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**Datasheet for the decision
of 4 February 2020**

Case Number: T 0155/18 - 3.2.01

Application Number: 07721824.6

Publication Number: 2040943

IPC: B60C23/00, B60C15/024

Language of the proceedings: EN

Title of invention:

A CHAMBER OF A PERISTALTIC PUMP FOR TIRE PRESSURE ADJUSTMENT

Patent Proprietor:

Coda Innovations s.r.o.

Opponent:

The Goodyear Tire & Rubber Company

Headword:

Relevant legal provisions:

EPC Art. 100(c), 123(3), 123(2)

Keyword:

Grounds for opposition - subject-matter extends beyond content
of earlier application (yes)

Amendments - inescapable trap (yes)

Decisions cited:

G 0001/93, G 0002/10

Catchword:



Beschwerdekammern

Boards of Appeal

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Case Number: T 0155/18 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 4 February 2020

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
17 November 2017 concerning maintenance of the
European Patent No. 2040943 in amended form.**

Composition of the Board:

Chairman G. Pricolo
Members: J. J. de Acha González
A. Jimenez

Summary of Facts and Submissions

- I. The appeal of the opponent lies against the decision of the Opposition Division concerning the maintenance in amended form of the European patent 2 040 943 based on the international application published under the international publication number WO 2007/134556 A1.
- II. In its decision, the Opposition Division held among others that the subject-matter of claim 1 of the main request, whose wording is identical to that of granted claim 1, did not represent an inadmissible extension of the application as originally filed (Article 100(c) EPC).
- III. Oral proceedings were held before the Board on 4 February 2020.

The appellant (opponent) requested that the decision under appeal be set aside and that the European patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed (main request) or in the alternative that the patent be maintained in amended form in accordance with the claims of one of the auxiliary requests I and II initially filed with its submission of 8 August 2017 during the opposition proceedings and filed again with letter of 3 December 2019 .

- IV. Claim 1 of the main request reads as follows (feature underlined by the Board):

"A chamber with shape memory for the pressure correction in a tire, which is a part of the tire or

adjacent to the tire wall and is connected with the interior of the tire on one end and with the external environment on the other end, the chamber (1) being in the shape of a curved hollow channel and being placed in the area of the tire side wall (4) at its bead, ***characterised in that*** it has at least one its enclosing wall formed at least by a part of a pair of surfaces (10) lengthwise coplanar with the chamber (1) and making an angle $\alpha = 0$ to 120° , where if the angle $\alpha > 0^\circ$, it is at the connecting edge of these surfaces (10), located on the further side from the center of the surface of the chamber (1) cross-section, the chamber has a width of 0.1 mm to 200 mm and thickness of 0.01 to 100 mm."

Claim 1 of the auxiliary request I differs from claim 1 of the main request in that after the wording "the chamber", coming after the last comma in the claim, the following feature has been added: "being realized by means of a matrix (9) which".

Claim 1 of the auxiliary request II differs from claim 1 of the auxiliary request I in that it further includes at its end the following feature: "and the chamber has a width of 0.1 mm to 200 mm and thickness of 0.01 to 100 mm."

Reasons for the Decision

1. Main request - Inadmissible extension
- 1.1 The subject-matter of claim 1, which is identical to that of claim 1 as granted, goes beyond the content of

the application as originally filed and, consequently, the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent according to the main request.

1.2 Claim 1 includes with respect to claim 1 as originally filed among others the following additional feature:

- (i) the chamber has a width of 0.1 mm to 200 mm and thickness of 0.01 to 100 mm.

1.3 In the respondent's view the specific dimensions for the chamber cross section derive directly and unambiguously from the disclosure of the application as originally filed (passages of the granted patent were cited when referring to the application as originally filed since their exact wording is present in the publication of the international application; analogously in the following reference is made to the patent specification). In particular, this subject-matter finds its basis in paragraphs 15, 16, 31, 35, 41, 42, 46, 83 and 84, together with the figures 3 a) to 6 e) of the patent specification and claim 9 as originally filed. There is a clear and direct correspondence between the relevant dimension (thickness and width) of the matrix and the chamber. A person skilled in the art does therefore not see any differences in the matrix or chamber width and thickness dimensions. Possible shrinking, deformations, etc. do not rely on information from the patent application and should be considered as mere speculation. These passages give the skilled person the information that the matrix and the chamber have the same thickness and width because the matrix is used for forming the chamber (negative-positive shape forming relationship). There is a correspondence between the

shape, namely width and thickness of the matrix on the one hand and the width and the thickness of the chamber of the tire on the other hand.

The Opposition Division in its decision concluded also that the specific dimensions of the chamber were originally disclosed since claim 9 as filed taught the skilled person that the resulting chamber dimensions can vary within the disclosed range values for the matrix and par. 41 and 42 confirmed that the size of the chamber fell within the claimed ranges.

1.4 The standard to assess whether the subject-matter of an amended patent goes beyond the content of the application as originally filed is the "gold standard", namely if that subject-matter is directly and unambiguously derivable by a skilled person, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as originally filed (see e.g. point 4.3 in the Decision of the Enlarged Board of Appeal G 2/10, OJ EPO 2012, 376).

1.5 Bearing in mind this criteria, the Board does not share either the view of the respondent or that of the Opposition Division in its decision.

The claimed dimensions of the chamber are nowhere in the originally filed application either explicitly or implicitly disclosed to the skilled person. The specific dimensions disclosed throughout the application as originally filed refer only to the matrix used to form the chamber during the manufacturing process of the tire and before vulcanization. Then vulcanization takes place and the matrix is removed. However, as defended by the

appellant, a link is missing that confirms that the specific dimensions of the matrix and the final dimensions of the chamber claimed are the same. On the contrary (see e.g. par. 16 of the patent specification) the dimensions of the chamber, i.e. before loading and after fitting the tire onto the rim, need not be identical to those of the matrix since the chamber wall surfaces will take the working position and the chamber cross-section will correspond to the required chamber cross-section before loading. In the cited passages it is not disclosed that the dimensions of the produced chamber are identical to those of the matrix used for its production. According to par. 16 and 46 it is only the member that has the cross section identical to that of the chamber but not the matrix.

The Board agrees with the respondent that the cross-sectional shape, i.e. the form, of the matrix is preserved to some extent for the created chamber after removal of the matrix following vulcanization. However, it cannot be said that the specific dimensions of the chamber produced correspond exactly to those of the negative shape of the matrix used for its manufacturing. As pointed out by the appellant, a multiple number of factors known to the skilled person may deviate the final cross-sectional dimensions of the produced chamber from those of the matrix used after removal following vulcanization. The composition of the rubber used (i.e. shrinkage, behaviour during vulcanization) and the geometry of the tire and chamber can lead to dimensions in width or thickness that are smaller or bigger than those of the matrix employed. This does not amount to speculation but to common general knowledge of the skilled person.

2. Auxiliary requests I and II

2.1 According to claim 1 of auxiliary request I the above mentioned conflicting feature (i) from claim 1 of the main request has been deleted and replaced by a feature according to which the specific cross sectional dimensions of width and thickness are no longer those of the chamber but only the dimensions of the matrix used for manufacturing the chamber.

Claim 1 of auxiliary request II contains both features: feature (i) from claim 1 of the main request as well as the above mentioned additional feature of the auxiliary request I, so that according to claim 1 of the auxiliary request II the chamber has a width of 0.1 mm to 200 mm and thickness of 0.01 to 100 mm and the chamber is realized by means of a matrix with a width of 0.1 mm to 200 mm and thickness of 0.01 to 100 mm.

2.2 As reasoned above under point 1 it does not derive directly and unambiguously from the application as originally filed that the claimed cross sectional dimensions of the chamber are identical to those of the matrix used for manufacturing the chamber. The link is missing and is not derivable for the skilled person in the application documents as originally filed.

Consequently, the subject-matter of claim 1 of auxiliary request I is not limited anymore to a chamber exhibiting the specific dimensions of the chamber according to feature (i) of claim 1 as granted (identical to claim 1 of the main request).

2.3 According to the decision of the Enlarged Board of Appeal G 1/93 (see order point 1.) if a European patent as granted contains subject-matter which extends beyond

the content of the application as filed in the sense of Article 123(2) EPC and which also limits the scope of protection conferred by the patent, such patent cannot be maintained in opposition proceedings unamended, because the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent. Nor can it be amended by deleting such limiting subject-matter from the claims, because such amendment would extend the protection conferred, which is prohibited by Article 123(3) EPC. Such a patent can, therefore, only be maintained if there is a basis in the application as filed for replacing such subject-matter without violating Article 123(3) EPC.

- 2.4 It follows that in the present case the subject-matter of claim 1 of the auxiliary request I contravenes Article 123(3) EPC since feature (i) has been deleted and accordingly the extent of protection conferred by the granted patent has been extended. Claim 1 of auxiliary request II includes feature (i) and for the same reasons as for the main request its subject-matter extends beyond the content of the application as originally filed in the sense of Article 123(2) EPC.

Finally, it is noted that the exception under point 2 of the order of the decision G 1/93 does not apply in the case at hand, since feature (i) which has not been disclosed in the application as filed provides undoubtedly a technical contribution to the subject-matter of the claimed invention.

Order

For these reasons it is decided that:

3. The decision under appeal is set aside.

4. The patent is revoked.

The Registrar:

The Chairman:



D. Magliano

G. Pricolo

Decision electronically authenticated