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D E C I S I O N
of 8 July 2004

Case Number: T 0274/03 - 3.2.1

Application Number: 98305738.1

Publication Number: 0892195

IPC: F16H 59/04

Language of the proceedings: EN

Title of invention:
Shift changing device for torque converter

Applicant:
TOYO DENSO KABUSHIKI KAISHA

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC R. 86(4)

Keyword:
"Amendments of claims - switching to unsearched subject-matter implying a significant change in the nature of the subject-matter claimed (no)"

Decisions cited:
T 0442/95, T 0708/00, T 0377/01

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0274/03 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 8 July 2004

Appellant: TOYO DENSO KABUSHIKI KAISHA
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 23 September 2002 refusing European application No. 98305738.1 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: S. Crane
Members: F. J. Pröls
G. E. Weiss

Summary of Facts and Submissions

I. European patent application No. 98 305 738.1 was refused by a decision of the Examining Division posted on 23 September 2002.

The reason given for the decision was that claim 1 as amended did not meet the requirements of Rule 86(4) EPC.

II. A notice of appeal against this decision was filed on 8 November 2002 and the fee for appeal paid at the same time. The statement of grounds of appeal was received on 3 February 2003.

The appellants (applicants) requested that the decision under appeal be set aside and the examination be continued on the basis of the documents filed on 8 June 2001 (main request). Auxiliary requests concerned the performance of an additional search.

Present claim 1 reads as follows:

"A shift changing device for a torque converter, which is changeable in a multistage manner from a neutral position to at least a forward position or reverse position, comprising,

a shift lever (5) pivotally mounted in association with a steering shaft (1), and

a shift switch (7) operated by moving the shift lever;

wherein a control means is provided to prevent the shift lever from successively moving to multistage positions in the same plane, characterised in that said

shift switch includes a slider (8) interlocking with the shift lever, and push rods (9a-9e) moving selectively up and down according to the movement of the slider, each push rod being adapted to selectively turn on or off position switches (24a—24e) corresponding to each shift position."

Reasons for the Decision

1. The appeal complies with the formal requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is therefore admissible.

2. Present amended claim 1 which was the basis for the decision under appeal includes in its precharacterising part all the features of claim 1 as originally filed and further comprises as content of the characterising part of the claim additional features which are disclosed in the original description on page 3, lines 32 to 35 and on page 5, lines 7 to 9.

   Thus, no objection arises under Article 123(2) EPC.

3. The Examining Division argues that the subject-matter of present claim 1 had not been searched, since it was not included in any of the original claims and that it does not combine with the originally claimed invention to form a single general invention concept, because it is based on a different technical approach.

4. Given the principle that the EPC assumes that a search fee must always be paid for an invention presented for examination, Rule 86(4) EPC, which was introduced with effect from 1 June 1995, is intended to prevent amendments of the application which circumvent this principle. Rule 86(4) EPC now stops applicants switching to unsearched subject-matter in the reply to a communication from the Examining Division and makes means available for the European Patent Office to react when different subject-matter is claimed not simultaneously but in sequence as is the case when the applicant drops the existing claims and replaces them with originally non-unitary subject-matter extracted from the description. See in this connection the "Preparatory document" relating the new Rule 86(4) EPC, the document CA/12/94 Rev. 1 of 17 October 1994, "Amendment of the EPC, the Implementing Regulations and the Rules relating to Fees", pages 16 and 17, and the Notice of 1 June 1995 published in OJ EPO 1995, pages 409 and particularly 420, 421 concerning the introduction of the new Rule 86(4) EPC.

5. Therefore it is clear that post-search "switching" of subject-matter clearly implies a significant change in the nature of the subject-matter being claimed which is not normally comparable to the addition of features taken from the description to further define an element that was already a feature of the original main claim.

6. In accordance with the case law of the Boards of Appeal (T 377/01, point 3.1 and T 708/00, point 17, both decisions not published in OJ EPO) the Board is of the opinion that an amendment amounting to the restriction of an original main claim by including complementary

features from the original description into the claim represents an admissible reaction of an applicant vis-à-vis an objection against the patentability of the unamended claim and does not constitute an abuse of the system of the nature which Rule 86(4) EPC was introduced to prevent. This type of amendment should not therefore in general be judged as contravening the requirements of the rule, even though an additional search may be required.

In this context it is to be observed that the implicit finding of lack of unity between the originally claimed and later claimed subject-matter, which is a prerequisite for an objection under Rule 86(4) EPC, must, with amendments of the type under consideration here, be *a posteriori*. The Guidelines for Examination in the EPO make it clear however that this form of objection to lack of unity should be the exception, with benefit of the doubt being given to the applicant (see C-III, 7.7).

In the present case, see point 2 above, amended claim 1 concerns the addition of features to the otherwise unchanged subject-matter of the original main claim, whereby the specification of the slider arranged within the shift switch interlocking the shift switch with the shift lever and the push rods actuated by the slider turning on or off position switches clearly makes a contribution to the construction of the shift switch operated by moving the shift lever which represents the most essential part of the shift changing device according to the original main claim.

As a consequence of the above the Board comes to the conclusion that the present set of claims is in agreement with the requirements of Rule 86(4) EPC.

T 442/95 (see Case Law of the Boards of the appeal of the EPO, 2001, page 425) as cited in the decision under appeal concerns a case wherein the objected claim was the result of post-search switching of subject-matter in the sense mentioned above under points 4 and 5 and therefore is not comparable with the present case.

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 for further prosecution.

The Registrar: The Chairman:

A. Vottner S. Crane