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D E C I S I O N
of 16 October 1997

Case Number: T 0288/97 - 3.2.4

Application Number: 93906961.3

Publication Number: 0624112

IPC: A63C 9/08

Language of the proceedings: EN

Title of invention:
Snowboard boot binding system

Applicant:
THE BURTON CORPORATION

Opponent:

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Headword:

-

Relevant legal provisions:
EPC Art. 111, 82

Keyword:
"Unity a priori - (yes)"
"Remittal to the first instance"

Decisions cited:

-

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0288/97 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 16 October 1997

Appellant:

THE BURTON CORPORATION
80 Industrial Parkway
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 5 November 1996
refusing European patent application
No. 93 906 961.3 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. A. J. Andries
Members: M. G. Hatherly
J. P. B. Seitz

Summary of Facts and Submissions

- I. On 19 December 1996 the appellants (applicants) filed an appeal against the decision of the examining division dispatched on 5 November 1996 to refuse European patent application No. 93 906 961.3 (International application No. PCT/US93/01090, International publication No. WO-A-93/14835). The appeal fee was paid on 19 December 1996 and the statement of grounds of appeal was received on 5 March 1997.

The Examining Division held that the application did not meet the requirements of Article 84 EPC (since the application then included four independent claims which were held not to be concise), Article 82 and Rule 30 EPC (for lack of unity of invention of the four independent claims), and Articles 52(1) and 54(1) EPC (for lack of novelty of the subject-matter of one of the independent claims).

- II. With the statement of grounds of appeal the appellant filed a new set of claims. The board explained in its communication of 3 June 1997 why it considered that this new set of claims overcame the conciseness and novelty objections under Articles 84, 52(1) and 54(1) EPC but still did not satisfy the unity of invention requirement under Article 82 EPC.

- III. With their reply of 1 August 1997 the appellants filed a fresh set of claims, the independent claims thereof reading as follows:

"1. A system for binding a snowboarding boot to a snowboard, comprising a snowboard (10), a snowboard binding (18, 20, 28, 30) which receives the boot and has a hold-down plate (30), and means to releasably

attach the hold-down plate to the board, the system characterized in that:

the attachment is effected by three attachment elements which are arranged as an equilateral triangle and link the hold-down plate (30) to the board (10) beneath the area of the binding which accommodates the sole of the boot."

"10. A snowboard binding for the system according to any one of claims 1 to 9, wherein the binding effects attachment of the hold-down plate (30) to the snowboard (10) by three attachment elements and the hold-down plate has a plurality of bores (42) arranged as an equilateral triangle, one bore at each vertex of the triangle serving to receive a respective one of the three attachment elements."

"16. A snowboard for the system according to any one of claims 1 to 9, said snowboard including two sets of three binding attachment points arranged as an equilateral triangle, each set serving as an alternative attachment location for the binding and spaced close enough together to provide useful incremental adjustment of the position of the binding on the board, by translating the binding across the face of the board from a first attachment location to a second alternative one."

IV. The appellants request that the decision under appeal be set aside and the application be remitted to the first instance for further prosecution on the basis of the following documents:

- Claims 1 to 20 filed with the letter of 1 August 1997.
- Description pages 1 to 7 as originally filed, and

- Drawings sheets 1/3 to 3/3 (Figures 1 to 5) as originally filed.

Oral proceedings are requested before any decision adverse to the appellants is taken by the board.

Reasons for the Decision

1. The appeal is admissible.
2. *Article 82 and Rule 30 EPC*
 - 2.1 The examining division stated in section 3 of its decision, as part of its reasons for finding that the requirements of unity of invention were not met, that the triangular arrangement of the fixing holes was not mentioned in three of the four independent claims then on file and indeed that there were no common or equivalent features common to all the independent claims.
 - 2.2 Each of **present** independent claims, on the other hand, includes the triangular arrangement, indeed an equilateral triangular arrangement of the attachment points. Claim 1 specifies "three attachment elements which are arranged as an equilateral triangle", claim 10 "a plurality of bores (42) arranged as an equilateral triangle" and claim 16 "three binding attachment points arranged as an equilateral triangle".
 - 2.3 Thus the independent claims are linked by the triangular arrangement and the *a priori* lack of unity of invention finding by the examining division no longer applies.

3. *Article 84 EPC*

3.1 The examining division found in section 2 of its decision that the four independent claims then on file were not concise.

3.2 The present claim 1 is directed to a snowboard, a snowboard binding including a hold-down plate, and three attachment elements to attach the hold-down plate to the snowboard. Claim 10 omits the snowboard and is directed to the binding while claim 16 omits the binding and is directed to the snowboard. It is reasonable for the appellants to seek protection not only for a snowboard with a binding but also for a snowboard on its own and for a binding on its own since the consumer might buy any one of these three alternatives. Each alternative includes the equilateral triangular arrangement for the attachment elements that attach the binding (claim 10) to the snowboard (claim 16) to make the combination (claim 1).

3.3 Thus, while there is still a plurality of independent claims (i.e. three) in the present version of the application, a further objection of lack of conciseness would be inappropriate.

4. *Articles 52(1) and 54(1) EPC*

4.1 The examining division found in sections 4.1 and 4.2 of its decision that the subject-matter of the independent claim 23 filed with the letter of 9 July 1996 was not novel. This claim concerns the rotational adjustment of a highback leg support of the binding, subject-matter which is completely different to that of the independent claims 1, 10 and 16 now on file.

- 4.2 Thus the specific objection of novelty made in the decision under appeal cannot apply to the present version of the application.
5. Accordingly the appellants have overcome the three specific objections made in the decision under appeal. The decision therefore must be set aside. This does not mean however that the application is ready for grant. The examination needs to be continued to see whether the application satisfies the other requirements of the EPC e.g. regarding whether the claims are fairly based on the originally filed claims (Article 123 EPC and Guidelines C-VI, 5.8a), are clear (Article 84 EPC), and have novel and inventive subject-matter (Articles 52(1), 54(1) and 56 EPC). The description certainly requires amendment.

Under Article 111 EPC the board may itself continue with the examination of the application or may remit the case to the examining division. In the present case, as far as patentability issues are concerned, the examining division has commented only on novelty concerning an independent claim which is not in the present version of the application. The board therefore considers that the examination concerning the other requirements of the EPC needs to be carried out by the first instance so that, should it decide against the applicants on any point, the applicants would still have the chance to appeal to a higher instance.

6. *Further prosecution of the case*

Without wishing to bind the examining division, the board draws attention to the following points.

- 6.1 The opening part of claim 1 could be clarified since the system for binding a snowboarding boot to a snowboard seems to consist only of the binding. It seems illogical to include the snowboard in the system. A possibility might be "A snowboard and a snowboard binding for binding a snowboarding boot to the snowboard ...".
- 6.2 It would be clearer if claim 10 defined the binding per se and did not e.g. refer to "the" hold-down plate as if it had already been specified in the claim. The reference to "the system according to any one of claims 1 to 9" (or an equivalent reference) should be retained but something along the lines of "said binding receiving the boot and having a hold-down plate (30), and means to releasably attach the hold-down plate to a snowboard" might be added.
- 6.3 If, after considering the prior art, the examining division were to consider that the subject-matter of one or more of the independent claims lacked novelty or inventive step then presumably the examining division would also consider that the common feature linking the independent claims, namely the equilateral triangular arrangement of the attachment points, was not a single general **inventive** concept as required by Article 82 EPC. Nevertheless, if this were the case, it would seem better for reasons of procedural efficiency not to worry immediately about lack of unity of invention but instead to concentrate on having the aforesaid claim or claims amended to satisfy the novelty and inventive step requirements. If thereafter the independent claims did not already contain the same inventive concept then it should be relatively simple to bring them into line.

6.4 Claim 12 should be appended solely to claim 11 since claim 12 mentions a plurality of "bores" at the first and second vertices and this possibility is only foreseen in claim 11. In claim 10 only one bore at each vertex appears to be defined.

6.5 For the same reason claim 14 should be appended to claims 11 to 13 and not to claims 10 to 13.

6.6 In claim 17 it appears superfluous to state that a set of attachment points "is located on a circle". As the attachment points are arranged in an equilateral triangular manner, they are necessarily located on a circle.

6.7 Strictly geometrically speaking the mirror image configuration defined in claim 18 is not possible when dependent on claim 17 because the two triangles of claim 17 **overlap** and therefore no 'mirror plane' **between** the two figures is possible. The (vague) wording of claim 16 is not bound to result in overlapping figures. Wording such as "inverted" or "180°-inverted" in claim 18 may be more appropriate.

7. The board is granting the appellants' requests so there is no need to appoint the auxiliarily requested oral proceedings. However it is pointed out that this auxiliary request for oral proceedings is a request in the present appeal proceedings and will have no effect in the further proceedings before the examining division.

Order

For these reasons it is decided that:

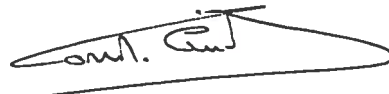
1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the following documents:
 - Claims 1 to 20 filed with the letter of 1 August 1997.
 - Description pages 1 to 7 as originally filed, and
 - Drawings sheets 1/3 to 3/3 (Figures 1 to 5) as originally filed.

The Registrar:



N. Maslin

The Chairman:



C. Andries