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D E C I S I O N
of 17 February 1997

Case Number: T 0920/95 - 3.2.1

Application Number: 92115657.6

Publication Number: 0530845

IPC: B21D 28/36

Language of the proceedings: EN

Title of invention:
Die support arrangement in a rotary forming apparatus

Patentee:
BODNAR, ERNEST R.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 76(1)

Keyword:
"Extension of subject-matter of divisional application beyond content of parent (no - after amendment)"

Decisions cited:
-

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: T 0920/95 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 17 February 1997

Appellant: BODNAR, ERNEST R.
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Ontario (CA)

Representative: Hands, Horace Geoffrey
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 12 July 1995
refusing European patent application
No. 92 115 657.6 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: F. A. Gumbel
Members: S. Crane
G. Davies

Summary of Facts and Submissions

I. European patent application No. 92 115 657.6, which is a divisional of European patent application No. 88 302 371.5 filed on 18 March 1988, was refused by a decision of the Examining Division posted on 12 July 1995.

II. The reasons given for the decision were that the divisional application contained subject-matter extending beyond the content of the parent application (Article 76(1) EPC) and lack of clarity of the then valid Claim 1 (Article 84 EPC).

In particular, the Examining Division held that the broad definitions of "leading and trailing die support guide means" and "leading and trailing control means" contained in the then valid Claim 1 found no basis in the parent application as originally filed which only disclosed "guide pin means extending from each of the two ends of the die support block" and "path definition means adapted to receive said guide pins" in this context. The feature concerning the cooperation of the two dies for deformation of the material, present in original Claim 1 of the parent application, had also been omitted from the claim considered in the decision, for which omission there was again no basis. Moreover, since it was no longer clear how the apparatus claimed was intended to work no unambiguous meaning could be given to the terms "leading" and "trailing".

III. An appeal against this decision was filed on 7 September 1995 and the fee for appeal paid at the same time. The statement of grounds of appeal was filed on 2 November 1995.

With the statement of grounds of appeal the appellant filed an amended set of claims which in his opinion overcame those of the objections raised by the Examining Division which he saw as justified, in particular the omission of the term "pin" from the form of the guide means and the replacement of "path definition means" by "control means". He explained these omissions as being due to an oversight. He further argued that the other objections were not justified since the apparatus now claimed was unambiguously disclosed in the original application and it was clear how this apparatus functioned. He also requested reimbursement of the appeal fee since the Examining Division had not dealt properly with the arguments he had raised in the course of the examination proceedings and his request for an interview had not been acceded to.

- IV. In response to communications of the Board pursuant to Article 110(2) EPC dated 29 July 1996 and 28 October 1996, the appellant filed on 11 December 1996 a new amended Claim 1 and amended pages 1 and 3 to 6 of the description on the basis of which, together with dependent Claims 2 to 5 filed on 2 November 1995, the remaining pages of the description and the drawings as originally filed with the divisional application on 12 September 1992, he requested grant of the patent.

Claim 1 reads as follows:

"A die support apparatus for use in association with a rotary apparatus for forming and cutting material, said rotary apparatus having a rotatable upper roll unit (32) and a corresponding rotatable lower roll

unit (34), said upper and lower roll units (32, 34) being supported by bearing means (37) and being connected for synchronous rotation, each of said units comprising a carrier member (41, 52) defining a central axis, said member having at least one recess (42) extending along said member parallel to the central axis, said recess having bearing surface means of generally semi-circular shape, said die support apparatus comprising:

at least one die support member (46, 58) adapted to be supported by said carrier member (41, 52), and having a platen surface to which is affixed a die for forming or cutting said material, said die support member (46, 58) being rotatably supported in the recess of said carrier member (41, 52); characterised by

leading die support guide pin means (48, 62) extending from a leading portion of the end of said die support member;

trailing die support guide pin means (49, 63) extending from a trailing portion of the end of said die support member;

said apparatus further comprising leading path definition means (64, 70) adapted to receive said leading guide pin means; and,

trailing path definition means (66, 72) adapted to receive said trailing guide pin means, the engagement of said guide pins within said path definition means controlling the position of said die support members at least during said forming or cutting of said material."

Dependent Claims 2 to 5 relate to preferred embodiments of the apparatus according to Claim 1.

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 therefore admissible.
2. *Conformity with Articles 84 and 76(1) EPC*
 - 2.1 Present Claim 1 is no longer open to the objections under Article 84 and "Article 123(2)" EPC raised in the contested decision. (The latter Article is referred to erroneously in the decision. It is clear from the circumstances that what is meant is Article 76(1) EPC). In particular, the claim now specifies that the leading and trailing guide means comprise respective pins extending from an end of the die support member and that there are leading and trailing path definition means which receive the respective guide pins to control the position of the die support member during forming or cutting of the material. Furthermore, it is clear in the context that the terms "leading" and "trailing" refer to the relative positions of the guide pins with respect to the path of motion of the die support member.
 - 2.2 In fact, the only significant difference between the subject-matter of present Claim 1 and that of Claim 1 of the parent application as originally filed is that the latter is directed to rotary cutting and forming apparatus comprising die support apparatus of a particular form whereas present Claim 1 is directed to that die support apparatus for use in the equivalent rotary cutting and forming apparatus. The basis for this change is to be seen in the fact that it is clear from the originally filed application that the distinction over the closest state of the art mentioned there (US-A-1 581 236) resides in the form of the die

support apparatus rather than in the overall organisation of the rotary cutting and forming apparatus.

3. The Examining Division has already indicated (cf point 4 of its communication dated 23 January 1995 and point 2, last paragraph of the contested decision) that in its view the subject-matter of a claim corresponding to present Claim 1 would meet the requirements of novelty and inventive step. The Board sees no reason to disagree with that assessment. For the reasons given in point 2, paragraph 2 above, it cannot however agree with the comment made by the Examining Division in this context that the subject-matter of present Claim 1 is the same as that covered by the claims of the parent application.

4. *Request for reimbursement of the appeal fee*

4.1 In the first communication issued by the Examining Division, dated 5 September 1994, the objection was raised that the then valid Claim 1 defined the apparatus in a general way which found no basis in the parent application as originally filed.

In reply to this communication the appellant filed, with a letter dated 13 December 1994, a new set of claims. He commented in the letter that the apparatus now claimed was disclosed in the original application so that the claims did not extend beyond its content. Reference was made to the Guidelines C-VI 9.4 in which it is said that "the claims of a divisional application need not be limited to subject-matter already claimed".

In a second communication dated 23 January 1995 the Examining Division explained in more detail, in terms corresponding closely to those used in the contested decision, in what way there had been an extension

beyond the content of the parent application. An objection was also raised to the clarity of Claim 1 (Article 84 EPC).

In reply, with a letter dated 1 May 1995, the appellant referred on the question of added subject-matter to the arguments made in his letter of 13 December 1994, which in his opinion had been left unanswered, and added that there was nothing more for him to say. He did however indicate that he would be available for an interview on 26 September 1995.

- 4.2 The decision to refuse the application was issued on 12 July 1995.

According to Article 113(1) EPC a decision may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. By virtue of the communication of the Examination Division dated 23 January 1995 this requirement was met in the present case. Furthermore it is clear from this communication that the objection being made was not directed in simple terms to the claims of the divisional application not being limited to subject-matter already claimed in the parent application so that, at least implicitly, the argument raised by the appellant by reference to Guidelines C-VI 9.4 had been adequately dealt with. Lastly, the decision of an Examining Division whether or not to grant a request for an interview is a discretionary one, cf Guidelines C-VI 6.1a.

- 4.3 Thus the Board comes to the conclusion that the issue of the contested decision by the Examining Division did not involve any procedural violation which could justify reimbursement of the appeal fee (Rule 67 EPC).

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 with the order to grant a patent on the basis of the following documents:

Claims: 1 filed on 11 December 1996 with letter dated 5 December 1996;

2 to 5 filed on 2 November 1995 with letter dated 30 October 1995.

Description: Pages 1 and 3 to 6 filed on 11 December 1996 with letter dated 5 December 1996;

Pages 2 and 7 to 18 as filed on 12 September 1992.

Drawings: Sheets 1/10 to 10/10 as filed on 12 September 1992.

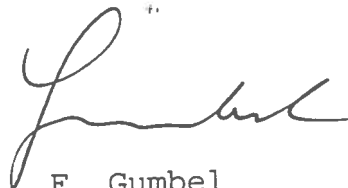
3. The request for reimbursement of the appeal fee is refused.

The Registrar:



S. Fabiani

The Chairman:



F. Gumbel

