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D E C I S I O N
of 5 February 2002

Case Number: T 0502/99 - 3.4.2

Application Number: 94200139.7

Publication Number: 0611948

IPC: G01B 11/275

Language of the proceedings: EN

Title of invention:

System for measuring the wheel base of an automobile frame and the transverse and longitudinal offsets of its steered wheels

Patentee:

CORGHI S.p.A.

Opponent:

Snap-On Deutschland Holding GmbH

Headword:

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Relevant legal provisions:

EPC Art. 84, 111(1)

Keyword:

"Grounds for revocation under Article 84 EPC no longer apply to amended patent"

"Remittal to the first instance"

Decisions cited:

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Catchword:

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Case Number: T 0502/99 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 5 February 2002

Appellant: CORGHI S.p.A.
(Proprietor of the patent) Strada Statale 468, No.9
I-42015 Correggio Emilia (Reggio Emilia) (IT)

Representative: Corradini, Corrado
Studio Ing. C. CORRADINI & C. S.r.l.
4, Via Dante Alighieri
I-42100 Reggio Emilia (IT)

Respondent: Snap-On Deutschland Holding GmbH
(Opponent) Auf dem Hüls 5
D-40822 Mettmann (DE)

Representative: Nöth, Heinz, Dipl.-Phys.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 March 1999
revoking European patent No. 0 611 948 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: A. G. Klein
Members: M. A. Rayner
V. Di Cerbo

Summary of Facts and Submissions

I. The appellant (patent proprietor) lodged an appeal against the decision of the opposition division revoking the European patent No. 0 611 948 (application No. 94 200 139.7).

An opposition against the patent as a whole had been filed by the respondent (opponent); the opposition was based on the grounds of lack of novelty and lack of inventive step (Article 100(a) EPC).

In reply to the statement setting out the grounds of opposition, the patent proprietor submitted an amended set of claims and requested maintenance of the patent in amended form. Claim 1 of the amended set of claims included the amended feature "the optical angle measurement means [...] receive the light beams emitted by the two LEDs [...] in a plane distant from the apex of said two beams".

The opponent submitted that the amended feature referred to above was not disclosed in the documents of the patent in suit and that it was inconsistent with the arrangements represented in Figurey 5 and 7 of the patent. These submissions were contested by the patent proprietor.

The opposition division revoked the patent by the decision under appeal on the grounds that the subject matter of the amended claim 1 did not fulfill the requirements of Article 84 EPC. The opposition division held in particular that the disputed feature was not clear and that it was not supported by the description. No other finding substantiating additional grounds for

revocation was mentioned in the decision under appeal.

- II. The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the sole claim 1 and the amendments to the description submitted with the letter dated 28 April 2000. He also requested oral proceedings on an auxiliary basis.

Claim 1 of the appellant's request reads as follows:

"A system for measuring the wheel base of an automobile frame and the transverse and longitudinal offsets of its steered wheels, comprising a first and a second device respectively attached by known means to the front and back automobile wheels on the same side of the vehicle

characterised in that

said first device comprises two light emitting diodes (LEDs) located a known distance apart measured in the horizontal plane; and

said second device comprises a cylindrical lens of vertical axis able to concentrate the light beams emitted by said diodes into two light lines parallel to the lens axis,

a line of optical sensors arranged perpendicular to said lens axis to measure the distance between the points of incidence of said light lines with said line of sensors,

a microprocessor arranged to calculate the wheel

base (p) between the front and back automobile wheels on the same side of the vehicle, starting from said measured distance."

III. The respondent requested the board to dismiss the appeal of the appellant and on an auxiliary basis oral proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. *Claim 1 of the appellant's request*

The single claim of the appellant's request no longer includes the disputed feature "the optical angle measurement means [...] receive the light beams emitted by the two LEDs [...] in a plane distant from the apex of said two beams" considered by the opposition division in the decision under appeal as being neither clear nor supported by the description (Article 84 EPC).

Claim 1 thus overcomes the sole ground for revocation under Article 84 EPC laid down in the decision under appeal and the decision under appeal must therefore be set aside.

3. *Further prosecution*

Claim 1 of the appellant's request has been substantially amended in a way which calls for further examination in relation to issues involving both the formal and substantive requirements of the EPC. Any

decision on such issues during the present appeal proceedings would, however, result in depriving the parties of the right to defend their case before two instances.

Accordingly, taking also into account that the main purpose of appeal proceedings is to allow for a decision of the first instance being reviewed on its merits, and that the opposition proceedings were themselves relatively rapid - they did not involve the issuing of a communication by the opposition division nor the holding of oral proceedings - the board deems it appropriate, in accordance with the established practice of the Boards of Appeal, to exercise its power under Article 111(1) EPC to remit the case to the department of first instance for further prosecution, without further comment as to the merits of the case of the parties, since any such comments may improperly influence the first instance, which is free to examine all of the issues concerned.

Since the parties will have an opportunity to request oral proceedings before the first instance department where the case is to be further prosecuted, there is no need for appointing oral proceedings before the board. It is noted in this respect that by a communication dated 14 September 2001 the parties were duly informed of the board's intention to remit the case to the department of first instance without oral proceedings being held before the board; this course of action was expressly agreed by the appellant, and the respondent's silence to the board's communication is interpreted as an indication that he had no fundamental objection against it.

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.

The Registrar:

The Chairman:

P. Martorana

A. Klein