BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

A		B		C	X

File Number: T 179/91 - 3.5.1

Application No.: 82 102 204.3

Publication No.: 0 061 662

Title of invention: Preformed integral covering, particularly for motor vehicle gear shift levers

Classification: G05G 1/04

D E C I S I O N
of 3 February 1993

Applicant: Lear S.n.c. di Foggini & C.

Opponent: Bayerische Motoren Werke Aktiengesellschaft

Headword:

EPC Article 56, 84, Rule 29

Keyword: "Clarity of claim (yes) - interpretation by skilled person will be as submitted" - "Two-part form (appropriate)" - "Inventive step (yes) - new feature unobvious"

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number : T 179/91 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 3 February 1993

Appellant : (Opponent)
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Representative :

Respondent : (Proprietor of the patent)
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Decision under appeal :
Interlocutory decision of the Opposition Division of the European Patent Office dated 27 December 1990 concerning maintenance of European patent No. 0 061 662 in amended form.

Composition of the Board :

Chairman : P.K.J. van den Berg
Members : W.B. Oettinger
E.M.C. Holtz

Summary of Facts and Submissions

I. The appeal contests the Interlocutory Decision of the Opposition Division stating that, taking into consideration the amendments made during the opposition proceedings, the European patent No. 0 061 662 and the invention to which it relates are found to meet the requirements of the Convention.

The patent had been granted on European patent application No. 82 102 204.3 filed on 18 March 1982 claiming a priority of 1 April 1981.

The admissible opposition was based, referring to the ground mentioned in Article 100(a) EPC, on the contention that its subject-matter lacked an inventive step (Article 56), having regard to the following prior art documents:

D1: DE-A-2 252 392 (cited in the patent);

D2: US-A-4 178 806;

D3: DE-U-1 905 361;

D4: US-A-2 121 989;

D5: US-A-2 272 897.

The decision under appeal was taken on the basis of the following patent documents:

Claims: 1 filed on 24 September 1990,
2 to 6 as published;

Description: columns 1 and 2 filed on 23 October 1990, column 3, lines 1 to 9, as published;

Drawings: sheet 1 and 2 as published.

Claim 1 reads as follows:

"A gear shift lever covering having a sleeve portion (11) which, in use, covers at least the upper part (20) of the rod of the gear shift lever, and a bellows-like portion (13) which, in use, covers at least the zone of the articulation joint of the lever, the covering having a top portion of knob-like shape (12) defined by a cup-like formation at the upper end of and integral with said sleeve portion (11), the interior of said cup-like formation of the covering (10) defining a hollow space which, in use of the covering, is above the upper part (20) of the lever rod, characterized in that

a) said bellows-like portion (13) is an integral part of said sleeve portion (11) so that said bellows-like portion (13), said sleeve portion (11) and said cup-like formation constitute a one piece-member, and

b) within said hollow space an insert formation (15) is arranged in mating engagement with the interior of said cup-like formation, which insert formation, in use of the covering, is fitted on the upper part (20) of said rod, and in that said insert formation (15) and said single piece member are made of polymeric material and have structurally a mutual co-moulded relationship."

In the decision, the Opposition Division held that the subject-matter of this claim involves an inventive step because, starting from the background art given by

D0: DE-A-2 353 417 (cited in the patent),

it is not rendered obvious by other relevant prior art, constituted in particular by D2 and by:

D6: DE-A-1 655 821 (cited in the Search Report).

According to the minutes of oral proceedings, in which the decision was announced, D1 was also considered, but D3, D4 and D5 were regarded as not relevant enough for having to be considered in detail.

Certain documents (D7 to D10) cited, either by the Patentee or by the Opponent, after expiry of the time limit for opposition were also not considered in detail in the decision under appeal.

II. The Interlocutory Decision, with its reasons enclosed, was posted on 27 December 1990.

The appeal was lodged by the Opponent (in German) on 27 February 1991, and the respective fee was paid on the same day. The Notice of Appeal contains a request that the decision be set aside in its entirety and the patent revoked.

On 23 April 1991, the Appellant filed a Statement of Grounds.

III. In the Statement of Grounds, the Appellant cited another five documents (A1 to A5) of which, however, only four belong to the prior art and only the following ones were considered, in a Communication, by the Board as being relevant enough for having possibly to be taken into account:

D11: Behelfskatalog BMW 1502 1602 1802 2002, Band 2, V/1975, sheet 51/78;

D12: Behelfskatalog BMW 316/318 320, Ausgabe A, VII/1976, sheet 51/27.

IV. The Respondent in reply disputed the Appellant's argumentation and requested approval of the Interlocutory Decision by rejection of the appeal.

As an auxiliary request ("if, for a decision favourable to the patent proprietor, further clarifications were required"), he requested oral proceedings.

V. After an exchange of substantive submissions, the Respondent and the Appellant were given an opportunity again to present their comments on each others' submissions, which they did on 12 and 17 November 1992, respectively.

Relevant details of these submissions will be found in paragraphs 3 to 6 below.

Reasons for the Decision

1. The appeal (cf. paragraph II) is admissible.

2. Amendments

The Interlocutory Decision implies that the Opposition Division considered the amendments made to the patent, in particular to Claim 1, to be admissible both under Article 123(2) and 123(3) EPC.

The Board agrees with this view.

3. Form of Claim 1

In respect of the two-part form of Claim 1, the Board concludes as follows:

3.1 Among all those prior art documents which were either re-cited or newly cited in the appeal, only D0, D1 and D6 disclose gear shift lever coverings. For the question of which document comes "nearest" to the claimed invention and can therefore serve as the "starting point", only these will thus have to be considered.

3.2 From D0, used for formulating the preamble of Claim 1, a gear shift lever with a covering as defined in this preamble (cf. paragraph I above) is known (cf. Fig. 1), but the characterizing features a) and b) of that claim are not derivable from D0.

3.3 D1 shows only the upper part of a gear shift lever. Therefore it shows the sleeve portion of its covering but not a bellows-like portion as mentioned in the preamble of Claim 1.

An insert formation as mentioned in feature b) is also shown in D1, but it is not derivable from D1 that this insert formation and the cup-like formation of the top portion of the covering would have "structurally a mutual co-moulded relationship".

3.4 D6 shows a gear shift lever with a covering having a sleeve portion and a portion covering the zone of the articulation joint of the lever. That portion is bell-like rather than bellows-like but otherwise these parts of the lever covering are substantially as defined in the preamble of Claim 1.

An insert formation as mentioned in characterizing feature b) is also shown in D6 (ref. no. 16), but it is not derivable from D6 that this insert formation and the cup-like formation of the top portion of the covering would have "structurally a mutual co-moulded relationship".

3.5 In coming to the conclusion (3.3 and 3.4) that neither in D1 nor in D6 there is "structurally a mutual co-moulded relationship" between the insert formation and the cup-like formation, the Board has taken into account that its doubts expressed in the Communication of 31 March 1992 about the significance of this expression have effectively been dispelled by the Appellant's own submissions:

In his response filed on 29 July 1992, he expressly confirmed that he accepted the term "co-moulding relationship" as having to be understood in the sense of a molecular bonding, and that he would regard such a molecular bonding as a connection which does not allow the insert (15) and the cup-like formation of the lever covering to be separated without destruction. Insofar, therefore, the Appellant and the Respondent are in agreement with each other. In these circumstances and because it appears credible that in a "co-moulding process", where the parts are moulded together, their bonding will inevitably be, due to molecular forces, so strong as submitted, the Board sees no longer any reason for disagreeing with this interpretation.

The expression "structurally a co-moulded relationship" being therefore interpreted in this sense, there is no doubt that this feature is neither known from nor implicit in either D1 or D6.

3.6 In his earlier submission filed on 23 April 1991, the Appellant expressed doubts as to whether, in this respect, Claim 1 is clear (Article 84 EPC). But on the basis of the Appellant's later submission of 29 July 1992, the Board is now convinced that the term "co-moulded relationship" must be understood as submitted (cf. 3.5). Any doubt as to clarity is therefore not left.

3.7 Considering that, as follows from this analysis (3.2 to 3.4), the lever of D0 does not, but the levers of D1 and D6 do, have an insert formation as claimed, it might well appear possible to use either D1 or D6 rather than D0 as a "starting point" coming nearer to the claimed lever covering.

On the other side, however, D1 and D6 do not show a bellows-like portion as claimed and shown in D0.

In these circumstances, the Board regards the chosen partitioning with respect to D0 as not clearly inappropriate. No objection arises, therefore, under Rule 29(1) EPC.

4. Disclosure

In his submission filed on 23 April 1991, the Appellant expressed also doubts as to whether the disclosure is sufficient (Article 83 EPC) in respect of the feature "structurally a mutual co-moulded relationship" as interpreted above (3.5).

It is noted, in this context, that the opposition was not based on the corresponding ground (Article 100(b) EPC). But the Board has nevertheless considered this point with the following result:

The expression "co-moulding (process)" has been used in Claims 3 and 4 and in the description (page 4 lines 12-13) as originally filed. In the absence of any further explanation as to its implementation, it is clear that in this respect the application relied, and the patent relies, on common general knowledge.

However, on the basis of the Appellant's as well as the Respondent's submissions (cf. 3.5), the Board has no doubt that the skilled reader's general knowledge would indeed include the effect of "molecular bonding" as a result of the "co-moulding process".

5. Novelty

It follows directly from the above considerations (3.1 to 3.6) that the claimed covering is new against any of the prior art documents to be considered.

6. Inventive step

On the basis of the facts on file and taking into account the arguments submitted by the parties, the Board's conclusion is that the claimed gear shift lever covering is to be regarded as involving an inventive step.

It has come to this conclusion substantially on the basis of the following considerations:

6.1 The first of the two characterizing features of Claim 1, a), is not rendered obvious by any of the documents disclosing gear shift lever covering, i.e. D0, D1 and D6.

In D0 and D6, the sleeve portions and the bellows-like or bell-like portions are not combined in a single piece member. It cannot therefore be derived from D1 either that

the skilled person would deviate from this teaching of D0 and D6 when complementing the upper part of the gear shift lever shown in D1 by a suitably constructed lower part.

6.2 The Appellant based his obviousness objection against the characterizing feature a) on D2, but the Respondent submitted that this document is from a very different field.

What D2 discloses is a toggle switch seal. It is clearly true that an electrical switch such as a toggle switch is something from a field quite remote from gear shift levers. It would therefore appear unlikely that a gear shift lever constructor would seek any suggestions from electrical switches.

On the other hand, electrical switches are also used in motor-cars and well-known to car constructors. It cannot even be excluded that a gear shift lever acts on an electrical contact. Moreover, the ultimate purpose of the seal of D2 and of the covering claimed in the patent-in-suit are essentially the same, viz. protection of the interior from, for instance, dust.

Even so, the aforementioned point of view would appear supported by the fact that the articulation joint to be protected would normally be, in the case of a gear shift lever, of quite a different quality and size than in the case of an electrical switch.

However, a final decision on the point of obviousness of feature a) from D2 does not factually appear to be required for the reasons to follow (6.6 ff).

6.3 D11 and D12 may be of the same field as the claimed invention.

However, in the Board's opinion, it is somewhat far-fetched to conclude from a general tendency of combining such parts of a car as the different portions of an instrument panel in a single-piece member, that it would be obvious to combine specifically the upper part of a gear shift lever covering and the bellows-like portion within a single-piece member.

But however this may be, it appears again, in fact, not to be required to give a final decision on this point, for the reasons to follow (6.6 ff).

6.4 No reference to the other prior art documents cited together with D11 and D12 (cf. III) is necessary for the same reason.

6.5 For characterizing feature b), neither D0 nor D2 nor any of the documents not concerning gear shift levers (D11, D12) is relevant.

6.6 What is relevant for feature b), are the insert formations in D1 (2) and D6 (16).

The cup-like formation of D1 is, and the insert formation (2) may be, of polymeric material. But nothing in D1 points to the possibility of structurally giving them a mutual co-moulded relationship, understood as molecular bonding (cf. 3.5).

Similarly, the cup-like formation (17) and the insert formation (16) of D6 may be of polymeric material but nothing points to their having structurally a mutual co-moulded relationship in the above sense (cf. 3.5).

6.7 It has been argued and is clearly true that molecular bonding belongs to common knowledge of the person skilled in the art. As already pointed out, the application and the patent rely on this fact (cf. paragraph 4).

However, the issue to be decided is whether the skilled person would find any incentive in the prior art, and thus a reason, for applying this feature in the particular case of the gear shift lever knob of D1 or that of D6. In the opinion of the Board, this is not the case for the following reasons (6.8, 6.9).

6.8 In the claimed invention, the feature that the insert formation and the cup-like formation have structurally a mutual co-moulded relationship has, as the skilled reader would realize, the evident purpose of inhibiting any mutual displacement of these formations. In the embodiments shown in Fig. 1 and 2 and in Fig. 6 of D1, such a problem is apparently not addressed. In the embodiments shown in Fig. 3 and 4 and in Fig. 5, a similar problem may be addressed and solved but only to a very imperfect extent in that it requires somewhat stronger forces for displacing the insert formation and the cup-like formation relatively to each other. Moreover, the imperfect solution of this partial problem is apparently more complicated from a technical point of view.

The claimed solution is, on the contrary, both technically easy to implement and perfect in that it effectively prevents any mutual displacement between the two formations. Since D1 does not in any way consider deviating from the teaching given by its Fig. 3 to 5 for achieving this effect only partially, it cannot be said to be obvious from D1 to give the insert formation and the cup-like formation "structurally a mutual co-moulded relationship".

6.9 The gear shift lever of D6 corresponds, in this respect, to the embodiment shown in Fig. 1 and 2, or Fig. 6, of D1, i.e. has no means whatsoever to prevent any mutual displacement between the insert formation and the cup-like formation. The claimed solution is not, therefore, obvious from D6 either.

6.10 D3, D4 and D5, which have not been re-cited in the appeal, do not appear to be of any more relevance for features a) and/or b) than documents D0, D1 and D6 considered above.

7. Conclusions

Claim 1 is therefore allowable and it follows that the Respondent's (main) request is allowable as a whole. His auxiliary request for oral proceedings (cf. IV) therefore need not be considered.

The Appellant's request has, on the contrary, to be rejected.

Order

For these reasons, it is decided that:

1. The appeal is dismissed.

2. The case is remitted to the first instance with the order to maintain the patent as amended, viz. on the basis of the documents recited in paragraph I.

The Registrar: The Chairman:

M. Kiehl P.K.J. van den Berg

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