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D E C I S I O N
of 9 August 2005

Case Number: T 1072/03 - 3.2.7

Application Number: 98306468.4

Publication Number: 0899064

IPC: B25F 3/00

Language of the proceedings: EN

Title of invention:

A power tool having interchangeable tool head

Patentee:

Black & Decker Inc.

Opponent:

Shanghai Xing Te Hao Industrial Co., Ltd.

Headword:

-

Relevant legal provisions:

EPC Art. 100(a)(b)(c), 123(2)

RPBA Art. 10b

Keyword:

"Grounds under Article 100(a)(b) - not substantiated"

"Added subject-matter - yes"

"Request filed during oral proceedings - not admitted"

Decisions cited:

-

Catchword:

-



Case Number: T 1072/03 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 9 August 2005

Appellant: Black & Decker Inc.
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Respondent: Shanghai Xing Te Hao Industrial Co., Ltd
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 12 September 2003
revoking European patent No. 0899064 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: C. Holtz
Members: P. O'Reilly
K. Poalas

Summary of Facts and Submissions

- I. Opposition was filed against European Patent No. 0 899 064 as a whole and was based on Article 100(a) EPC (lack of novelty and lack of inventive step), Article 100(b) EPC (insufficiency) and Article 100(c) EPC (added subject-matter).

The Opposition Division revoked the patent on the basis that one of two alternatives specified in claim 1 as granted was not disclosed in the application as filed in contravention of Article 123(2) EPC. It further held that the grounds under Article 100(a)(b) EPC had not been substantiated and therefore did not examine them.

- II. The appellant (proprietor) filed an appeal against the decision of the Opposition Division.

- III. The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of claims 1 to 3 filed with the grounds of appeal dated 8 October 2003 (main request). Alternatively, the patent should be maintained in amended form on the basis of the set of claims auxiliary request number 2 also filed with the appeal grounds (first auxiliary request), or in accordance with the auxiliary request filed during the oral proceeding before the Board on 9 August 2005 (second auxiliary request).

The respondent (opponent) made no requests or submissions during the appeal proceedings.

IV. The independent claim of the main request reads as follows:

"1. A power tool (2) comprising a tool body (4) having a clam shell comprising an outer rim (76) having a motor (20) with a direct rotary output (24) about an axis (49) and a detachable tool head (50) having a substantially cylindrical outer body (54), wherein the tool head comprises a drive mechanism for engagement with the motor output (24), said motor output comprising a first engagement means (32) for complimentary engagement with a second engagement means (104) on said head drive mechanism when said tool head (50) is connected to said tool body (4); said first engagement means being recessed within said body and accessible through an aperture in said body and said second engagement means being recessed within said tool head and accessible through a second aperture in said tool head; the second engagement means being formed within a spigot (62) which spigot (62) may be received within a chamber (47) formed from the tool body (4), whereby such spigot (62) engages and co-operates with the tool body to restrain that spigot (62) from axial displacement when the first and second engagement means (32, 104) are engaged; wherein said spigot is disposed co-axial about a drive axis (60) characterised in that said spigot (62) has a diameter substantially less than the diameter of said tool head on which it is disposed, such that when said spigot is received within said chamber (47) it is restrained radially remote from the outer rim (76) of the tool body (4)."

The independent claim of the first auxiliary request reads as follows (amendments when compared to claim 1 of the main request are depicted in bold):

"1. A power tool (2) comprising a tool body (4) having a clam shell comprising an outer rim (76) having a motor (20) with a direct rotary output (24) about an axis (49) and a detachable tool head (50) having a substantially cylindrical outer body (54), wherein the tool head comprises a drive mechanism for engagement with the motor output (24), said motor output comprising a first engagement means (32) for complimentary engagement with a second engagement means (104) on said head drive mechanism when said tool head (50) is connected to said tool body (4); said first engagement means being recessed within said body and accessible through an aperture in said body and said second engagement means being recessed within said tool head and accessible through a second aperture in said tool head; the second engagement means being formed within a spigot (62) which spigot (62) may be received within a chamber (47) formed from the tool body (4), whereby such spigot (62) engages and co-operates with the tool body to restrain that spigot (62) from axial displacement when the first and second engagement means (32, 104) are engaged; wherein said spigot is disposed co-axial about a drive axis (60) characterised in that said spigot (62) has a diameter substantially less than the diameter of said tool head on which it is disposed, such that when said spigot is received within said chamber (47) **it is received in a complimentary fit therewithin and** is restrained radially remote from the outer rim (76) of the tool body (4)."

The independent claim of the second auxiliary request reads as follows (amendments when compared to claim 1 of the main request are depicted in bold or struck through):

"1. A power tool (2) comprising a tool body (4) having a clam shell comprising **a front extension plate (38) and substantially parallel thereto, an outer extension plate (45), the two extension plates serving to define a chamber (47)** an outer rim (76) having a motor (20) with a direct rotary output (24) about an axis (49) and a detachable tool head (50) having a substantially cylindrical outer body (54) **which is ergonomically designed to match the exterior contours of the tool body (4)**, wherein the tool head comprises a drive mechanism for engagement with the motor output (24), said motor output comprising a first engagement means (32) for complementary engagement with a second engagement means (104) on said head drive mechanism when said tool head (50) is connected to said tool body (4); said first engagement means being recessed within said body and accessible through an aperture in said body and said second engagement means being recessed within said tool head and accessible through a second aperture in said tool head; the second engagement means being formed within a spigot (62) which spigot (62) may be received within a chamber (47) formed from the tool body (4), whereby such spigot (62) engages and co-operates with the tool body to restrain that spigot (62) from axial displacement when the first and second engagement means (32, 104) are engaged; wherein said spigot is disposed co-axial about a drive axis (60) characterised in that **extended rearwardly of the outer body portion (54) is a substantially cylindrical spigot**

(56) which is shaped so as to fit snugly within a cylindrical opening (22) of the body (4), the cylindrical opening (22) being defined by a series of inwardly directed ribs (23) forming a substantially cylindrical chamber; cylindrical spigot (56) has a substantially flat circular rear wall (58) designed about a head axis (60); projecting rearwardly of wall (58) so as to extend co-axially with the axis (60) is spigot (62); spigot (62) being substantially cylindrical and hollow and having a series of exterior cylindrical ribs (64) which define an outer cylindrical recess (66); said spigot (62) has a diameter substantially less than the diameter of the spigot (56) and that the body (4) is further provided with a resiliently biased locking mechanism within the chamber (47) defined between a front extension plate (38) and an outer extension plate (46), said locking mechanism comprising a resilient mechanism comprising two resiliently biased spring wires disposed symmetrically about the axis (60) which extend across respective apertures (42, 48) formed in extension plates (38, 46); ~~said tool head on which it is disposed~~, such that when said spigot is received within said chamber (47) it is restrained radially, remote from the outer rim (76) **or outer body (54)** of the tool body (4)."

- V. In a communication accompanying the summons to oral proceedings the Board set out its provisional opinion. In the communication the Board indicated its opinion that that a number of features of claim 1 as granted were not disclosed in the application as filed (Article 123(2) EPC). The Board further expressed the provisional opinion that the amendments made with the

auxiliary requests filed with the appeal grounds did not comply with Article 123(2) EPC.

VI. The appellant argued in written and oral submissions essentially as follows:

- (i) The deletion of the alternative which the Opposition Division considered to be added subject-matter overcomes the reasons of the Opposition Division for its revocation of the patent.

- (ii) With regard to the main request the feature concerning the cooperation and engagement of the spigot with the tool body to restrain axial movement is disclosed on page 10, lines 23 to 29 of the application as filed. In that passage of the description the engagement of the spigot is mentioned as well as its axial restraint so that there is a basis for the amendment.

The feature that the spigot is restrained radially remote from the outer rim of the tool body is disclosed in particular on page 8, lines 22 to 25, wherein the ribs 23 are described, and in figure 5. Moreover the claim must be interpreted by the description in accordance with Article 69(1) EPC and the description discloses an ergonomic matching of the shoulder portion 74 with the tool body 4 as disclosed on page 8, lines 7 to 11 and page 10, lines 5 to 9. Therefore the claim must be interpreted as implying an ergonomic matching between shoulder 74 and tool body 4 which implies

that there is a restraint on the movement of the tool head.

- (iii) With regard to the extra feature included in the first auxiliary request, page 10, lines 2 to 5 of the description describes the snug fit of the spigot 56 in the opening 22. Also, on page 9, lines 26 to 33 the complementary fit of the spigots 62 and 56 respectively in apertures 42 and 48 in the respective extension plates 38 and 46 is described. The chamber 47 is defined on page 7, lines 15 to 19 to be formed between the extension plates 38 and 46. Therefore there is a complementary fit of the spigot 62 in the chamber 47.

- (iv) The second auxiliary request should be admitted into the proceedings. It is only in the oral proceedings before the Board that the appellant has learnt the detailed objections of the Board. No adjournment of the oral proceedings is necessary so that the admittance of the request complies with Article 10b of Rules of Procedure of the Boards of Appeal.

There is no problem with the right to be heard of the respondent since the appellant has an agreement with the respondent that the respondent will not pursue the opposition further.

Reasons for the Decision

1. *Article 100(a)(b) EPC*

The Opposition Division considered that these grounds were not substantiated during the period for opposition and hence were not in the proceedings. The Board concurs with that view of the Opposition Division. Moreover, the respondent during oral proceedings before the Opposition Division indicated that he did not wish to pursue these grounds. The respondent made no submission during the appeal proceedings and hence did not pursue these grounds in the appeal proceedings either.

Main Request

2. *Article 123(2) EPC*

2.1 The Opposition Division revoked the patent on the basis that claim 1 as granted contained an alternative whereby the chamber (47) could be formed in the tool head (50) (as opposed to the tool body (4)). The appellant amended claim 1 of the main request filed with the appeal grounds, which is still the main request considered in this decision, to delete this alternative. The Board is satisfied that this deletion does not contravene Article 123(2) EPC since the deletion removes subject-matter from the claim without adding any.

2.2 Claim 1 of the patent as granted includes the feature that "such spigot (62) engages and co-operates with the tool body to restrain that spigot (62) from axial

displacement when the first and second engagement means are engaged". The claims as originally filed did not contain this feature. The appellant argued that this feature is disclosed on page 10, lines 23 to 29 of the application as filed. That passage is indeed the only passage which could come into consideration to support the amendment. In the preceding passage in lines 15 to 23 the purpose of two resiliently biased wires in the chamber 47 into which the spigot is inserted is explained. In the above cited passage it is explained that insertion of the spigot deflects the resilient wires until they engage with a cylindrical recess in the outer surface of the spigot to restrain the spigot from further axial displacement. The description thus informs the skilled person of the presence of a particular locking mechanism which includes resilient wires in the body 4 and a cylindrical recess on the outer surface of the spigot. The description further informs that there are wires in the body which engage with the spigot. The skilled person receives no information regarding any generalised manner of cooperation which allows just the spigot to engage in any manner with the tool body to restrain the spigot from axial motion. The only engaging action which is disclosed is performed by the resilient wires engaging with the recess to restrain the spigot.

The argument of the appellant that the above cited passage mentions both engagement and restraint is clearly an insufficient basis for a generalisation since it ignores the context in which the engagement and restraint are described, i.e. that they are effected by a specific mechanism. The Board concludes therefore that this feature of the patent as granted

was not part of the content of the application as originally filed.

- 2.3 Claim 1 of the patent as granted further includes the feature that "said spigot (62) has a diameter substantially less than the diameter of said tool head on which it is disposed, such that when said spigot is received within said chamber (47) it is restrained radially remote from the outer rim (76) of the tool body (4)". The claims as originally filed did not contain this feature. Although the description of the application as filed indicated that the diameter of the spigot 62 was substantially less than the diameter of a spigot 56 on said tool head on which it is disposed there was no explicit disclosure linking this fact to a radial restraint remote from the outer rim of the body. There is a disclosure in the application as filed that the spigot 56 fits snugly into a cylindrical opening 22. However, such a specific disclosure does not form a basis for the expression "remote from the outer rim (76) of the tool body (4)", nor does it form a basis for the radial restraint being a result of the difference in diameter between the spigots 56 and 62.

In order to support the disclosure of this feature in the description the appellant referred to page 8, lines 7 to 11 of the application as filed. In that passage a cylindrical outer body portion 54 is stated to be ergonomically designed to match the outer contours of the body portion 4. The appellant argued that the claim has to be interpreted in view of Article 69(1) EPC as being limited to this form. The Board cannot agree with the appellant. In the first place there is nothing in the description to indicate

that this particular feature of an embodiment of the invention is such that the claims must be considered as being limited to that feature. Indeed this line of argument would require the claim to be interpreted to include all the features of the embodiment of the invention. This is clearly not the intention of Article 69(1) EPC. Moreover, this interpretation does not help the appellant since this feature of the description concerns the axial restraint and hence is irrelevant to a feature of the claim concerning the radial restraint.

- 2.4 Therefore, claim 1 of the main request does not comply with Article 123(2) EPC.

First auxiliary request

3. *Article 123(2) EPC*

- 3.1 This request includes the feature that "it [said spigot] is received in a complimentary (*sic*) fit therewithin [said chamber]". In the description on page 7, lines 15 to 19 the chamber is stated to be defined by two extension plates 38, 46. This definition is confirmed on page 10, lines 14 to 15. The chamber is thus formed by these plates 38 and 46. If the spigot is received as a complementary fit within this chamber then it should have a shape which complements that of the chamber. There is however no disclosure in the description of such a complementary fit. There is a disclosure, which was referred to by the appellant, of a complementary fit of the spigot in respective apertures 42 and 48 of the extension plates. However, it is quite clear that a disclosure of a complementary fit of a spigot in two

apertures in a pair of plates is not a disclosure of a complementary fit in a chamber formed between those plates. This amendment therefore adds subject-matter to the application as filed.

- 3.2 Therefore claim 1 of the first auxiliary request does not comply with Article 123(2) EPC for the same reasons as claim 1 of the main request and in addition with respect to the amendment made to the claim compared to claim 1 of the main request as explained in point 3.1 above.

Second auxiliary request

4. *Admissibility of the request*

- 4.1 In a communication accompanying the summons to oral proceedings the Board pointed out a number of matters with respect to Article 123(2) EPC in both the main request and the auxiliary requests that had been filed with the appeal grounds. The parties were requested to make any submissions at least one month before the oral proceedings. During the oral proceedings the representative of the appellant discussed each of these matters in turn using the communication of the Board as a basis for his arguments. The discussion during the oral proceedings did not go beyond the points raised in the said communication.

- 4.2 The amendments proposed to claim 1 of this request are quite extensive, almost doubling the length of the claim with matter taken from the description. The amendments are derived from various parts of the description. It would require an extensive examination

of the exact wording of the amendments as well as context in the description from which they are derived in order to establish whether they comply with Article 123(2) EPC. Also, because the amendments may imply changes in the relationships between different parts of the claim it would be necessary to carefully examine the amended claim for compliance with Article 123(3) EPC. The Board considers that there is no reason why these amendments could not have been filed earlier in response to the communication accompanying the invitation to oral proceedings. The filing of these amendments during the oral proceedings thus constitutes an abuse of the proceedings.

- 4.3 The appellant referred to Article 10b of the Rules of Procedure of the Boards of Appeal arguing that only amendments to a party's case after the issue of the summons to oral proceedings which lead to an adjournment of the oral proceedings are not admissible. The appellant is attempting to extract a right to actions as long as they are not specifically forbidden. However, such a right does not exist since it is clear from paragraph (1) of Article 10b that all amendments to a party's case are at the discretion of the Board.

The appellant argued that the amendments were made as a result of new matters raised during the oral proceedings. However, as already indicated no new matters were raised during the oral proceedings. Therefore this cannot be a justification in the present case.

4.4 The Board also considered the rights of the respondent who was not present during the oral proceedings. The argument of the appellant that they had an agreement with the respondent cannot be accepted. It is quite clear that an appellant is not in a position to waive the rights of another party. Such a waiving of rights can only be effected by the other party themselves and not on their behalf by their adversary. Nevertheless, since the Board was not prepared to admit the request for other reasons it is not necessary to consider further the right to be heard of the respondent.

4.5 The Board therefore decided not to admit the request into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

C. Holtz