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D E C I S I O N
of 29 August 2005

Case Number: T 0966/03 - 3.2.4

Application Number: 00202128.5

Publication Number: 1166684

IPC: A47C 4/54

Language of the proceedings: EN

Title of invention:

Inflatable furniture having independent air chambers and method

Applicant:

Intex Recreation Corp.

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 123(2), 109(1), 111(1)

EPC R. 67

Keyword:

"Interlocutory revision"

"Reimbursement of the appeal fee (not equitable)"

"Substantial amendment"

"Remittal to the first instance"

Decisions cited:

T 0139/87, T 0020/81

Catchword:

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Case Number: T 0966/03 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 29 August 2005

Appellant: Intex Recreation Corp.
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Long Beach, CA 90801 (US)

Representative: Jilderda, Anne Ayolt
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 1 April 2003
refusing European Patent application
No. 00202128.5 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: M. Poock
T. Bokor

Summary of Facts and Submissions

- I. European patent application No. 00 202 128.5 (publication No. 1 166 684) was refused by a decision of the examining division posted on 1 April 2003.

In its decision the examining division ruled that claim 1 of the main or three auxiliary requests submitted in the oral proceedings of 12 March 2003 had been amended such that it did not comply with the requirements of Article 123(2) EPC.

More particularly it was set out that claim 1 of all of the requests did not contain the feature "said subchamber for increasing the pressure within and for modifying the shape of said outer enclosing chamber". Since this feature was consistently presented in the application as being essential for the proper functioning of the invention, it could not be omitted in claim 1.

- II. An appeal was lodged against this decision on 11 June 2003 and the appeal fee was paid on the same day. The statement of grounds of appeal was received on 11 August 2003 with two sets of claims 1 to 12 according to a new main and a new auxiliary request.

- III. The appellant requests:
- that the decision under appeal be set aside and the case be remitted to the examining division for further prosecution on the basis of claims 1 to 12 of the main or auxiliary request, or
 - auxiliarily, to be summoned to oral proceedings.

IV. The last feature of claim 1 according to the main request reads as follows:

"said sub chamber for increasing the pressure within said outer enclosing chamber to push back on and thus support the body seated thereon and for modifying the shape of said outer enclosing chamber in pressurized form".

Reasons for the Decision

1. The appeal is admissible.

Main request

2. Article 109(1) EPC stipulates that the department whose decision is contested must rectify its decision when the appeal is admissible and well founded.

An appeal is to be considered well founded if the amendments submitted by the applicant (appellant) with the appeal clearly meet the objections on which the decision relies (see T 139/87, OJ EPO 1990, 68, point 4 of the reasons).

The sole ground for refusal was that the requirement of Article 123(2) EPC had not been met (legal basis) because the essential feature "said subchamber for increasing the pressure within and for modifying the shape of said outer enclosing chamber" had been omitted in claim 1 (factual reason). In fact, this feature was present in claim 1 as filed originally.

With the amendments in claim 1 of the main request the omitted feature was reinserted, so that claim 1 as amended fully overcomes this objection.

3. Under these circumstances, the examining division should have rectified its decision.

The examining division might have seen other irregularities with respect to the requirements of the EPC, be it Article 123(2) EPC or others. However, this could not preclude the application of Article 109 EPC because such irregularities would relate to a new factual reason, thus a new ground which was not the ground on which the decision relied (see T 139/87 above, point 4 of the reasons).

4. In certain circumstances a failure to grant interlocutory revision can amount to a substantial procedural violation in the sense of Rule 67 EPC justifying reimbursement of the appeal fee.

However, since the decision should have been rectified merely because the appellant in his appeal finally decided to amend claim 1 in order to meet the objection of the examining division, it would not be equitable in such case to reimburse the appeal fee.

5. The board has not, however, taken a decision on the whole matter.

Apart from the reinserted feature, claim 1 of the main request has been substantially amended. Some of these amendments were presented for the first time in the appeal proceedings, e.g. "to push back on and thus

support the body seated thereon" was included in the last feature. Other amendments were already present in claim 1 of the main or auxiliary requests submitted during the first instance's oral proceedings, e.g. "comprising" was replaced by "consisting of" and "... subchamber sealed to said bottom layer" was replaced by "... sub chamber sealed to said bottom layer only".

Thus the application needs to be examined further, not only for compliance with the requirements of Article 123(2) EPC but also to see if its subject-matter meets all other requirements of the EPC.

Since the claims were substantially amended and the examining division should have rectified its decision, the board considers it appropriate to exercise its discretion under Article 111(1) EPC and to remit the case to the examining division for further prosecution on the basis of claims 1 to 12 of the main request.

In this respect, the following should be observed:

The board shares the view of the examining division that the technical effect on which the application and the appellant rely to locally increase the pressure in the outer enclosing chamber by pressurising the subchambers is not plausible. However, since the disclosure of an application is aimed at the person skilled in the art, this deficiency will be recognised and rectified by him on the basis of his common general knowledge (see Case Law of the Boards of Appeal of the European Patent Office, 4th edition, II.A.2.(a)).

The board is convinced that the person skilled in the art will immediately understand from the application that the pressurisation of any interior subchamber will increase the pressure in the entire outer enclosing chamber (i.e. its space surrounding the subchambers) and not only locally as could be derived from page 12, lines 7-11; page 15, lines 5-10 or page 17, lines 4-10. Apart from the pressure increase in the subchambers, any local pressure increase within the outer enclosing chamber is not plausible and the corresponding statements in the application will thus be disregarded by the person skilled in the art.

Therefore, this deficiency does not affect the disclosure that the subchambers are suitable for increasing the pressure within the outer enclosing chamber (see e.g. page 4, lines 21, 22) and for modifying the shape of the outer enclosing chamber (see e.g. page 12, lines 5-7). However, the modification of the shape of the outer enclosing chamber is not limited to the regions where the subchambers are located.

In addition, it should be noted that this alleged technical effect should not be taken into consideration for the examination of the patentability of the application's subject-matter unless it is supported by convincing evidence (see e.g. T 20/81, OJ EPO 1982, 217).

Auxiliary requests

6. Since the appellant succeeds with his main request there is no need for the board to consider the auxiliary requests.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte