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D E C I S I O N
of 16 April 1998

Case Number: T 0118/96 - 3.2.4

Application Number: 92309514.5

Publication Number: 0540218

IPC: F02D 41/22

Language of the proceedings: EN

Title of invention:
A method of and an apparatus for detecting a fault in a return system

Applicant:
Lucas Industries Public Limited Company

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 84
EPC R. 71(2)

Keyword:
"Claims - clarity (no)"

Decisions cited:
-

Catchword:
-

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Case Number: T 0118/96 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 16 April 1998

Appellant: Lucas Industries Public Limited Company
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Representative: Robinson, John Stuart
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 18 September 1995 refusing European patent application No. 92 309 514.5 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: C. A. J. Andries
Members: H. A. Berger
J. P. B. Seitz

Summary of Facts and Submissions

I. The appellant (applicant) has lodged an appeal against the examining division's decision of 18 September 1995 to refuse European patent application No. 92 309 514.5. The appeal and the appeal fee were received on 8 November 1995. The statement of the grounds of appeal was received on 19 January 1996.

II. The independent claims under consideration are worded as follows:

Claim 1 (filed with letter dated 18 July 1995):

"An apparatus for detecting a fault in a return system, comprising first return means (4) for urging a mechanism of the system to a first return position and second return means,
characterised in that
the second return means (6-13) is arranged to urge the mechanism to a second return position beyond the first return position
and characterised by means (15) for determining the first and second return positions and means (24-28) for indicating a fault if the second return position is not beyond the first return position."

Claim 9 (filed with letter dated 19 December 1994):

"A method of detecting a fault in a return system, comprising urging a mechanism of the system by a first return means to a first return position, determining the first return position, urging the mechanism by a second return means to a second return position beyond

the first return position, determining the second return position, and indicating a fault if the second return position is not beyond the first return position."

III. After being informed of the intention of the board to organize oral proceedings, the appellant withdrew his request for oral proceedings. Oral proceedings however were held on 16 April 1998. The appellant, although duly summoned with the summons posted on 27 February 1998, did not appear. In accordance with the provisions of Rule 71(2) EPC the proceedings were continued without the appellant. In the annex (communication pursuant to Article 11(2) of the rules of procedures of the Boards of Appeal) to the summons the board drew attention among other things to the clarity problem of the claims (see sections 3 and 6 of this communication).

IV. In his written statement of the grounds of appeal the appellant argues among other things that the claims 1 and 9 define precisely those features which distinguish the invention patentably from the prior art and which are absolutely essential to the invention. The appellant points out that he does not wish to claim the combination of the apparatus and the return system, but the apparatus for detecting a fault on its own, because this is the essence of the invention. It is quite possible that such apparatus could be made or sold independently of the return mechanism.

The appellant further argues that the term "return" is used because it is essential to the definition of the invention and because it has precisely that meaning which is required to define the invention fully. To define as an essential feature of the claim the mechanism and the first and second return positions would unnecessarily and unfairly limit the scope of

protection for the invention. The wording chosen in Claims 1 and 9 is, according to the appellant, clear English and is only capable of correct interpretation. In claim 1, the return positions are specifically defined as being return positions of the mechanism of the return system specifically because it is not necessary for the throttle valve itself to have more than one return position, although there is no reason why it should not have. For instance, whether the throttle valve is attached to the right end or the left end of the shaft 1 in Figure 1 of the present application is irrelevant as it has no effect whatever on operation.

V. Requests

The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the following documents:

Claims: 1 to 7 as filed with the letter of 18 July 1995;
8, 9 as filed with the letter of 19 December 1994.

Description: Pages 1, 3 to 7, 9 as originally filed;
pages 2, 8 as filed with the letter of 19 December 1994;
page 2a as filed with the letter of 18 July 1995.

Drawings: Sheets 1/3 to 3/3 as originally filed.

Reasons for the Decision

1. The appeal is admissible.

2. *Clarity*

2.1 Problem to be solved with the claimed apparatus:

The problem with an arrangement comprising two independently functioning "return-to-closed" systems (for instance a spring and a motor) is that a dormant fault can develop and remain undetected such that, should a second failure occur, the ability to return, for instance, the throttle to its closed position may be lost (see description page 2, second paragraph). This problem should be solved by the claimed apparatus and method.

2.2 Solution according to claim 1

According to claim 1 means are provided for determining the first and second return positions and means for indicating a fault if the second return position is not beyond the first return position. Although the second return position is clearly defined in relation to the first return position (namely "beyond"), no clear definition of the first return position in the system is given in claim 1. The first return position therefore could be any return position in the system. In the description (page 4, second paragraph and page 8, third paragraph, three last lines) it is indicated that the first return position may be compared with a stored value, for instance corresponding to substantial closure of the throttle, so that a fault with respect to this first return position can be detected. It is however not clear to the board how the apparatus for detecting a fault in a

return system may function without this feature, i.e. without the determination of the particular predetermined first return (end) position in the system. Indeed if, for instance, the measured first return position is not the predetermined return end position in the system and the throttle valve is not fully closed because of a failure of the spring (first return means for urging a mechanism of the system to a first return position) the electro motor (second return means) may urge the throttle valve to a second return position beyond the first return position. Due to the general character of the wording of the claim and the unclear definition of "the first return position", the determination of the first and second return positions by the corresponding means defined in claim 1 would therefore not lead to an indication of the existence of a fault. The wording of claim 1 therefore does not comprise the features needed to allow the claimed apparatus to detect a fault in a return system.

The appellant maintains in his statement of the grounds of appeal (page 1, fourth paragraph) that it is clearly stated in the claim that the first return means must be such as to urge the mechanism to the first return position, and not to any intermediate position or any other undefined position. However nothing is mentioned in claim 1 that the first return position is a particular predetermined position in the system, let alone a particular predetermined **end** position, for instance, the end position predetermined by a stored value, with which the return end position established by the first return means is compared.

Furthermore, the appellant argues in his written statement of the grounds of appeal (see page 1, second paragraph) that he does not wish to claim the combination of the apparatus and the return system, but

that he wants only the apparatus for detecting a fault on its own because this would be the essence of the invention. The functioning of the apparatus without the return system however is not clear.

2.3 The problem mentioned above (section 2.1) therefore cannot be solved by the apparatus defined in claim 1, since the latter lacks essential features. Claim 1 therefore lacks clarity (Article 84 EPC).

Although attention was drawn in the communication of the board (see the above section III) to the deficiencies of the claims 1 and 9 (see sections 3 and 6 of the communication) the appellant did not respond at all.

2.4 The board wishes to stress that clarity of the claims (Article 84 EPC) is of the utmost importance during the procedure up to grant, particularly since lack of clarity is no ground for opposition (Article 100 EPC), so that after grant there is no further possibility to force the wording of a granted claim to be clarified.

2.5 Claim 1 is not in accordance with Article 84 EPC and is therefore not patentable. The application therefore does not fulfill the requirements of the European Patent Convention, so that the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

N. Maslin

The Chairman:

C. Andries