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**D E C I S I O N**  
**of 15 May 2002**

**Case Number:** T 0203/00 - 3.2.6

**Application Number:** 90313333.8

**Publication Number:** 0436313

**IPC:** D04B 9/06

**Language of the proceedings:** EN

**Title of invention:**  
Circular knitting machine

**Patentee:**  
PRECISION FUKUHARA WORKS, LTD

**Opponents:**  
Mayer & Cie. GmbH & Co.  
Terrot Strickmaschinen GmbH

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 54(1)

**Keyword:**  
"Clarity of claim 1 - yes"  
"Novelty - yes"  
"Remittal to first instance - yes"  
"Apportionment of costs - no"

**Decisions cited:**  
T 0199/90

**Catchword:**  
-





Case Number: T 0203/00 - 3.2.6

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.6**  
**of 15 May 2002**

**Appellant:** PRECISION FUKUHARA WORKS. LTD  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 21 December 1999  
revoking European patent No. 0 436 313 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. Alting van Geusau  
**Members:** G. C. Kadner  
M. J. Vogel

## Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 436 313 in respect of European patent application No. 90 313 333.8 claiming a Japanese priority from 11 December 1989 and filed on 7 December 1990 was published on 25 October 1995.

Claim 1 of the patent reads as follows:

"A knitting machine comprising:

a frame (1, 27, 28),

a needle cylinder (6), releasably mounted upon said frame for rotative movement relative to said frame during operation of said machine,

a generally vertical support shaft (20) carried by said frame,

a needle dial (17) releasably secured to said support shaft (20),

a support sleeve (19b) encircling said support shaft (20),

a dial cam holder (18) carried by said support sleeve (19b)

control means (26, 29) for lifting and lowering said support sleeve (19b) whereby said dial cam holder (18) and said needle dial (17) are vertically moved so as to provide vertical clearance between said needle dial (17) and said needle cylinder (6),  
characterised in that:

said support shaft (20) has a circular stepped portion (20b) at its lower end,

said needle dial (17) has an opening (17c) closely receiving said stepped portion (20b) of said support shaft (20) and a support shaft engaging upper surface (17a) and an upper dial cam holder engaging surface

(17b) that are flush with each other, and  
said vertical clearance is sufficient to permit  
lateral movement of said needle cylinder (6) into and  
from said knitting machine."

II. Two notices of opposition were filed on the grounds of  
Article 100(a), and (b) EPC on 25 July 1996.

In respect of an alleged lack of novelty and inventive  
step the following documents were relied upon:

D1: DE-A-23 25 788

D2: DE-C-177 577

D3: DE-A-26 09 101

D4: DE-A-15 60 924

D5: EP-A-0 413 608 (an Article 54(3) EPC document)

Opponent 02 additionally raised objections under  
Article 83 EPC and held that the subject-matter of  
claim 1 was not sufficiently disclosed so as to be  
capable of being carried out by a skilled person.

III. By decision announced on 13 September 1999 and posted  
on 21 December 1999 the Opposition Division revoked  
European patent No. 0 436 313 on the basis of a new  
claim 1 which had been amended during opposition  
proceedings under Article 84 EPC. This claim 1 (with  
amendments in *Italics*) reads as follows:

"A knitting machine comprising:  
a frame (1, 27, 28),

a needle cylinder (6), releasably mounted upon said frame for rotative movement relative to said frame during operation of said machine,

a generally vertical support shaft (20) carried by said frame,

a needle dial (17) releasably secured to said support shaft (20),

a support sleeve (19b) encircling said support shaft (20),

a dial cam holder (18) carried by said support sleeve (19b)

control means (26, 29) for lifting and lowering said support sleeve (19b) whereby said dial cam holder (18) and said needle dial (17) are vertically moved so as to provide vertical clearance between said needle dial (17) and said needle cylinder (6),  
characterised in that:

said support shaft (20) has a circular stepped portion (20b) at its lower end,

said needle dial (17) has an opening (17c) closely receiving said stepped portion (20b) of said support shaft (20) *within the opening*, and a support shaft engaging upper surface (17a) *about the opening and engaging the lower end of the stepped portion* and an upper dial cam holder engaging surface (17b) *defining the upper surface of the needle dial, said shaft engaging upper surface and upper dial cam engaging surface being flush with each other*, and

said vertical clearance is sufficient to permit lateral movement of said needle cylinder (6) into and from said knitting machine."

The Opposition Division held that this claim 1 included unresolvable contradictions as to which surface was in contact with one another, and therefore the scope of

the claim was not clearly defined because it was not understandable.

- IV. On 18 February 2000 the Appellant (Patentee) lodged an appeal against this decision simultaneously paying the appeal fee. The statement of grounds of appeal was filed on 28 April 2000. In addition to a main request for maintenance of the patent in its granted form the Appellant filed new claims in accordance with a first and second auxiliary request.
- V. In a communication dated 19 January 2002 the Board of Appeal expressed the preliminary opinion that discussion of granted claim 1 with respect to D5 or eventually - if novelty vis-a-vis that document was denied - of the claims according to the auxiliary requests appeared to be necessary, and that remittal of the case to the department of first instance would have to be considered.
- VI. Oral proceedings were held on 15 May 2002.

The Appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request);

auxiliarily maintenance of the patent in amended form on the basis of the claims in accordance with the first and second auxiliary request filed with the statement of grounds of appeal or the third auxiliary request filed with letter dated 10 April 2002;

apportionment of costs in case the Board decided to remit the case to the first instance.

The Respondents (Opponents) requested that the appeal be dismissed and the patent be revoked, auxiliarily that the case be remitted to the first instance for further prosecution and that the request for apportionment of costs be rejected.

VII. In support of its request the Appellant essentially relied upon the following submissions:

With regard to decision T 199/90 the skilled person would draw the disclosure of the whole patent into consideration when trying to understand the subject-matter claimed. When applying the principle of willingness to understand the teaching of the patent, its disclosure was sufficient to enable a skilled person to comprehend the technical function and relations of the features of the knitting machine according to claim 1.

The subject-matter of granted claim 1 was novel because the surfaces disclosed in Figure 2 of D5 corresponding with 17a and 17b of the patent in suit were not "flush" with each other. The skilled person would clearly understand that the expression "flush" did not apply to the needle dial of D5 because there was an upstanding lip or projection between the internal surface and the external surface. Furthermore no indication was given in D5 in which plane these surfaces were arranged. In contrast to the needle dial disclosed in D5 the surfaces of the needle dial of the patent could be ground in one operation. Furthermore, having regard to decision T 199/90, despite a similar wording in the description of the patent in suit the skilled person would nevertheless understand that the stepped portion 15 according to D5 had a different function when



compared to the circular stepped portion 20b according to the patent since it was not received in an opening of the dial 11 but only in contact with a stepped portion of it. Since the case could be decided in appeal there was no reason for remittal to the first instance, and therefore the Respondent's request in this respect should be rejected. Otherwise an apportionment of costs in the Appellant's favour was considered appropriate.

VIII. The Respondent's submissions are summarised as follows:

Discussion of novelty was hardly possible because claim 1 was not clear enough so as to compare its subject-matter with that of D5. Particularly it was not understandable in which way surface 17b "engaged" the upper dial cam holder surface.

In any case the subject-matter of claim 1 was not novel because the description of D5 (column 3, lines 35 to 39) disclosed the arrangement of the dial 11 with the stepped portion 15 of the shaft 14 in identical wording. The literal meaning of "flush" would not only be restricted on coplanar surfaces without a projection between them but would also include that these surfaces lay in the same plane irrespective of a projection or a recess between them. Thus the embodiment of D5 was included in the scope of claim 1 of the patent in suit since lifting of the inner sleeve 16a in order to provide a vertical clearance which allowed lateral movement of the dial 11 was carried out in identical manner (column 4, lines 37 to 45).

In case the Board concluded that the subject-matter of granted claim 1 was novel remittal of the case to the

first instance was necessary since the issue of inventive step had not been discussed up to now, and the Respondent had the right for prosecution of its opposition before two instances. There was thus no reason for an apportionment of costs in the Appellant's favour.

## **Reasons for the Decision**

1. The appeal is admissible.
2. *Interpretation of claim 1*
  - 2.1 Interpretation of the subject-matter of claim 1 is necessary in view of the fact that there are some inconsistencies in claim 1 and in the description of the patent as granted. However, a skilled person in the field of textile engineering having particular knowledge of knitting machines is able to derive the technical content of claim 1 clearly and unambiguously from the patent as a whole, in particular when having regard to the figures in the patent specification. In this respect Figure 2 shows clearly that surface 17b of the needle dial is not "engaged" with the opposing surface of the dial cam holder 18 as is formulated in claim 1 but is arranged to allow a small gap between them. When considering the operation of such knitting machines it is clear that the movement of the needles being guided in the radially extending grooves of the needle dial 17 is controlled by the opposed groove within the camholder 18. Therefore the skilled person understands the wrong expression "engaged" to mean opposed by a small gap.

2.2 Furthermore, considering the assembly of needle dial 17 and support shaft 20 defined in claim 1, the question arises as to what part of the support shaft engages the support shaft engaging upper surface 17a. This cannot be the "stepped portion" of the support shaft because that portion is received in the opening 17c. The skilled person is thus aware of the need for reference to the description and drawings because claim 1 itself does not give an answer to that question. However, when taking into account the description and drawings of the patent it is immediately clear that the support shaft has at its lower end a flange 20a carrying the stepped portion 20b. It is this flange 20a which engages the surface 17a.

Therefore when interpreting claim 1 the skilled person comes to the conclusion that the support shaft carries at its lower end a flange contacting with its lower surface the needle dial surface 17a and a stepped centre portion for centring the support shaft in the needle dial opening 17c.

2.3 With respect to the meaning of "flush" the Board cannot share the opinion of the Respondent. In accordance with excerpt of THE NEW COLLINS DICTIONARY filed by the Respondent "flush" has to be interpreted as "level or even with another surface", "directly adjacent" or "continuous" which excludes a step or projection between the surfaces being "flush" with one another.

### 3. Novelty

3.1 In agreement with the parties to the appeal the Board concludes that D5 discloses the features of the pre-characterising portion of claim 1. Furthermore D5

discloses that the support shaft 14 has a circular stepped portion 15 at its lower end, and the vertical clearance when lifting the support sleeve 16a is sufficient to permit lateral movement of the needle cylinder 9 into and from the knitting machine (column 3, lines 35 to 39; column 4, lines 37 to 45).

3.2 Considering whether D5 discloses further features of claim 1 it is to be noted that this document does not disclose any indication of a distinct relation between the internal surface of the needle dial 11 adjacent to the stepped portion 15 and the external surface opposing the dial cam holder 16 which might lead to the conclusion that these surfaces lie in the same plane. In Figure 2 it is not clearly recognisable whether both surfaces have the same level or not. Since there is an annular centring projection adjacent the internal surface, clearly both surfaces are not "flush" with one another in the meaning of claim 1.

3.3 The knitting machine of claim 1 differs from the disclosure of D5 further by the assembly of the support shaft and the needle dial. D5 discloses a flange 15 which is received in a stepped bore (see Figure 2). When comparing Figures 2 of the patent and of D5 the skilled person immediately recognises the different manner of centring the needle dial in respect of the support shaft. While D5 shows an external centring where no portion is closely received in the opening of the needle dial, the patent discloses an internal or self-centring of the needle dial in respect of the support shaft by means of a protrusion 20b on the flange 20 (see also point 2.2 above).

3.4 In view of these differences the subject-matter of

claim 1 meets the requirement of novelty when compared with the disclosure of D5 (Article 54(1) EPC). Since D5 is a document according to Article 54(3) EPC it has no longer to be taken into account when inventive step is considered.

4. Since substantive examination in respect of inventive step has not yet been carried out by the Opposition Division, and it would not comply with the requirement of fair proceedings if the Respondents were not be given the occasion to prosecute the further grounds of opposition in two instances, the case has to be remitted to the first instance for further examination of the opposition.

5. *Apportionment of costs*

In accordance with Article 104(1) each party to the proceedings shall meet the costs it has occurred unless apportionment is ordered for reasons of equity.

In the Board's opinion apportionment of costs is not justified because neither the oral proceedings before the Board of Appeal nor the future proceedings effected by remittal to the first instance are caused by inequitable procedural actions of the Respondent. Each party shall have the right to request prosecution before two instances, and since substantive criteria of patentability have not yet been considered, the request of the Respondent for remittal to the first instance is allowable and without further consequences in respect of apportionment of costs.

**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.
3. The request for apportionment of costs is rejected.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau