the skilled person in the field of mechanics and thus are common general knowledge. As a consequence, the skilled person would immediately understand that a rotating means which co-operates with a rack is necessarily a toothed rotating means whose teeth or similar members are adapted to gear in meshing engagement with the toothed rack. He would also understand that for fulfilling this function it is not essential that this rotating means is strictly circular and that it is a segment (as opposed to a full circle).

3. According to the case law of the boards of appeal, it is not permissible to delete from an independent claim a feature which is in the application as originally filed disclosed as being an essential feature of the invention (see T 260/85 OJ EPO 89, 105). However, in the case to be decided, the feature "toothed circular segments (14) engaged with racks (27)" is not completely deleted but replaced by the more general wording, "rotating means (14) engaged with racks (27)" which is adequately supported by the patent application as originally filed, as outlined above.

For the above reasons the Board concludes that the above amendment meets the requirement of Article 123(2) EPC.

4. Since, the terms "rotating drawing means (27)" and "means engaged with drawing means (27)" in granted claim 1 are replaced in present claim 1 by the more restrictive wording "rotating means (14) engaged with racks (27)", the requirement of Article 123(3) EPC is also complied with.

5. Finally, the term "rotating means" is appropriate for defining the means for rotating the lever (13) which according to claim 1 is provided, at one end, on said rotating means. Thus contrary to the respondents' submissions this wording complies with the clarity requirement of Article 84 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance with the order to maintain the patent as granted but subject to the amendments in claim 1 according to the appellant's request (see point IV above).

The Registrar:

The Chairman:

S. Fabiani

F. Gumbel