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D E C I S I O N
of 4 May 2004

Case Number: T 1226/01 - 3.2.1

Application Number: 92915989.5

Publication Number: 0592602

IPC: B66C 23/62

Language of the proceedings: EN

Title of invention:

Swing lock mechanism for construction equipment with rotatable upper works

Patentee:

Manitowoc Crane Companies, Inc.

Opponent:

Liebherr-Werk Ehingen GmbH

Headword:

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Relevant legal provisions:

EPC Art. 54, 56, 114(1)

Keyword:

"Novelty - main request (yes)"

"Inventive step - fresh ground for opposition (not admitted)"

Decisions cited:

G 0010/91, G 0001/95, G 0007/95, T 0928/93, T 0131/01

Catchword:

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Case Number: T 1226/01 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 4 May 2004

Appellant: Liebherr-Werk Ehingen GmbH
(Opponent) Münsingerstrasse 80
D-89584 Ehingen (DE)

Representative: Gossel, Hans K., Dipl.-Ing.
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Respondent: Manitowoc Crane Companies, Inc.
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Representative: Bayliss, Geoffrey Cyril
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 November 2001
rejecting the opposition filed against European
patent No. 0592602 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: S. Crane
Members: F. J. Pröls
G. E. Weiss

Summary of Facts and Submissions

- I. European patent No. 0 592 602 granted 27 May 1998 was opposed by the appellants (opponents) on the grounds that its subject-matter lacked novelty (Article 100(a) EPC).

Claim 1 of the granted patent reads as follows:

"A crane (10) having an upper works (12), a lower works (14), and a swing bearing (40) connecting the upper works (12) and the lower works (14) so as to allow the upper works (12) to be rotatable with respect to the lower works (14), the lower works (14) further comprising a gear with teeth (44) thereon for use in causing rotation of the upper works (12); the crane (10) also comprising a swing lock mechanism comprising a swing lock segment (90) comprising teeth adapted to intermesh with said gear teeth (44) when the swing lock segment is in an engaged position; characterised by further comprising:

a piston (95) actuatably mounted in a cylinder (94), the cylinder (94) being secured to the upper works (12) and the piston (95) being connected to said swing lock segment (90) so as to move said swing lock segment (90) into and out of said engagement position upon actuation of the piston (95) and cylinder (94), and a connector link (91) connected to said swing lock segment (90), said connector link (91) having a means for rigidly holding said swing lock segment (90) in its engaged position to thereby prevent the swing lock segment (90) from disengagement when resisting a swing torque."

As evidence of the state of the art the appellants relied in the notice of opposition on documents E1 showing a technical drawing of the appellant dated 16 June 1982, with the drawing number 1355-651.02.00000-002 and an identification number 9116543 and E2 showing a delivery list, dated 3 April 1984 concerning order No. 0011943 of the company MEDIACO. Both documents allegedly concerned a crane delivered by the appellants to this company. As further evidence they offered the testimony of a witness.

With its decision posted 2 November 2001 the Opposition Division rejected the opposition.

- II. A notice of appeal against that decision was filed on 19 November 2001 and the appeal fee was paid at the same time. The statement of grounds of appeal was received on 7 January 2002.
- III. Oral proceedings before the Board were held on 4 May 2004.
- IV. The appellants (opponents) requested that the decision under appeal be set aside and the patent be revoked.

The respondent (patentee) requested that the appeal be dismissed (main request) or in the alternative that the patent be maintained in amended form on the basis of the sets of claims according to first and second auxiliary requests submitted with letter dated 5 April 2004.

V. The arguments of the appellants in support of their request for revocation of the patent were substantially as follows:

The prior used crane not only had the same general construction of the claimed crane but also the contested feature in the last lines of claim 1 concerning the connector link having a means for rigidly holding said swing lock segment in its engaged position to thereby prevent the swing lock segment from disengagement when resisting a swing torque. The drawing E1 disclosed a swing lock segment with a connector link having an actuator piston mounted in a cylinder. Such a hydraulically actuated unit must be necessarily associated with means rigidly holding the piston in a position preventing movement of the swing lock segment and disengagement of its teeth from the intermeshing gear teeth of the lower works of the crane. The last feature in claim 1 could not be understood as representing a connector link which itself is associated with the holding means. This is merely shown in the embodiment of the patent specification. As a consequence the subject-matter of claim 1 lacked novelty.

Even if claim 1 should be interpreted as describing holding means associated with the connector link then the teaching of the claim would not involve an inventive step since it was obvious for a skilled person to transfer the holding means from the hydraulic actuator to the connector link. These observations were already forwarded in written form in the appeal proceedings.

VI. The respondents argued essentially the following in reply:

Claim 1 clearly required that the connector link has itself the holding means. This was not present in the drawing E1 according to the alleged prior use.

Furthermore E1 did also not show that the piston has any holding means. Thus, the subject-matter of claim 1 is novel with respect to document E1. The alleged lack of inventive step represented a fresh ground for opposition which could only be considered in appeal proceedings with the approval of the patentees which was not given by them.

Reasons for the Decision

1. The appeal meets the requirements of Article 106 to 108 and Rule 64 EPC and is therefore admissible.

2. Claim 1 of the patent in suit expressively says that the swing lock mechanism further comprises "a piston actuatably mounted in a cylinder... the piston being connected to the swing lock segment... and a connector link connected to said swing lock segment." Claim 1 further says "said connector link having a means for rigidly holding said swing lock segment..." and so makes it clear that the holding means represent a complementary mechanism associated with the connector link and not with the piston. Furthermore the statements in claim 1 as concern the arrangement of the cylinder in the upper work of the crane and the functioning of its piston "being connected to said swing lock segment so as to move said swing lock segment into and out of said engagement position upon

actuation of the piston and cylinder" on the one hand and the accentuation of the connector link with reference to the holding means on the other hand make it also clear that the holding means are not represented by the piston-cylinder unit as the appellant argues.

Subsequently in document E1 the actuating piston-cylinder unit even if associated with means such as a hydraulic stop rigidly holding the piston in an end position to prevent the swing lock segment from disengagement would clearly differ from the swing lock mechanism having a holding means which is associated to the connector link as claimed by the patent in suit.

Thus, it is apparent that a crane having all features of claim 1 is not disclosed in the drawing according to E1 and therefore is novel.

3. In the opposition procedure an objection relating to inventive step was not raised and substantiated as a ground for opposition. The appellants submitted such an objection in very general terms for the first time in the statements of grounds of appeal and sought to amplify their observations at the oral proceedings.

The patentees relying on G 9/91 and G 10/91, point 18 of the reasons for the decision (OJ 1993, 408 and 420) protested about the belated introduction of what was effectively a new ground for opposition.

For their part the respondents argued that it was not a new ground at all since this objection had already been raised in writing in the appeal proceedings

4. The decisions G 1/95 (OJ 1996, 615) and G 7/95 (OJ 1996, 626) state under point 4.4, first sentence of the reasons of the decision that

"The totality of these Articles (namely Articles 52 to 57 EPC) within the meaning of Article 100(a) EPC do not therefore constitute a single objection to the maintenance of the patent, but a collection of different objections, some of which are completely independent from each other (eg Article 53 and Articles 52(1), 54 EPC), and some of which may be more closely related to each other (eg Articles 52(1), 54 and Articles 52(1),56 EPC."

Thus, the Enlarged Board of Appeal found that the meaning of the legal concept "fresh ground for opposition" as used in point 18 of G 10/91 (*supra*) must be interpreted as having been intended to refer to a ground for opposition which was neither raised and substantiated in the notice of opposition, nor introduced into the proceedings by the opposition division in accordance with the principles set out in point 16 of G 10/91. Having clarified the meaning of these two terms, the Enlarged Board of Appeal (G 1/95, G 7/95) went on to decide on the questions referred to it and decided in G 7/95 (*supra*) that, in a case where a patent had been opposed under Article 100(a) EPC on the ground that the claims lacked an inventive step in view of documents cited in the notice of opposition, the ground of lack of novelty vis-à-vis the said documents based on Article 52(1) EPC and Article 54 EPC was a fresh ground for opposition and accordingly could not be introduced into the appeal proceedings without

the agreement of the patentee. It follows by analogy that an objection of lack of inventive step is in principle a different objection having a different legal basis from the objection of lack of novelty. Therefore, the objection of lack of inventive step cannot be introduced into the appeal proceedings without the agreement of the patentee, because it constitutes a "fresh ground for opposition" within the meaning of paragraph 18 of G 10/91.

In T 928/93 (not published in OJ) an objection based on lack of an inventive step was raised for the first time by the appellants/opponents during the appeal proceedings in their reply to the summons to oral proceedings. The originally raised objections based on novelty failed and the respondents/patentees did not give their consent for an examination of inventive step. The Board therefore did not admit the new ground of opposition based on inventive step.

Decision T 131/01 (OJ 2003, 115) was concerned with a case in which the appellants/opponents raised opposition in essential on the ground of lack of novelty. Besides this they have also marked the box of standard form EPO 2300.2-04.89 indicating that it lacks an inventive step (Articles 52(1), 56 EPC) with a cross. Moreover, it was apparent from the notice of opposition that the claimed subject-matter was not considered inventive vis-à-vis a cited prior art document even if there were any features in claim 1 which were not identically present in this prior art, since those features would be obvious for a skilled person. The Board did not judge this objection as fresh ground for opposition even though the Opposition

Division had decided to disregard it when the opponents sought to pursue it at the oral proceedings. The Board therefore admitted the objection without agreement of the patentees.

5. In the present case (contrary to T 131/01) nothing was stated in the notice of opposition to the effect that an objection relating to lack of inventive step was being raised. Nor did the opponents seek at any stage during the opposition proceedings to argue on the basis of lack of inventive step rather than novelty.

Furthermore the allegation on which the appellants have essentially based their objection of lack of inventive step, i.e. that in the prior used crane the piston and cylinder arrangement was also provided with holding means, was presented for the first time in the appeal proceedings, novelty having been previously challenged with a completely different line of argumentation, and it is manifestly clear that the alleged feature cannot be derived from the documents E1 and E2 themselves. Thus in contrast to the objection of lack of novelty, which for the reason given above could be dealt with by the Board without the need to hear the witness, this would not have been the case with the objection of lack of inventive step, entailing an undue delay in the procedure.

Given that the patentees did not agree to the introduction of the fresh ground for opposition, see above, the objection of the appellants based upon Articles 52(1) and 56 EPC, is rejected as inadmissible.

6. The remaining opposition ground relating to lack of novelty (Articles 52(1) and 56 EPC) does not prejudice the maintenance of the patent as granted.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Vottner

S. Crane