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**Datasheet for the decision
of 19 February 2008**

Case Number: T 1182/05 - 3.2.01

Application Number: 02018106.1

Publication Number: 1285821

IPC: B60R 21/16

Language of the proceedings: EN

Title of invention:

Air bag device

Patentee:

TAKATA CORPORATION

Headword:

-

Relevant legal provisions:

RPBA Art. 11

Relevant legal provisions (1973):

EPC Art. 113(1)

EPC R. 68(2), 67

Keyword:

"Lack of reasoning (yes)"

"Procedural violation (yes)"

"Right to be heard (no)"

"Reimbursement of appeal fee (yes)"

"Remittal to the first instance (yes)"

Decisions cited:

T 0278/00, T 0034/90, G 0009/91, T 0861/02, T 0897/03,

T 0276/04, T 1309/05, T 0583/04, T 0094/84

Catchword:

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Case Number: T 1182/05 - 3.2.01

D E C I S I O N
of the Technical Board of Appeal 3.2.01
of 19 February 2008

Appellant: TAKATA CORPORATION
4-30, Roppongi 1-chome
Minato-ku
Tokyo 106-8510 (JP)

Representative: Banzer, Hans-Jörg
Kraus & Weisert
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 23 March 2005
refusing European application No. 02018106.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. Crane
Members: P. L. P. Weber
T. Karamanli

Summary of Facts and Submissions

I. The appeal is against the decision of the Examining Division posted 23 March 2005 to refuse the European patent application 02018106.1.

Notice of appeal was filed on 20 May 2005 and the fee paid on the same day. The statement of the grounds of appeal was filed on 21 June 2005.

II. In a communication dated 10 July 2003 the Examining Division objected that the airbag device according to originally filed Claim 1 was not novel over D1: US-A-3642303.

III. In its response dated 11 November 2003, the applicant filed amended claims replacing the claims then on file and explained why it considered the subject-matter of Claim 1 as being novel and involving an inventive step.

IV. In a communication dated 23 January 2004 the Examining Division objected that the airbag device according to Claim 1 on file was not inventive over D1, the differentiating feature of the capacity of the lower bag segment when deployed being 60 to 90 liters being a simple selection the man skilled in the art would consider without inventive step.

V. In its response dated 24 May 2004, the applicant maintained Claim 1 and explained further why in its opinion the claimed subject-matter involved an inventive step.

- VI. In a communication dated 15 June 2004, the Examining Division introduced two new documents D6: US-A-4243248 and D7: EP-A-1065192 and explained why in its opinion the airbag device according to Claim 1 on file was not inventive over a combination of D1 with D6 or D7.
- VII. In its response dated 14 October 2004 the applicant filed an amended Claim 1 replacing the claim then on file with the additional feature of the capacity of the upper bag segment being 20 to 40 liters and explained why the claimed subject-matter was inventive over a combination of D1 with D6 or D7. The applicant explained in particular that D1 did not disclose any capacity for the upper and lower bag segments and that D6 and D7 although disclosing capacities, did so only for airbags having one bag segment, so that these documents could not render obvious the particular capacities as claimed which allow a reliable inflation of both segments at a high speed even with a low-output inflator. As an auxiliary measure the applicant requested oral proceedings to be held.
- VIII. Claim 1 reads as follows:
- "1. An air bag device (1), comprising:
an air bag (10) to be deployed in front of a passenger's (PS) seat of a car, wherein said air bag (10) comprises:
a lower bag segment (11) for holding the shoulders and chest of an adult passenger (PS) when it is deployed,
an upper bag segment (21) that rises from said lower bag segment (11) so as to hold the head of the adult passenger (PS) when it is deployed; and

a partition cloth (31) having an inner vent hole (33) for separating said upper and lower bag segments (11, 21); and

an inflator (5) for injecting inflation gas to deploy said air bag (10), wherein the inflation gas from said inflator (5) is directly supplied to said lower bag segment (11) of said air bag (10), and is supplied to said upper bag segment (21) through said inner vent hole (33) of said air bag (10),

characterized in that

the capacity of said lower bag segment (11) of said air bag (10) when deployed is 60 to 90 liters, and the capacity of said upper bag segment (21) of said air bag (10) when deployed is 20 to 40 liters."

IX. In its communication annexed to the summons to attend oral proceedings dated 17 November 2004 the Examining Division mentioned that at the oral proceedings before the discussion on novelty and inventive step clarity would have to be discussed, the terms "capacity of lower bag segment" and "capacity of upper bag segment" being unusual parameters in the sense of the Guidelines for Examination in the EPO, C-III, 4.7a as no comparison with the prior art could be made. These parameters thus would disguise a lack of novelty as per the Guidelines for Examination in the EPO, C-IV 7.5.

In the event Claim 1 would be considered to be clear and the claimed subject-matter novel, the capacities cited in the characterising portion of the claim would be common values for the skilled man.

- X. In reply to the summons, the applicant filed on 31 January 2005 a letter of six pages together with amended pages 4, 4a, 5, 6 of the description.

In this letter the applicant stated under point "I" that it would not attend the scheduled oral proceedings and that it requested the Examining Division "to render a decision on the record". The appellant further requested that "the subject-matter of the present claims be re-examined taking into account the following explanations".

Under point "II" the applicant explained that it had filed replacement pages for pending description pages 4 to 6. Under point "III" it argued why in its opinion the subject-matter of Claim 1 on file was not only novel, but also inventive over D1 and D6 or D7. Under point "IV" it explained over one and a half pages why the clarity objection raised in the annex to the summons was not justified and why the Guidelines for Examination in the EPO, C-III, 4.7a and C-IV, 7.5 could not be used against Claim 1 on file.

In particular the applicant explained that the capacities could be clearly and reliably determined by objective procedures which are usual in the art and that the skilled man would not unavoidably arrive at these values when carrying out the invention of D1.

- XI. The decision to refuse the application dated 23 March 2005 was issued on EPO Form 2061 with the following grounds for the decision:

"In the communication(s) dated 23.01.2004, 15.06.2004, 17.11.2004 the applicant was informed that the

application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 31.01.2005.

The application must therefore be refused."

XII. The appellant considers that the decision issued by the Examining Division does not fulfil the requirement of Rule 68(2) EPC 1973 that the decisions of the European Patent Office shall be reasoned, since the decision does not include any logical chain of arguments justifying the Examining Division's finding. It merely refers to previous communications.

In addition the appellant states that according to the decision the appellant allegedly did not file any comments or amendments in reply to the latest communication which is not correct, the appellant having filed an amended description and new arguments on 31 January 2005 in response to the summons to oral proceedings.

In its view it seems that the Examining Division has not even considered the arguments in the appellant's response of 31 January 2005 when it decided to refuse the application.

The appellant argues that this contravention of Rule 68(2) EPC 1973 constitutes a substantial procedural violation justifying the reimbursement of the appeal fee pursuant to Rule 67 EPC 1973.

XIII. In telephone conversations dated 24 May and 5 June 2007, the representative's attention was drawn to the fact that the board was of the opinion that a substantial procedural violation was apparent in the first instance's proceedings. According to Article 10 of the Rules of Procedure of the Boards of Appeal (RPBA) in the version which entered into force on 1 May 2003 (OJ EPO 2003, 89), in cases of fundamental deficiencies the board would have to remit the case to the first instance, since in the present case no special reasons were apparent for doing otherwise.

XIV. The appellant requests:

1. That the Examining Division's decision of 23 March 2005 be set aside and a European patent be granted on the basis of the presently pending application documents, that is claims 1-7 as filed on 14 October 2004 in combination with the remaining originally filed application documents as far as they have not been replaced by new description pages 4, 4a, 5 and 6 filed on 31 January 2005.

2. That the appeal fee be reimbursed under Rule 67 EPC 1973.

Reasons for the Decision

1. The appeal is admissible.
2. The first question to be decided in this appeal is whether the first instance decision was sufficiently reasoned. Therefore the board has to establish whether the impugned decision complies with the relevant provisions of EPC 1973, in force at the date of said decision.

Compliance with Rule 68(2) EPC 1973

3. According to Rule 68(2) EPC 1973 the decisions of the European Patent Office open to appeal shall be reasoned. The function of appeal proceedings is to give a judicial decision upon the correctness of a separate earlier decision taken by a first instance department (see inter alia T 34/90 (OJ EPO 1992, 454) and G 9/91 (OJ EPO 1993, 408)). A reasoned decision issued by the first instance department meeting the requirements of Rule 68(2) EPC 1973 is accordingly a prerequisite for the examination of the appeal.
4. In the present case the Examining Division, in response to the appellant's request "*to render a decision on the record*", refused the application using EPO form 2061 for a so-called "decision on the state of the file". The Guidelines for Examination in the EPO (June 2005) E-X 4.4, state: "Applicants may request a decision 'on the file as it stands' or 'according to the state of the file', e.g. when all arguments have been sufficiently put forward in the proceedings and the applicant is interested in a speedy appealable decision."

In such a case, the decision will be of a standard form, simply referring to the previous communication(s) for its grounds and to the request of the applicant for such a decision."

This standard form is entirely appropriate in the special case where the Examining Division fully expressed and reasoned its objections to the current application text in the preceding communication(s) taking into account the applicant's submissions, and the applicant has not presented further counter-arguments in the reply in which it requests a decision according to the state of the file.

A number of decisions of the EPO Boards of Appeal have pointed out however that a decision form which refers to several communications, leaving it to the board of appeal and the appellant to speculate as to which of the reasons given by the Examining Division in its communications might be essential to the decision to refuse the application does not meet the 'reasoned' requirement of Rule 68(2) EPC 1973 (see T 861/02, T 897/03, T 276/04 and T 1309/05).

5. In its letter of 14 October 2004, the appellant limited the claimed subject-matter by further adding the feature of the "capacity of the upper bag segment being 20 to 40 liters" and explained why the subject-matter was inventive over a combination of D1 with D6 or D7. The appellant explained in particular that D1 did not disclose any capacity for the upper and lower bag segments and that D6 and D7 although disclosing capacities, did so only for airbags having one bag segment, so that these documents could not render

- obvious the particular capacities as claimed which allow to reliably inflate both segments at a high speed even with a low-output inflator.
6. In the annex to the summons the Examining Division raised for the first time an objection of lack of clarity in respect of the terms "capacity of lower bag segment" and "capacity of upper bag segment". These terms were considered to be unusual parameters in the sense of Guidelines C-III, 4.7a since no comparison with the prior art could be made. These parameters thus would disguise a lack of novelty as per Guidelines C-IV 7.5. However no further explanation was given as to why these specific terms would fall under the concept mentioned in the Guidelines. This was probably meant to be discussed at the oral proceedings. The same is true for the conditional objection of lack of inventive step since it was simply stated that the capacities given would be common values.
 7. With its reply of 31 January 2005 the appellant filed amended pages of the description as replacement pages for description pages 4 to 6 then on file. The appellant explained why in its opinion the subject-matter of claim 1 on file was novel and inventive and why the clarity objection raised in the annex to the summons was not justified. In particular the appellant explained that the capacities could be clearly and reliably determined by objective procedures which are usual in the art and that the skilled man would not unavoidably arrive at these values when carrying out the invention of D1.

8. The decision of the Examining Division however does not contain any specific reasons, but merely refers to the communications (including the annex to the summons) which had been issued before the appellant's reply of 31 January 2005. By not commenting on the amended pages of the description and/or on any of the counterarguments brought forward by the appellant in its last reply it is left to the board and to the appellant to speculate as to which were the decisive reasons for the refusal. As a matter of fact several options could be possible: it could well be that the Examining Division no longer upheld the lack of clarity objection but considered the lack of inventive step detrimental or that clarity and novelty of the subject-matter of claim 1 was at stake, or even that only the amended description was not considered allowable.

9. This is at odds with the established jurisprudence of the boards of appeal that for the requirements of Rule 68(2) EPC 1973 to be fulfilled the decision must include, in logical sequence, the arguments justifying the order. The grounds upon which the decision is based and all decisive considerations in respect of the factual and legal aspects of the case must be discussed in detail in the decision (see T 278/00 (OJ EPO 2003, 546)). The applicant's request "to render a decision on the record" is not to be construed as a waiver of the right to a fully reasoned first instance decision, even in the light of the suggested procedure in the Guidelines (see T 1309/05, T 583/04). The applicant even expressly requested that "the subject-matter of the present claims be re-examined taking into account the following explanations". In view of this and of the fact that amended pages of the description were filed

the board is of the opinion that a decision of a standard form, simply referring to the previous communications for its grounds and to the request of the applicant for such a decision was not appropriate in the present case. Instead, in its decision, the Examining Division should have explained the very reason or reasons for its decision and why the counterarguments of the applicant were not considered convincing. By failing to do so the Examining Division did not issue a reasoned decision within the meaning of Rule 68(2) EPC 1973 and committed, therefore, a substantial procedural violation.

Right to be heard (Article 113(1) EPC 1973)

In the communication annexed to the summons to the oral proceedings, the Examining Division raised a clarity objection. In the absence of any indication to the contrary, the board and the party must assume that this was part of the reasons for the refusal.

10. Article 113(1) EPC 1973 requires that a decision be based on grounds on which a party has had an opportunity to present its comments. The right to be heard also guarantees that grounds put forward are taken into consideration (see T 94/84 (OJ EPO 1986, 337)). In the present case the Examining Division neglected arguments which have been stated in a clear fashion. This has the same effect as if the applicant had not been allowed to put them forward at all. The impugned decision does not deal with the counterarguments of the appellant concerning the objection of lack of clarity. There is also no reasoning as to why the Examining Division cannot

accept the arguments of the appellant submitted in its last reply in favour of inventive step.

11. In addition it is clear that the statement of the Examining Division in the appealed decision that no comments or amendments had been filed by the appellant in reply to the last communication is not correct and clearly indicates that the Examining Division considered neither the amended pages of the description nor the appellant's arguments filed with its last reply, in particular in relation to the objection of lack of clarity made for the first time in the preceding Examining Division's communication.

The absence of any indication of the consideration of the amended pages of the description or the appellant's arguments put forward in its last reply constitutes a violation of Article 113(1) EPC 1973.

Remittal to the first instance

12. Pursuant to Article 11 of the Rules of Procedure of the Boards of Appeal in the version which entered into force on 13 December 2007 (OJ EPO 2007, 536), when fundamental deficiencies are apparent in the first instance proceedings, the case is remitted to the first instance for further prosecution.

In the present case the first instance proceedings infringed Article 113(1) EPC 1973 and Rule 68(2) EPC 1973, and no special reasons being present in the file or having been mentioned by the appellant for doing otherwise, the remittal is justified.

Reimbursement of the appeal fee (Rule 67 EPC 1973)

13. The appeal is allowed insofar as the decision under appeal is set aside. Since the decision of the first instance clearly contravened Rule 68(2) EPC 1973 and Article 113(1) EPC 1973, and the appellant had to appeal in order to obtain a fully reasoned decision considering its amended description and its counterarguments it is equitable to reimburse the appeal fee pursuant to Rule 67 EPC 1973.

Order

For these reasons it is decided that:

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

The Registrar

The Chairman:

A. Vottner

S. Crane