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Bezeichnung der Erfindung: Electrical connector

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : HO1R13/115

ENTSCHEIDUNG / DECISION

vom / of / du 23 July 1985

Anmelder / Applicant / Demandeur:

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

A M P Incorporated

Einsprechender / Opponent / Opposant :

Kabelwerke Reinshagen GmbH.

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Art. 54

"Novelty"

Leitsatz / Headnote / Sommaire

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Case Number: T 133 / 83

DECISION
of the Technical Board of Appeal 3.5.1
of 23 July 1985

Appellant:
(Proprietor of the patent) AMP INCORPORATED
Eisenhower Boulevard,
Harrisburg
Pennsylvania
U S A

Representative: R.O. Gray
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Respondent:
(Opponent) Kabelwerke Reinshagen GmbH
Reinshagenstr.1
5600 Wuppertal 21

Representative: -.-

Decision under appeal:

Decision of the Opposition Division of the European Patent Office
dated 4 July 1983 revoking European patent No.
0 001 159 pursuant to Article 102(1) EPC

Composition of the Board:

Chairman: G. Korsakoff
Member: W. Oettinger
Member: F. Benussi

Summary of Facts and Submissions

I. The decision to grant the European patent 0 001 159 based on the application No. 78 300 281.9 claiming a French priority of 9.9.77 was published on 3.3.82.

II. Claim 1 as granted reads :

"An electrical connector comprising a receptacle contact contained in a one-piece insulating housing and defining a male-contact-receiving passage, the receptacle contact having an outwardly directed projection engageable with a surface of the housing, characterized in that the projection (9) of the receptacle contact is engageable with the surface (18, 32, 33) of the housing on movement of the receptacle contact relative to and within the housing, such engagement effecting an increase in the effective cross-sectional area of the male-contact-receiving passage (8) of the receptacle contact."

Claims 2 to 9 referring to Claim 1 are dependent claims concerning particular embodiments of the claimed connector.

III. Admissible notice of opposition was filed on 2.12.82.

In his statement of grounds for an opposition, the Opponent stated that the subject-matter of the patent was not patentable (Art. 52 EPC), in particular that the subject-matter of Claim 1 lacked novelty with respect to a prior connector disclosed in the document US-A-3 796 987 (Art. 54 EPC) and that the subject-matter of the dependent claims did not involve an inventive step having regard to the state of the art (Art. 56 EPC).

- IV. In his reply the Proprietor of the patent submitted that there was no ground for opposition and that the subject-matter of all the claims was new and involved an inventive step.
- V. On 4.7.83 the Opposition Division revoked the patent on the finding that the connector defined by Claim 1 was not new.

This decision rejected also a request of the Proprietor of the patent for an award of costs in his favour.

- VI. The Proprietor of the patent lodged an appeal against this decision on 16.7.83, filed simultaneously a statement of grounds and paid the appeal fee.

He stated that Claim 1 must be interpreted with limitations appearing in the text of the patent specification and relating to a one-piece construction of the receptacle contact which solves a problem arising on insertion of the male contact into the receptacle contact. In order to make this clear, he proposed to amend Claim 1 by two insertions limiting the claim in this sense.

Claim 1 as amended reads :

"An electrical connector comprising a one-piece receptacle contact contained in a one-piece insulating housing and defining a male-contact-receiving passage, the receptacle contact having an outwardly directed projection engageable with a surface of the housing, characterized in that the projection (9) of the receptacle contact is engageable with the surface (18, 32, 33) of the housing on movement of the receptacle contact relative to and within the housing, such movement being caused by engagement between the receptacle contact and a male contact being mated with the receptacle

.../...

contact when the male contact is moved relative to the housing and into the male-contact-receiving passage (8) of the receptacle contact, such engagement effecting an increase in the effective cross-sectional area of the male-contact-receiving passage (8) of the receptacle contact."

The Appellant requested cancellation of the entire decision.

He further submitted that the appeal fee should be refunded at least in part and requested oral proceedings if such would be beneficial.

VII. In his response of 23.12.83 the Respondent submitted that the Appellant had to prove that the inserted feature has been disclosed as an essential part of the invention ("erfindungswesentlich").

He requested the rejection of the appeal in its entirety or - as a subsidiary request - remittal of the case to the Opposition Division.

He further requested an award of costs incurred during the opposition and appeal procedures.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. The Respondent's submission of 23.12.83 states that Claim 1 as amended is not admissible under Article 123(2) and/or(3) EPC.

Such objection is not well-founded.

.../...

The "one-piece" limitation of Claim 1 is based on the fact that the portions (1, 2) of the receptacle contacts of both the first and the second embodiments of the claimed connector shown in Figures 1 and 10 are disclosed to be "integrally formed from sheet metal" (cf. patent specification col. 3 lines 42-46 and col. 6 lines 21-24 and a similar passage in the description as originally filed) and thus "one-piece".

Moreover, this feature appears implicit in Claim 3 if one considers that receptacle contacts intended to be used with flat tab male contacts for practical reasons must be, and usually are, of a one-piece type (see for instance the documents cited in the pre-grant procedure and all other documents cited in the search report). Articles 123(2) and (3) EPC do not appear in the present case to require that the one-piece receptacle contact is stated to be an essential part of the invention.

The limitation of Claim 1 to the "on insertion" problem solution is based on a statement in the description both as granted (cf. col. 2 lines 31-37) and as initially filed (cf. page 2 lines 25-30) that such problem solution is preferred.

Moreover, this feature is clearly disclosed as essential to the invention in those passages of the description relating to the function and to the advantages of the invention and additionally can be derived from figures 4 and 13 (reference numerals 18 and 33 resp.).

Claim 1 as amended is therefore admissible under Article 123 EPC.

.../...

3. The Respondent has not questioned that the amendments to Claim 1 as filed by the Appellant are such that the lack of novelty objection (Art. 54 EPC) on which the decision under appeal was based has been overcome.

Indeed the subject-matter of Claim 1 as amended is new.

The receptacle contact of the connector known from US-A-3 796 987 is clearly neither "one-piece" nor such that "on insertion" of the male contact into the receptacle contact, by way of an engagement of the projection of the receptacle contact with the surface of the housing, the effective cross-sectional area of the male-contact-receiving passage of the receptacle contact is increased.

4. So far, an inventive step examination (Art. 56 EPC) has not taken place. The decision under appeal does not declare whether the patent as a whole contains any subject-matter which in addition to being novel also involves an inventive step (Art. 56); in other words, whether an envisageable new Claim 1 admissibly amended in a way just sufficient to overcome the novelty objection, by way of a limitation in the sense of any of the dependent claims or any passage in the description or disclosure in the drawings, would or would not be objectionable for obviousness having regard to the US citation taken either alone or in combination with other citations. Neither in a communication nor in the decision have the Opposition Division given any hint of their opinion in this respect.
5. The inventive step examination differs substantially from the novelty examination. While the novelty examination is restricted to a mere identity comparison of the features of the claimed subject-matter with the features of one single prior art disclosure, the inventive step examination goes much further in that, first, also features similar to those

claimed but known per se from other documents are taken into consideration, and secondly, the particular problem to be solved by the claimed features has to be compared with the problem solved by corresponding prior art features in their own context.

6. In view of these differences the Board does not consider it appropriate to give an opinion or to finally decide on this point in the course of the present appeal. As the Opposition Division, acting as the first instance, has not decided the inventive step question, an opinion or decision of the Board on this point would deprive the parties of a normal two-instance procedure and in particular the losing party of the possibility of having the inventive step decision reviewed by a second instance.

It is therefore deemed appropriate to remit the case to the Opposition Division for further prosecution, in particular the inventive step examination.

7. As in the decision under appeal the grounds for revoking the patent were confined to the lack of novelty objection and in this respect the appeal was successful, Appellant's subsidiary request for oral proceedings is considered settled as far as this appeal procedure is concerned. A discussion about inventive step in an oral proceeding, if any, would have to take place before the division competent for that question.
8. The fact that the first instance made no express decision about the dependent claims is not regarded as a substantial procedural violation rendering the reimbursement of the appeal fee equitable (Rule 67 EPC).

The decision under appeal is to be seen in the light of the Proprietor's statement in his response to the opposition that an amendment of Claim 1 is not proposed, and his not filing or suggesting an amendment as a subsidiary request. The Opposition division was not obliged to examine an envisageable claim not on file, although such procedure would, as the present case has shown, have been more efficient.

9. The requirements for a positive decision on the Respondent's request for costs are not met (Article 104(1) EPC).

Order

For these reasons it is decided that :

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution on the basis of Claim 1 and the description as amended in accordance with the Appellants' notice and grounds of the appeal filed on 16.7.83, and Claims 2 to 9 and the drawings as granted.
3. The Appellant's request for reimbursement of the appeal fee is rejected.
4. The Respondent's request for costs is rejected.

The Registrar

B A Norman

The Chairman

G Korsakoff