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

Case Number: T 0538/96 - 3.2.1
Application Number: 87902906.4
Publication Number: 0263163 (WO 87/05676)
IPC: F16J 3/04, F16J 15/52
Language of the proceedings: EN

Title of invention:
One-piece split boot for universal joint

Applicant:
TIEGS, Del V., et al

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Addition of subject-matter (yes)"

Decisions cited:
T 0451/84, T 0331/87, T 0514/88, T 0527/88, T 0118/89, T
0415/91, T 0802/92

Catchword:
-



Case Number: T 0538/96 - 3.2.1

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

Appellant: Tiegs, Del V. et al
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 26 January 1996
refusing European patent application
No. 87 902 906.4 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: F. Gumbel
Members: S. Crane
J.-C. Saisset

Summary of Facts and Submissions

- I. European patent application No. 87 902 906.4 was refused by a decision of the Examining Division posted on 26 January 1996.
- II. The reason given for the decision was that the application had been amended in such a way that it contained subject-matter which extended beyond the content of the application as filed (Article 123(2) EPC).

The decision was based on a set of claims 1 to 7 filed 12 December 1994 of which claim 1 reads as follows:

"A boot for a universal joint or the like comprising a main body (12) for mounting about said universal joint or the like, characterised in that the end portions (14, 16) of the main body (12) are provided with sizing guide indicia (17, 19) for indicating the positions in which part of the material of the main body (12) should be removed such that the diameter of the aperture in the end of the main body (12) may be varied to accommodate different sized said universal joints or the like, and in that the main body (12) includes a corrugated portion (20, 22) having protruding portions, the plane of each protruding portion being diagonally disposed relative to the longitudinal axis of said main body (12), whereby recirculation of lubricating oils inside said main body (12) is facilitated."

Dependent claims 2 to 7 relate to preferred embodiments of the boot according to claim 1.

In particular, it was argued in the decision that there was no basis in the original disclosure for a claim to a boot which did not include the features concerning

the boot having a split unitary body comprising connecting means for non-destructive removal and sealingly connecting the body along the split, as defined in claim 1 as originally filed. Furthermore, it was also argued that the deletion of the term "split" from various passages of pages 1 and 3 of the description filed on 12 December 1994 likewise offended against Article 123(2) EPC.

- III. An appeal against this decision was filed on 26 March 1996 and the fee for appeal paid at the same time. The statement of grounds of appeal was filed on 23 May 1996.

The appellants (applicants) request that the decision under appeal be set aside and a patent granted on the basis of the application documents forming the basis for that decision.

- IV. Oral proceedings before the Boards were held on 17 April 1997.

At the oral proceedings the appellants submitted an auxiliary request that the grant of a patent be ordered on the basis of the application documents which the Examining Division had proposed in its communication according to Rule 51(4) EPC dated 17 September 1993.

- V. The arguments put forward by the appellants can be summarised as follows:

What was presented as the "main feature" of the invention in the application as filed was largely irrelevant. What was important was what was disclosed (explicitly and implicitly) to the person skilled in the art. This person reading the application as filed would understand that three distinct inventive concepts

were described. Each of these concepts was associated with distinct advantages which were not related to each other and these three concepts represented the appellants' contribution to the art, for which they were entitled to claim protection.

In situations such as these recourse was often had to a divisional application. In this context the Boards of Appeal had made it clear that there was no requirement for the claims of the divisional application to include the features of the main claim of the parent application as originally filed. The same considerations should apply when an equivalent amendment was made within the same application.

The Examining Division had relied in particular on the three-fold "essentiality" test proposed in decision T 331/87 (OJ EPO, 91, 022) in coming to its decision. It had, however, either misunderstood or misapplied what that decision required and had ignored the warning in decision T 151/84 (unreported) against adopting a too academic approach. It was in fact clear that the feature of the boot being split had nothing to do with and was completely inessential to the subject-matter now being claimed. Since this feature provided no technical contribution to the subject-matter of the claimed invention, its removal from the claim was allowable, as confirmed by decision T 802/92 (OJ EPO 95, 379).

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. *The original application*

The first paragraph of the description of the original application states that

"the present invention relates to boots for covering universal joints and the like and more particularly to (a) unitary, flexible body having a first mating edge and second mating edge and shaped to be helically wrapped about a universal joint, coupling or other type of structure without disassembling the structure in which the first mating edge is engaged with the second mating edge thereby forming a removable boot for the universal joint or the like."

This is followed by a general explanation of the well-known problem associated with the replacement of a boot for a constant-velocity joint of a front wheel drive vehicle or the like that the joint had to be disassembled. It is indicated that attempts had been made to solve this problem by cutting the boot, placing it over the joint and then gluing the edges back together, but this approach had been unsuccessful since it was difficult to achieve an adequate glued bond in the normal workshop environment.

There then comes a passage entitled "Summary of the invention" in the following terms:

"The present invention provides a split boot formed from a unitary, flexible body shaped to be helically wrapped around a universal joint or the like. Once the flexible body is wrapped around the joint with the mating edges engaged a main body is formed having a generally hollow truncated conical configuration with a corrugated or helical shape. In the preferred embodiment one end of the main body has a smaller circular cross section than the other end. Each end portion of the main body has cutting guide ridges such that the diameter of the aperture in the end may be varied by removing some of the material from the body, to accommodate different sized joints or mechanical units. The corrugations or the helical shape in the main body are diagonally disposed relative to the longitudinal axis of the main body to provide longitudinal flexibility and for providing the recirculation of lubricating oils during rotational movement of the boot with a rotating mechanical unit and to equalize rotational forces on the boot to prevent premature rupture and cracking thereof."

There follow a number of statements of object the first of which is:

"It is an object of the present invention to provide a novel split boot that is easily used and sealingly connects or mates around a universal joint or the like without disassembly of the joint."

The third object reads as follows:

"It is further object of the present invention to provide a novel split boot having a corrugated shape with the corrugations being generally diagonally disposed relative to the longitudinal axis of the boot which facilitates recirculation of the lubricating oil contained therein."

The description of the single embodiment shows the preferred form of the mating edges of the flexible body and explains how the boot is assembled in practice. The function of the corrugations and "cutting ridge guides" are explained in similar terms of those used in the summary of the invention.

The last paragraph of the description comprises a generalising statement of traditional form which reads as follows:

"The instant invention has been shown and described herein in what is considered to be the most practical and preferred embodiment. It is recognized, however, that departures may be made therefrom within the scope of the invention and that obvious modifications will occur to a person skilled in the art."

Claim 1 of the original application is drafted in the following terms:

"A boot for a universal joint or the like comprising:
a split unitary main body, said body sized and shaped for wrapping about said universal joint or the like;

connecting means, connected to said body, for non-destructive removal and sealingly connecting said body along said split about said universal joint or the like in a sealed position."

Dependent claim 3 relates to the provision of "diagonally" disposed corrugations and dependent claim 5 to the provision of "sizing guides" for facilitating accurate trimming to accommodate differently sized universal joints or the like.

3. *The amended application*

Claim 1 of the amended application considered by the Examining Division in the contested decision is quoted in Section II above.

It can be seen that the amended claim 1 no longer contains any of the features of the boot specified in the originally filed claim 1, except that it comprises a "main body". Those features first appear in dependent claim 4. It is evident that the amended claim 1 now extends to a boot which is not split and which must be mounted around the joint in the conventional manner.

The description has been amended *inter alia* to state in the first paragraph thereof that the invention relates "particularly, but not exclusively" to a flexible body shaped to be wrapped around a universal joint and to delete the term "split" from the third object quoted in Section II above.

4. *Considerations under Article 123(2) EPC*

The question of the circumstances in which the omission or generalisation of features originally used to describe or define the invention constitutes an extension of subject-matter contrary to Article 123(2) EPC has generated a substantial body of jurisprudence summed up on pages 164 to 167 of the 1996 edition of the "Case Law of the Boards of Appeal of the EPO". In the course of time various tests have been proposed as a means of aiding decision finding, in particular the "novelty", "modified novelty" and "essentiality" tests. More recently, partly in an attempt to reconcile the

various tests, emphasis has been placed on the key question of whether or not the amendment was consistent with the original disclosure, see for example the decisions T 514/88 (OJ EPO 1992, 570), T 527/88 and T 118/89 (both unreported).

In the present case the Examining Division relied on the three-part "essentiality" tests proposed in point 6 of the reasons of decision T 331/87 (supra) in coming to its conclusion that the application should be refused. Since the appellants are of the opinion that this test, when properly applied, supports their standpoint, it is a convenient starting point for discussion.

It is stated in that decision that the replacement or removal of a feature from a claim may not violate Article 123(2) EPC provided the skilled person would directly and unambiguously recognise that

- (1) the feature was not explained as essential in the disclosure,
- (2) it is not, as such, indispensable for the function of the invention in the light of the technical problem it serves to solve, and
- (3) the replacement or removal requires no real modification of other features to compensate for the change.

The Examining Division held that in particular requirement (1) was not met. The Board fully supports that view and in its opinion the same applies to requirements (2 and (3) as well. As can be seen from the analysis of the originally filed application in point 2 above the provision of a split in the boot body and connecting means for joining the body along the

split is not only clearly described as essential in the original application but is in fact indispensable to the function of the invention as disclosed. In the more general terms mentioned above it is therefore apparent that the amendments made to the application, to remove the requirement that the boot be split and to portray this as being merely a preferred feature, are not consistent with the original disclosure.

The argument of the appellants is that it was clear from the beginning that the application disclosed three separate and distinct inventive concepts ("split boot", "diagonal corrugations" and "sizing guide indicia") and that it was also clear to the person skilled in the art that the requirement that the boot was split was in no way essential to the second and third of these concepts. The amended claim 1, which was directed to a combination of those two concepts, would therefore pass each limb of the three-part "essentiality" test. But that argument is a circular one. It depends for its success on the assumption that there were three inventive concepts originally disclosed. That is not the case. The person skilled in the art reading the original application sees a relatively simple one-piece artefact which is designed to solve a specific problem, i.e. mounting a boot around a universal joint without disassembling the joint. He is also taught that the boot may contain preferred features to make it more versatile and to improve its function. Although it is possible that upon reflection, and using his imagination, it might occur to him that these features could be of merit in their own right, that would be his own idea, resulting from his own thinking. It was not part of the content of the application as filed (cf. T 415/91, not reported). The generalising statement at the end of the description in no way affects that assessment.

In the opinion of the Board there is no doubt that the "essentiality" test, if it is to be used, has to be applied to the invention (or each of the inventions if in fact several are present) originally disclosed and not to some combination of features extracted from the original disclosure and subsequently claimed. Although the published headnote of decision T 802/92 (OJ EPO 1995, 379) might appear to give a different impression, it is clear from points 2 to 4 of the reasons that in fact nothing else is being proposed there.

Lastly, the Board cannot accept the contention of the appellants that the EPO applies different standards when considering the admissibility of a divisional application and the admissibility of an amendment, and that since a divisional application would have been allowed in the present case then so should the amendment. In fact, a number of decisions of the Boards of Appeal have consistently emphasised the substantive identity of the requirements under Article 76 and 123(2) EPC (see for example T 514/88, supra).

5. *Auxiliary request*

After three negative communications the Examining Division decided that a patent could be granted on the basis of the documents set out in its communication under Rule 51(4) dated 17 September 1993. The Board sees no reason to interfere with that assessment. The auxiliary request of the appellants can therefore be granted.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The main request is rejected.
3. The case is remitted to the first instance with the order to grant a patent on the basis of the documents as indicated in the communication according to Rule 51(4) EPC dated 17 September 1993.

The Registrar:



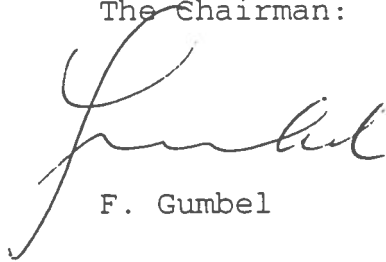
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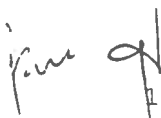
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The Chairman:



F. Gumbel


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