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D E C I S I O N
of 10 February 1995

Case Number: T 0460/94 - 3.2.1

Application Number: 90305032.6

Publication Number: 0397488

IPC: B60G 13/18

Language of the proceedings: EN

Title of invention:
Wheel assembly suspending

Applicant:
BOSE CORPORATION

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 83, 111(1)

Keyword:
"Disclosure - sufficiency - skilled person"
"Remittal"

Decisions cited:
-

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: T 0460/94 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 10 February 1995

Appellant: BOSE CORPORATION
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Decision under appeal: Decision of the Examining Division of the European
Patent Office dated 25 January 1994 refusing
European patent application No. 90 305 032.6
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: F. A. Gumbel
Members: P. Alting van Geusau
J. C. Saisset
C. G. F. Biggio
B. J. Schachemann

Summary of Facts and Submissions

I. European patent application No. 90 305 032.6, with publication No. 0 397 488 was refused by the Examining Division with decision announced at the oral proceedings held on 17 January 1994. The written reasons were posted on 25 January 1994.

II. The Examining Division considered that the subject matter of the amended Claim 1, filed with letter dated 27 July 1992, was distinguished from the prior art disclosed in

D1: SAE TRANSACTIONS, paper No. 841253 1985, NEW YORK US. pages 5698 - 5707; THOMPSON ET AL.: "Active suspensions with vibration absorbers and optimal output feedback control",

in that the active controlled suspension system was a non-linear system.

The person skilled in the art, faced with an infinite number of possible non-linear systems and no criteria available to him on which to choose among them, would not have sufficient information to allow at least beginning of a process of trial and error for determining a suitable non-linear control regime. It was therefore concluded that the application did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

As regards inventive step, under the assumption that the application disclosed sufficient information for the skilled person to carry out the invention, the Examining Division differentiated between the case in which the

non-linear control extended over the whole usable range of the suspension and one in which the non-linear control was restricted to the extremes of the usable range.

In view of the teachings of D1 and

D2: EP-A-0 114 757

in the latter circumstances no inventive activity would be necessary to arrive at the subject matter of Claim 1. However, a system with non-linear control over the whole usable range of the suspension was considered to be inventive.

- III. Notice of Appeal was filed against this decision on 15 March 1994 and payment of the appeal fee was received on 18 March 1994. The Statement of Grounds of Appeal was filed on 9 May 1994.
- IV. In a communication dated 26 October 1994, setting out the provisional opinion of the Board, objections under Article 123(2) and 84 EPC were raised against the amended Claim 1 then on file, in particular in respect of features omitted from the originally filed Claim 1 and subject-matter which, when taking into account the disclosure of the description, would appear to be essential to the claimed invention and should therefore be introduced into the independent Claim.

In respect of the objection of insufficiency of disclosure (Article 83 EPC), the Board expressed the view that, taking into account the definitions of the terms used in the present application, it appeared that well known three position control systems used in

vehicle suspension systems for height control of the suspension and known, for example, from

D9: US-A-4 753 328

would comply with the definition of a non-linear control system used in the present application.

Attention was further drawn to

D10: DE-A-3 408 292

disclosing an active suspension system for a vehicle which, in a preferred embodiment, has a progressive suspension characteristic and therefore would also make use of non-linear control.

Taking into account these teachings of the prior art, non-linear control in an active controlled suspension system would appear to be known in itself and therefore the skilled person would not encounter undue difficulties in carrying out the subject-matter of the present application.

As regards inventive step the Board raised the question whether an inventive activity would have been necessary to use, instead of the control known from D1, non-linear control as known from D10, when circumstances required a progressive suspension characteristic, for example in off-road use of the vehicle.

- V. With letter dated 22 December 1994 the Appellant filed new Claims 1 to 11 and replacement pages 5, 6 for the originally filed description.

The Appellant requested that the case be remitted to the first instance for further prosecution of the examining proceedings on the basis of these new claims.

Current Claim 1 reads as follows:

"Suspension apparatus for a vehicle having a sprung mass (11) and an unsprung mass including a wheel (12) and a wheel support member (12A), the suspension apparatus comprising:

an active controlled suspension system (17) intercoupling the sprung mass and the unsprung mass; a wheel damper (21,22,23) connected to the wheel support member; and,

a wheel damper supporting structure (21, 22, 23) connecting the wheel damper to the wheel support member, constructed and arranged to prevent transfer of force between the unsprung mass and the sprung mass through the wheel damper; characterised in that: the active controlled suspension system is a non-linear active dynamically controlled system".

VI. In support of his request the Appellant submitted essentially the following arguments:

In its communication the Board indicated that the objection under Article 83 EPC was withdrawn. However, the Board cited new documents which were apparently considered to be relevant when determining inventive step of the subject-matter of the application.

If the Board does not allow the application to proceed to grant on the basis of the present claims, there would be no opportunity for second consideration of the relevance of the new citations, which would severely prejudice the Appellant.

The case should therefore be remitted to the Examining Division for further consideration.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is admissible.

2. *Amendments*

Current Claim 1 is a combination of the features of the originally filed Claims 1 and 2.

The current dependent Claims 2 to 11 are based on the subject-matter of the originally filed Claims 9 to 12, 6 to 8, 14, 15 and 5, respectively.

No objections under Article 123(2) EPC arise against the present set of claims.

3. *Disclosure of the invention*

3.1 The Examining Division rejected the application on grounds of Article 83 EPC because in their opinion the skilled person is faced with an infinite number of possible non-linear control systems and no criteria are available to him on which to choose from among them.

3.2 However, the fact that the application does not give the skilled person direct information as to how its subject-matter should be put into practice would not necessarily lead a skilled person to the conclusion that the subject-matter of the application cannot be carried out. Rather the skilled person would in such a case firstly

consider whether non-linear active controlled systems of vehicle suspension exist or whether commonly known non-linear control systems would be applicable.

- 3.3 Under these circumstances the Board considered it to be appropriate to cite the documents D9 and D10 disclosing known non-linear active suspension systems in accordance with the definition of such a system in the present application (cf. the Appellant's remark on page 3, lines 36 and 37 in the response dated 22 December 1994).

In view of these disclosures at least some examples of non-linear active controlled suspension were already known to the skilled person and therefore he would not have encountered any difficulties in choosing a suitable non-linear control system when carrying out the subject-matter of the present application.

- 3.4 Hence, the Board comes to the conclusion that there is no objection under Article 83 EPC against current Claim 1.

4. *Procedural considerations*

- 4.1 In the present case the application was rejected mainly for reasons of insufficiency of disclosure (Article 83 EPC) which objection, in view of the above assessments, is not upheld by the Board.

However, the introduction of the further prior art documents by the Board in relation to the question of sufficiency of disclosure gives rise to a new situation as regards the establishment of novelty and inventive step of the subject-matter of Claim 1 in that this prior art has not yet been considered by the first instance.

- 4.2 In accordance with the jurisprudence of the Boards, if prior art is introduced during the appeal procedure and it is considered relevant, the case is normally remitted to the department of first instance (see for example T 28/81 of 11 June 1985, reasons point 8).

In the present case indeed the Appellant would be deprived of the possibility of having his case been considered by two instances if the Board would come to the conclusion that no patent could be granted on the subject-matter of the application.

Moreover, the Examining Division considered that, if the objection in respect of Article 83 EPC could be overcome, in principle the subject-matter of the application would appear to be inventive. Also for this reason the new situation caused by the newly cited documents calls for remittal of the present case for reconsideration of the Examining Division's earlier conclusion in the light of the extended prior art, in accordance with the Appellant's request.

- 4.3 Further examination of the claimed subject-matter should include all relevant requirements of the EPC and in particular those of Article 84, e.g. the question raised by the Board whether the subject-matter of Claim 1 comprises all the features necessary for carrying out the invention i.e. those features which are disclosed as being essential for arriving at the technical effects described in the application.

In this respect consideration should also be given to the question of whether the specific definitions of features used in the present application are such as to imply differences when compared with respective features from the prior art documents, in particular when

comparing the known active suspension systems and the **dynamically** controlled active suspension system in accordance with the present application.

Order

For these reasons it is decided that:

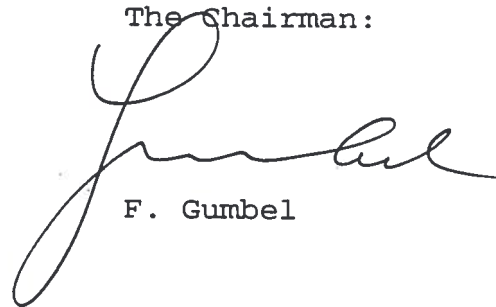
1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

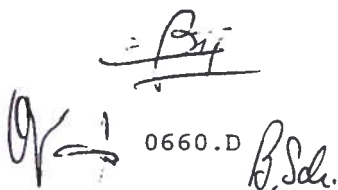


S. Fabiani

The Chairman:



F. Gumbel



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