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D E C I S I O N
of 30 January 2001

Case Number: T 1047/98 - 3.2.6

Application Number: 90203367.9

Publication Number: 0491088

IPC: D05B 57/14

Language of the proceedings: EN

Title of invention:
Rotary hook for sewing machines

Applicant:
HIROSE MANUFACTURING COMPANY LIMITED

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

EPC R. 67

Keyword:

"Amendments - feature derivable from the drawing (main request) - no"

"Amendments - omission of a feature only disclosed in combination with further features (auxiliary requests I and II)- no"

"Reimbursement of the appeal fee - no"

Decisions cited:

G 0001/93, T 0169/83, T 0523/88, T 0818/93

Catchword:

-



Case Number: T 1047/98 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 30 January 2001

Appellant: HIROSE MANUFACTURING COMPANY LIMITED
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Representative: Smulders, Theodorus A.H.J., Ir.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 23 October 1997
refusing European patent application
No. 90 203 367.9 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: G. C. Kadner
M. K. S. Aúz Castro

Summary of Facts and Submissions

I. European patent application No. 90 203 367.9 filed on 17 December 1990 with claim 1 of the following wording:

"A rotating hook for a sewing machine having a replaceable raceway member (15) with a front end (11c) thereof in the rotating direction (A) of the rotating hook body (1) is made of a material of high hardness."

and published under No 0 491 088 was amended on 28 February 1994 with the following claim 1:

"A rotating hook assembly (10) for a sewing machine, said assembly (10) including a rotating hook body (11) to be rotated about an axis of rotation (A), said rotating hook body (11) including a cylindrical wall coaxial with said axis, said wall having formed therein a cut-out opening (11a) and a hook point (16) at said opening and facing in said direction (A) characterized in that

- said opening (11a) is at least partially defined by a planar surface (11b) of said rotating hook body (11)
- a hook point member (15) is provided, having a planar surface (17a) and an end defining said hook point (16) and being formed of a material of high hardness
- said hook point member (15) being detachably mounted on said rotating hook body (11) with said planar surfaces (11b, 17a) in mating abutment and with said hook point (16) defining end facing in said direction (A) and extending axially beyond (h1) a free axial end of said rotating hook body (11); and

- said hook point member (15) having longitudinally extending outer (17c) and inner edges (17b) that project radially outwardly and inwardly, respectively, of outer and inner surfaces of said cylindrical wall of said rotating hook body (11), said outer and inner edges (17c, 17b) being curved."

II. The application was refused by the Examining Division by decision dated 23 October 1997. The Examining Division considered the amended application to contain subject-matter which extended beyond the content of the application as filed, and accordingly did not comply with Article 123(2) EPC.

III. On 22 December 1997 the Appellant (Applicant) lodged an appeal against this decision paying the appeal fee on the same date.

The statement of grounds of appeal was filed on 30 January 1998 together with new claims 1 to 15 and an amended specification, pages 1 to 14.

IV. In a communication pursuant to Article 12 of the Rules of Procedure of the Boards of Appeal the Board - on a preliminary basis - expressed doubts as to whether a number of features of the amended claims could be derived from the originally filed documents.

V. Oral proceedings were held on 30 January 2001.

The Appellant requested that

the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 15 as

rejected in examination proceedings and as filed on 30 January 1998;

by way of auxiliary request on the basis of claims 1 to 4 as filed on 22 December 2000;

by way of further auxiliary request on the basis of claims 1 to 4 as filed in oral proceedings.

Reimbursement of the appeal fee was also requested.

Claim 1 of the first auxiliary request reads as follows:

"A rotating hook assembly (25) for a sewing machine, said assembly (25) including a rotating hook body (27) to be rotated about an axis of rotation (A), said rotating hook body (27) including a cylindrical wall coaxial with said axis, said wall having formed therein a cut-out opening and a hook point at said opening and facing in said direction (A), said cut-out opening presenting at least partially a mounting surface on which a hook point member (28) formed of a material of high hardness is detachably mounted in mating abutment, characterized in that said hook point member (28) is plate-shaped and substantially U-formed, the mounting surface (27a) being planar and extending in an inclined outward direction from a base (27b) of said rotating hook body (27) to a free axial end thereof, said planar surface (27a) entirely defining said cut-out opening."

Claim 1 of the second auxiliary request is identical with that of the first auxiliary request, the word "roughly" being inserted in the first line of the

characterising portion before the term "plate-shaped".

VI. In support of its requests the Appellant essentially relied upon the following submissions:

The amendments to the application complied with Article 123(2) EPC and the respective case law of the Boards of Appeal as set out in decision G 1/93 of the Enlarged Board of Appeal. A skilled person in the field of sewing machines would understand the features objected to as immediately evident when considering the drawings of the originally filed application. Drawings were the international language of technicians and in this respect the feature according to which the "*planar surfaces (are) in mating abutment*" were unambiguously shown in Figure 5, and so were the further amendments derivable from the other drawings. In any case these amendments were also acceptable in application of Rule 88 EPC since it was obvious that wrong terms had been used for designating certain parts of the hook assembly.

Since a European Patent was published with the name of the professional representative on its front page the representative should be allowed to "brush up" a poorly worded translation in order to bring the language of the specification up to the standard of average Continental English with a view to avoiding the impression of having a poor command of the official language of the patent.

Reimbursement of the appeal fee was justified because the Examining Division had refused to give an opinion on the technical merits of the invention although the examination fee had been paid. Instead of carrying out

a complete substantive examination it rejected the application for formal reasons.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request*
 - 2.1 Pursuant to Article 83 EPC in combination with Article 78(1)d) EPC features can be disclosed by a drawing alone. In this case, however, the structure and the functions of the features should be disclosed clearly and unambiguously and be derivable from the drawings by the skilled person, and not be at odds with the other parts of the disclosure (compare decisions T 169/83, OJ 1985, 193; T 523/88 and T 818/93, not published).
 - 2.2 The Appellant stressed that although not literally mentioned in the application as filed the feature according to which the *hook point member (15) (was) detachably mounted on the rotating hook body (11) with planar surfaces (11b, 17a) in mating abutment* was clearly implied by Figure 5.

The Board agrees that Figure 5 indeed shows a straight line indicating an abutment of two surfaces 11b and 17a. However, this figure concerns a cross-sectional view and therefore no conclusions can be drawn as to the extension of these surfaces in the direction perpendicular to the plane of the drawing. In this respect, attention is drawn to Figures 2 and 3 in which

the raceway member 15 is drawn with curved lateral lines.

- 2.3 The Appellant argued that the curved lines shown in Figures 2 and 3 resulted from the perspective view of the graph representing a section of an inclined plane with the side wall of a hollow cylindrical body which in reality could have a straight form. A skilled person who would have to produce such a raceway member self-evidently would select plane surfaces because manufacturing of plane faces of hard material was easier than of curved surfaces. Consequently the skilled person would conclude that these surfaces were plane.

The Board cannot follow this line of argument because it relies on an interpretation of what a skilled person would have done under particular circumstances i.e. depending on the machine tools available for manufacturing the hook assembly. In fact Figures 2 and 3 could very well disclose curved surfaces 11b and 17a, and therefore in any case plane-shaped surfaces are not clearly and unambiguously derivable from the drawings alone.

- 2.4. Since the subject-matter of claim 1 extends beyond the content of the application as filed at least as regards the feature describing surfaces 11b and 17a as plane surfaces this claim is not acceptable.

3. *Auxiliary requests*

- 3.1 The Appellant's representative submitted that the amended claim was based on the subject-matter of the originally filed claims 6 and 7. He admitted that a

roughly plate-shaped member without a gib claw, as now claimed in claim 1 of the auxiliary request, was not disclosed in the application as filed, but that it was evident to the skilled person that the claw was not essential and anyhow the feature concerning the claw was the subject of the dependent claim 3.

The Board notes that each of the embodiments of the invention concerning a plate-shaped or roughly plate-shaped and/or substantially U-formed hook point member described in the originally filed documents (see page 3, last paragraph, page 4, last paragraph, page 5, 3rd paragraph to page 6, 3rd paragraph, page 12, first full paragraph to page 13, 1st paragraph, claims 6, 7 and 8) includes not only a hook point facing in direction A but also a loop retainer claw on its opposite side.

The argument that the "claw" was included in the embodiment of dependent claim 3 cannot be accepted because the subject-matter of each independent claim has to be examined in respect of Article 123(2) EPC.

3.2 Consequently a rotating hook assembly according to each claim 1 of the auxiliary requests without such claw was not disclosed in the application documents as filed. The subject-matter of claim 1 of the first and second auxiliary requests therefore extends beyond the content of the application as filed.

Therefore the auxiliary requests are also not allowable under Article 123(2) EPC.

4. *Request for reimbursement of Appeal fee*

The Appellant sees a procedural violation in that the Examining Division did not carry out a substantive examination of the application although the examination fee had been paid.

According to Rule 67 EPC a condition to be fulfilled before considering reimbursement of the appeal fee is that the appeal is deemed to be allowable. Since in the present case the appeal is dismissed the appeal fee cannot be reimbursed.

In any case, in the Board's opinion no procedural violation can be derived from the fact that the Examination Division stopped examination after their conclusion that the claimed subject-matter did not meet the requirements of Article 123(2) EPC i.e. the Applicant cannot demand examination of subject-matter that does not belong to the patent application.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau