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**Datasheet for the decision
of 30 November 2010**

Case Number: T 0350/09 - 3.2.08

Application Number: 02001242.3

Publication Number: 1203892

IPC: F16C 29/06

Language of the proceedings: EN

Title of invention:

Rolling guide apparatus

Patentee:

THK CO. LTD.

Opponent:

Schaeffler Technologies GmbH & Co. KG

Headword:

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Relevant legal provisions:

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Relevant legal provisions (EPC 1973):

EPC Art. 100(c)

Keyword:

"Divisional application - Extension beyond the content of the
earlier application (no, after amendment)"

"Remittal"

Decisions cited:

-

Catchword:

-

Case Number: T 0350/09 - 3.2.08

DECISION
of the Technical Board of Appeal 3.2.08
of 30 November 2010

Appellant: THK CO. LTD.
(Patent Proprietor) 11-6, Nishi Gotanda 3-chome
Shinagawa-ku
Tokyo 141 (JP)

Representative: Klunker . Schmitt-Nilson . Hirsch
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Respondent: Schaeffler Technologies GmbH & Co. KG
(Opponent) Industriestraße 1-3
D-91074 Herzogenaurach (DE)

Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 3 December 2008
revoking European patent No. 1203892 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: M. Alvazzi Delfrate
U. Tronser

Summary of Facts and Submissions

I. European patent No. 1 203 892, granted on a divisional application from earlier application No. 95 918 760.0 (the parent application) was opposed on the grounds according to Articles 100(a) and 100(c) EPC 1973.

II. By its decision posted on 3 December 2008 the opposition division revoked the patent on the ground that its subject-matter extended beyond the content of the parent application as filed.

III. The appellant (patent proprietor) filed an appeal against this decision on 2 February 2009, paying the appeal fee on the same day. The statement setting out the grounds of appeal was filed on 1 April 2009.

IV. Oral proceedings before the board of appeal were held on 30 November 2010.

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims filed as auxiliary request II (now main request) during the oral proceedings.

V. The respondent requested that the appeal be dismissed. It also requested that the opponent status be transferred to Schaeffler Technologies GmbH & Co. KG.

VI. Claim 1 reads as follows:

"A rolling guide apparatus in which a movable block (2) is supported to be movable along a guide rail through a number of rolling members (3), a circulation [sic]

passage for guiding circulation of the rolling members is formed to the movable block and in the guide rail (4), said rolling member circulation passage being composed of a loaded rolling member rolling passage (8) in a loaded area between loaded rolling member rolling grooves (8a, 8b) formed to opposing surfaces of the movable block (2) and the guide rail (4) and a non-loaded return passage in the movable block for returning the rolling members in the loaded area from one end of the loaded rolling member rolling passage (10) to another one end thereof, wherein said number of rolling members are supported by a number of rolling member retainer holes (50a) formed to a retainer formed of a flexible belt-shaped member characterized in that said endless retainer (50) is supported by a retainer support member (55 - 58) disposed linearly along the loaded rolling member rolling groove, e.g. ball rolling groove, of the movable block, said retainer support member (55-58) being integrally molded onto a block body of the movable block."

VII. The appellant's arguments in support of its request may be summarised as follows:

Present claim 1 was essentially based on the embodiment of Figures 7 and 8 of the parent application as originally filed, which disclosed a rolling guide apparatus comprising a belt-shaped retainer. Although the apparatus shown in these figures employed balls as rolling members, the parent application disclosed also the use of rolling members in general, of which balls were merely examples. Hence, it disclosed that generic rolling members could be used instead of the balls. Moreover, since all the preferred embodiments disclosed

in the parent application used balls as rolling members, it was clear that this possibility applied to all the embodiments, including the one shown in Figures 7 and 8. Therefore, the subject-matter of claim 1, which related to a rolling guide apparatus comprising a belt-shaped retainer and generic rolling members, was disclosed in the parent application as filed.

VIII. The respondent's arguments may be summarised as follows:

The parent application as originally filed disclosed in the embodiment of Figures 7 and 8 a belt-shaped retainer for rolling members in the form of balls. Hence, it could not be a basis for present claim 1, which was directed to an apparatus wherein generic rolling members were used in combination with a belt-shaped retainer.

Nor it was apparent from the parent application that in said embodiment the balls could be replaced by generic rolling members. It was true that the parent application also mentioned generic rolling members. However, when using cylindrical rollers, for example, it was necessary to maintain the orientation of the axis of rotation constant, while this was superfluous in the case of balls. Therefore, the belt-shaped retainer shown in Figures 7 and 8 needed to be modified for the use of rolling members other than balls. Hence, the possibility of using generic rolling members instead of balls, which was disclosed in the introductory portion of the parent application, did not apply to the embodiment of Figures 7 and 8.

Accordingly, the subject-matter of the patent in suit extended beyond the content of the parent application.

Reasons for the Decision

1. The appeal is admissible.
2. Transfer of opponent status.

During the oral proceedings before the board of appeal the respondent submitted document "HRA 2681 Amtsgericht Fürth" showing that "Schaeffler KG" had become "Schaeffler Verwaltung Drei KG" and subsequently "Schaeffler Technologies GmbH &Co KG" (see document "HRA 9349 Amtsgericht Fürth"). In view of these documents it is clear that the opponent status was transferred to the latter company.

3. Claim 1 relates to a rolling guide apparatus comprising a number of rolling members which are supported by a number of rolling member retainer holes formed to an endless retainer.

The parent application as originally filed relates to a rolling guide apparatus, preferred embodiments of which are disclosed in the drawings. In all the preferred embodiments balls are used as rolling members. This is true also for the embodiment shown in Figures 7 and 8, which is the only one comprising a belt-shaped retainer.

Nevertheless, the parent application in its more general disclosure is not limited to balls but foresees

also the possibility of using generic rolling members (see for instance column 3, line 21-46). Therefore, it clearly and unambiguously indicates that the rolling guide apparatus can comprise generic rolling members. Since the parent application does not make any distinction among the different embodiments in respect of the type of rolling member to be used, this possibility clearly applies to all the embodiments, including that of Figures 7 and 8.

The respondent submitted that the possibility of replacing the balls by other rolling members did not apply to the embodiment of Figures 7 and 8, since this required a modification of the belt-shaped retainer to maintain the orientation of the axis of rotation constant. However, this argument is not convincing. The necessity to modify the apparatus to maintain the orientation of said axis constant when using for example cylindrical rolling members exists for all the rolling guide apparatuses disclosed in the parent application. Hence there is no reason to assume that the parent application disclosed the possibility of using other rolling members instead of balls only with respect to the embodiments according to Figures 1 to 6 and 9 and not to the one shown in Figures 7 and 8.

Therefore, the subject-matter of the patent in suit does not extend beyond the content of the parent application as originally filed.

4. Since the patent as amended according to the present main request succeeds in removing the ground underlying the appealed decision, and since no decision was taken by the opposition division on the issues of novelty and

inventive step, the board finds it appropriate to remit the case to the department of first instance for further prosecution on the basis of this request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of the first instance for further prosecution on the basis of the auxiliary request II (now main request).

The Registrar:

The Chairman:

V. Commare

T. Kriner