

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 28 September 2010**

Case Number: T 2134/08 - 3.2.07

Application Number: 99310263.1

Publication Number: 1010497

IPC: B25F 3/00

Language of the proceedings: EN

Title of invention:
Power tool

Applicant:
Black & Decker Inc.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Amendments: not allowable (main request)"
"Late-filed auxiliary request: not admitted"

Decisions cited:
T 1126/97

Catchword:
-



Case Number: T 2134/08 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 28 September 2010

Appellant:

Black & Decker Inc.
Drummond Plaza Office Park
1423 Kirkwood Highway
Newark, DE 19711 (US)

Representative:

Shaya, Darrin Maurice
Black & Decker Europe
European Group Headquarters
210 Bath Road
Slough
Berkshire SL1 3YD (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 23 June 2008
refusing European patent application
No. 99310263.1 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: K. Poalas
I. Beckedorf

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the Examining Division refusing European patent application 99 310 163.1.
- II. In its decision the Examining Division held that the subject-matter of claim 1 according to the main request filed with fax on 23 January 2008 does not meet *inter alia* the requirements of Article 84 EPC and that the subject-matter of claim 1 according to the auxiliary request filed with the same fax does not meet *inter alia* the requirements of Articles 84 and 123(2) EPC.
- III. Oral proceedings before the Board took place on 28 September 2010, consecutive to those in case T 1723/08 (a divisional application of the present), with the consent of the appellant.
- IV. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of one of the sets of claims filed as main request with letter dated 3 October 2008 and as auxiliary request I during the oral proceedings.
- V. Independent claims 1 according to the main request and to auxiliary request I read as follows:

Main request

"A multi-function power saw having a linear reciprocating output formed at one end thereof, the power saw able to operate both as a panel saw and a jigsaw, the power saw including:

a plurality of different saw blades for cutting a workpiece, a first saw blade of the plurality of blades coupled to the linear reciprocating output to provide the panel saw;

and a second, different, saw blade of the plurality of saw blades coupled, in substitution to the first saw blade, to the linear reciprocating output to provide the jigsaw;

wherein, in order to allow the user of the power saw to hold the power saw in a first attitude relative to a workpiece to be cut, thus operating the power saw as a panel saw and to hold the power saw in a second attitude relative to a workpiece to be cut in order to operate the power saw as a jigsaw, the power saw includes:

a body (36) housing a motor for driving the power saw linear reciprocating output,

a handle (38), formed integrally with the body (36) at the end of the power saw remote from the linear reciprocating output, which handle (38) is accessible from more than one side thereof, the handle (38) positioned and angled relative to the body (36) to permit the handle (38) to be gripped by a user of the power saw in either:

one of the more than one said sides, corresponding to holding the power saw in the first attitude, or: another of the more than one said sides, which said another side corresponds to holding the power saw in the second attitude, this enabling a force applied to the handle (38) along a line of action to operate the power saw along that line of action regardless of whether the power saw is in the first or the second attitude,

a trigger (44) positioned adjacent the handle (38), the trigger positioned to be operable by a user when gripping the handle (38) and wherein the body of the

power saw defines two working surfaces (52, 54), one of which working surfaces (52) is used for resting the power saw on a workpiece when the power saw is held by the user in the second attitude".

Auxiliary request I

"A dual mode power saw able to operate both as a panel saw in a first mode and a jigsaw in the second mode and having a linear reciprocating output (2) formed at one end thereof, the power saw including:

a body (36) housing a motor for driving the power saw linear reciprocating output;

a first larger panel saw blade (12) for coupling to the linear reciprocating output to provide the panel saw;

and a second, smaller, jigsaw saw blade (12) for coupling, in substitution to the panel saw blade, to the linear reciprocating output;

a handle (38), formed integrally with the body (36) at the end of the power saw remote from the linear reciprocating output,

a trigger (44) positioned adjacent the handle (38), the trigger (44) being operable by a user when gripping the handle (38), wherein the handle (38) is positioned

relative to the body (36) of the saw, such that the saw is used in the panel saw mode with the first saw blade

mounted on the output (2) and held by a user in a first orientation and wherein the saw is used in the jigsaw mode with the second saw blade mounted on the output (2)

and held by a user in a second orientation wherein the first and second orientations correspond to two

accessible sides of the handle, respectively;

the handle (38) being positioned on the body (36) for the user to operate the saw such that a force applied

to the handle in a particular direction allows operation of the power saw in that direction regardless of in which of the plurality of modes the power saw used and held relative to the workpiece; and wherein the body of the power saw defines two working surfaces (52, 54), one of which working surfaces (52) is used for resting the power saw on a workpiece when the power saw is held by the user in the second orientation".

VI. The appellant argued as follows:

Main request: Amendments - Article 123(2) EPC

A multi-function power saw in the sense of being not only able to operate in the dual mode described in the originally filed application, namely either in the panel saw mode or in the jigsaw mode, but also being able to provide further additional operations has not been disclosed in the originally filed application.

With regard to the feature of claim 1 that the power saw defines two working surfaces 52, 54, one of which working surfaces 52 is used for resting the power saw on a workpiece, when the power saw is held by the user in the second attitude, reference is made to figure 13 of the application as filed wherein surface 52 is shown upon workpiece block 42. Furthermore the description at page 7, lines 18-19 and page 8, lines 28-31 explains that the jigsaw body 36 is held on the block of 42 via the working surface 52. It would be unfair to the appellant to limit its claim 1 as far as it concerns the working surfaces 52 and 54 by incorporating

additional structural features of the power saw shown in figure 13.

Auxiliary request I: admittance into the proceedings

Due to the amendments of claim 1 according to the auxiliary request I all objections raised in the Board's communication annexed to the summons to the oral proceedings have been overcome. The auxiliary request I should therefore be admitted into the proceedings.

Reasons for the decision

1. *Main request: Amendments - Article 123(2) EPC*

1.1 In its communication annexed to the summons to oral proceedings the Board stated *inter alia* the following:

"2. As to the fulfilment of the requirements of Article 123(2) EPC the Board comments as follows:

2.1 Claim 1 is now directed to a "*multi-function* power saw". In the originally filed application a power tool was claimed in claim 1, which "may be operated in two modes, each of which modes corresponds to one of the accessible sides of the handle", see originally filed claim 3.

A "*multi-function* power saw" does not mean that the saw is limited to be operated only in the two modes mentioned above and a basis for the expression "*multi-*

functional" cannot be found in the originally filed application.

.....

2.4 Claim 1 requires further that the power saw defines two working surfaces 52, 54, one of which working surfaces 52 is used for resting the power saw on a workpiece, when used in the second attitude.

Again, both figure 13 and the passages on Page 7, lines 18-19 and Page 8, lines 28-31 referred to by the appellant concern the specific configuration of the power saw shown in figures 12 and 13. The introduction of the two working surfaces into claim 1 taken in isolation from the description of said specific embodiments shown in figures 12 and 13 is not allowable under Article 123(2) EPC.

2.5 It seems therefore that for the above mentioned reasons claim 1 does not meet the requirements of Article 123(2) EPC".

1.2 As far as it concerns the Board's finding in point 2.1 of the above mentioned communication that due to the introduction of the term "multi-function power saw" into claim 1 said claim does not meet the requirements of Article 123(2) EPC the appellant has not presented any counterarguments in writing, nor at the oral proceedings, and the Board, after having reconsidered the case, sees no reason to deviate from this finding.

1.3 Furthermore, the Board sees also no reason to deviate from its finding in point 2.4 of the above mentioned

communication that the introduction of the two working surfaces into claim 1 taken in isolation from the description of said specific embodiments shown in figures 12 and 13 constitutes a non-allowable amendment under Article 123(2) EPC.

According to figures 12 and 13 and the passage from page 7, line 11 to page 8, line 31 of the originally filed description which refers to said figures, when the power saw is used in the first attitude, i.e. as a panel saw, the working surface 54 is a first surface of the sole plate 48 and is positioned at the lowermost part of the body when the body is kept horizontally, see page 8, lines 30, 31. When the power saw is used in the second attitude, i.e. as a jigsaw, the working surface 52 is the second surface of the same sole plate 48, the latter being pivoted around pivot point 50 so that its first surface is now in contact with the outer surface of the body adjacent to the jigsaw blade, the second surface being in contact with the workpiece.

From the above, it is clear that the original application disclosed the second working surface of the body of the saw in a close functional and structural relationship with the first working surface of the body of the saw, and in a particular form of the first and second surface. Other, more generalised forms of these surfaces are not disclosed.

The present wording: "two working surfaces (52, 54), one of which working surfaces (52) is used for resting the power saw on a workpiece when the power saw is held by the user in the second attitude" as claimed now in claim 1 isolates the second working surface from the

above mentioned combination with the first working surface. Moreover, in not further specifying the second working surface it generalises the latter from its specific disclosure in figure 13 and the respective part of the description. For both there is no basis in the application as filed and therefore the amendments made by the applicant do not comply with the requirements of Article 123(2) EPC. The main request is therefore not allowable.

2. *Auxiliary request I: Admittance into the proceedings*

2.1 The objection regarding the "multi function" power saw no longer applies to this request as claim 1 now refers to only a dual mode power saw.

2.2 The feature of claim 1 according to auxiliary request I that "the body of the power saw defines two working surfaces (52, 54), one of which working surfaces (52) is used for resting the power saw on a workpiece when the power saw is held by the user in the second orientation" differs from the corresponding feature of claim 1 according to the main request only in that the expression "second attitude" has been replaced by the expression "second orientation".

This amendment was made by the appellant because it was of the opinion that the term "orientation" was more adequate than the term "attitude" used in claim 1 according to the main request.

In the Board's view said amendment does not change the subject-matter of this feature, and as a result does not overcome the objections under Article 123(2) EPC

raised against the otherwise corresponding feature of claim 1 according to the main request, see point 1.3 above.

Accordingly, claim 1 of auxiliary request I is not clearly allowable.

2.3 The criteria applied by the Boards of Appeal for admitting amendments to claims filed at a late stage in the appeal procedure, in particular during oral proceedings are the following (see T 1126/97, not published in the OJ EPO, point 3.1.2 of the reasons):

(a) there should be some justification for the late filing;

(b) the subject-matter of the new claims should not diverge considerably from the claims already filed, in particular they should not contain subject-matter which has not previously been claimed;

(c) the new claims should be clearly allowable in the sense that they do not introduce new objections under the EPC and overcome all outstanding objections.

The appellant gave no justification for the late filing of its auxiliary request I. The Board, however, had set the ultimate date for filing submissions at one month before the oral proceedings, indicating that the admittance of facts and evidence was still subject to the discretion of the Board under Article 114(2) EPC and Articles 12 and 13 RPBA. In any case, at the oral proceedings the Board did not add to any of the objections raised in the Board's communication annexed

to the summons to oral proceedings, thus did not create a new situation for the appellant warranting such a late filing.

Since apart from condition (a) also condition (c) is not fulfilled, see point 2.2 above, the Board, in the exercise of this discretion, does not admit auxiliary request I.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders