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Chambres de recours



Case Number: T 161 /82

DECISION
of the Technical Board of Appeal 3.5.1
of 26 June 1984

Appellant: AMP INCORPORATED
Eisenhower Boulevard
Harrisburg Pennsylvania
USA

Representative: Gray, Robin Oliver
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Decision under appeal: Decision of Examining Division 053 of the European Patent
Office dated 7 August 1982 refusing European patent
application No 80301975.1 pursuant to Article 97(1)
EPC

Composition of the Board:

Chairman: G. Korsakoff
Member: J. van Voorthuizen
Member: P. Ford

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non



Aktenzeichen / Case Number / N° du recours : T 161/82

Anmeldenummer / Filing No / N° de la demande : 80301975.1

Publikations-Nr. / Publication No / N° de la publication : 0021730

Bezeichnung der Erfindung: Electrical contact capable of receiving a mating
Title of invention: contact in either of two mutually perpendicular
Titre de l'invention : orientations

ENTSCHEIDUNG / DECISION

vom / of / du 26 June 1984

Anmelder/Patentinhaber:

Applicant/Proprietor of the patent: A M P INC.

Demandeur/Titulaire du brevet :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE

Articles 54(1)(2), 113(1)

"Novelty, anticipation of a chance nature"

"Basis of decision, opportunity to present comments"

Leitsatz / Headnote / Sommaire

- I. Article 113(1) EPC does not require that the applicant be given a repeated opportunity to comment on the argumentation of the Examining Division so long as the decisive objections against ~~the grant of the European patent remain the same.~~
- II. In cases where an anticipation is of a chance nature, in that what is disclosed in a prior document could accidentally fall within the wording of a claim to be examined for novelty without there being a common technical problem, a particularly careful comparison has to be made between what can fairly be considered to fall within the wording of the claim and what is effectively shown in the document.

Summary of facts and submissions

- I. European Patent Application No. 80 301 975.1 filed on 12.06.80 (Publication No. 0 021 730) claiming a priority of 29.06.79 (FR), was refused by a decision of the Examining Division 053 of the EPO of 27.08.82. That decision was based on the single claim filed on 17.05.82.
- II. The reason given for the refusal was that the subject-matter of the claim lacked novelty having regard to DE-A-1 465 461.
- III. The applicant lodged an appeal against this decision on 21.09.82. In the Notice of Appeal the grounds for the appeal were set out. The appeal fee was paid on 14.09.82.
- IV. The applicant argues essentially that the contact known from the DE specification is not suitable for receiving a male contact in either of two mutually perpendicular orientations. In particular (as was pointed out for the first time in the Notice of Appeal) the contact in question would not provide an acceptable electric connection as it is clearly shown in this document that the second slot is parallel sided. Furthermore there is no suggestion in any of the cited documents which would suggest a modification to make this slot suitable for receiving a male contact.
- V. With the Notice and Grounds of Appeal the applicant submitted an amended claim, "in view of the argument relied on in the decision to refuse". He requested that

a European patent be granted on the basis of this claim which reads as follows:

"An electrical contact having a contact portion (2) comprising two pairs of opposed cantilever contact arms (22) all extending in the same direction, each arm (22) of each pair presenting a contact projection (23) to a similar projection (23) on the opposed arm (22), the two pairs of opposed arms (22) defining a common male-contact-receiving slot, characterised in that each arm (22) of each pair presents a second contact projection (24) of a similar projection (24) on an adjacent arm (22) of the other pair, the two pairs of second contact projections (24) defining a second male-contact-receiving slot which is perpendicular to the first such slot".

- VI. The applicant alleges that certain "technical facts" relied on by the Examining Division are not facts and that he was not previously given an opportunity to comment thereon. He submitted that the requirements of Article 113(1) EPC had not been met and requested a refund of the appeal fee.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. The Examining Division has based its decision on the disclosure in DE-A-1 465 461. In Fig. 1 to 3 of this document an electrical contact is shown which bears a resemblance to the electrical contact described in the single claim of the present application filed on 17.05.82 and which comprises a second slot perpendicular

to a first one. It is clear that the first slot is intended to receive a male contact but the essential question to be examined is whether the second slot also constitutes a "male contact receiving slot" i.e. whether it would be evident to a person skilled in the art that the slot could serve this purpose.

3. In considering this question it has to be borne in mind that the DE document is concerned with the solution of a problem totally different from that stated in the present application, viz to provide a female contact in which either a round or a flat male contact can be inserted.
4. In particular, in cases where the anticipation is of a chance nature in that what is disclosed in a prior document could accidentally fall within the wording of a claim to be examined for novelty without there being a common technical problem, a particularly careful comparison has to be made between what can fairly be considered to fall within the wording of the claim and what is effectively shown in the document.
5. When carrying out the comparison in the present case it is found that in the contact shown in DE-A-1 465 461 no flared or otherwise formed lead-in portion for the second slot is present and that the "contact surfaces" are strictly parallel sided over their entire longitudinal dimension. This practically excludes the possibility of regarding the second slot as "male contact receiving". Accordingly, the Board is of the opinion that the contact according to the claim before the Examining Division has to be regarded as novel over the cited DE specification.

6. This is true a fortiori for the contact according to the amended claim submitted with the Notice and Grounds of Appeal, in which it is now specified that "contact projections" are provided, which are definitely not present in the contact shown in the DE-specification.
7. Although the contact according to this amended claim is novel, it still has to be examined whether the claim satisfies the other requirements of the EPC, in particular whether inventive step is involved. In the procedure before the Examining Division this aspect has not been considered at all as far as the subject-matter of the then valid claim was concerned. In order not to deprive the applicant of his right to an examination in two instances the Board deems it appropriate to remit the application to the Examining Division for further prosecution.
8. The applicants contended in paragraph 4 on page 3 of the Notice of Appeal, that the requirements of Article 113(1) EPC have not been met, so that there had been a substantial procedural violation by the Examining Division (Rule 67 EPC). The Board considers that a distinction has to be made between the grounds on which a decision is based (i.e. the requirements of the EPC which are not satisfied by the application or the invention to which it relates) and the reasoned statement explaining in greater detail why the Examining Division is of the opinion that such grounds exist (cf. Rule 51(3) EPC).
9. The ground for rejection in the present case being lack of novelty in the subject-matter of the claim it is to be noted that this objection was raised and amply argued in the first communication by the primary examiner of

19.02.82. The applicant commented thereon in a letter of 17.05.82 and submitted an amended single claim differing from the previous claim 1 by the addition of two further features in order, as the applicant stated, to distinguish the invention more clearly from the prior art. In his comments the applicant merely observed that the Examiner's suggested use of the contact according to DE-A-1 465 461 was based on hindsight and that this use would not have been considered since the contact of Fig. 4 and 5 clearly cannot be used as suggested.

10. The Examining Division considered that the two added features were already implicitly disclosed to the person skilled in the art by the DE specification. The Division not being convinced by applicant's arguments and having found that the same objection as before still existed against the amended claim thereupon issued the decision under appeal. This decision contained as a matter of course some supplementary arguments concerning the features added to the claim.
11. The Board of Appeal takes the view that Article 113(1) does not require that the applicant be given a repeated opportunity to comment on the argumentation of the Examining Division so long as the decisive objections against the grant of the European patent remain the same.
12. In the circumstances of the present case, therefore, the Board considers that there was no contravention of Article 113(1) EPC.

Order

It is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution on the basis of the description and claim as amended in accordance with the applicants' Notice and Grounds of the Appeal filed on 21.09.82.
3. The applicants request for refund of the appeal fee is dismissed



BF

J. Gee

G. Korsakoff