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**Datasheet for the decision  
of 26 July 2011**

**Case Number:** T 0557/09 - 3.2.06

**Application Number:** 97941341.6

**Publication Number:** 0932466

**IPC:** B23B 31/12

**Language of the proceedings:** EN

**Title of invention:**  
Chuck

**Patentee:**  
POWER TOOLS HOLDERS, Inc.

**Opponent:**  
Röhms GmbH

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 123(2), 111(1)

**Relevant legal provisions (EPC 1973):**  
EPC Art. 56, 84

**Keyword:**  
"Main request - remittal to opposition division for further prosecution"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 0557/09 - 3.2.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.06  
of 26 July 2011

**Appellant:** POWER TOOL HOLDERS, Inc.  
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**Representative:** -

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 8 January 2009  
revoking European patent No. 0932466 pursuant  
to Article 101(2) EPC.

**Composition of the Board:**

**Chairman:** W. Sekretaruk  
**Members:** M. Harrison  
G. de Crignis

## Summary of Facts and Submissions

I. The appellant (patent proprietor) filed an appeal against the opposition division's decision dated 8 January 2009 revoking European patent No. 0 932 466.

In its decision, the opposition division found *inter alia* that claim 1 of the proprietor's sole request complied with Article 123(2) EPC in regard to the single amendment involving replacement of the terminology "configured and disposed" (in the granted claim - see feature "(f)" of claim 1 *infra*) by the term "attached", but that its subject-matter did not involve an inventive step when considering

D1: EP-A2-0 710 520

as the closest prior art and combining this with the teaching of

D5: US-A-5 501 473.

II. Apart from maintaining its sole request before the opposition division as its main request, the appellant filed amended versions of claim 1 in the form of three auxiliary requests.

III. With its letter received at the European Patent Office on 30 September 2009, the opponent withdrew its opposition.

IV. When issuing a summons to oral proceedings, the Board indicated in its annexed communication *inter alia* that

the requirement of Article 123(2) EPC did not appear to be fulfilled by claim 1 of any of the requests.

- V. During an exchange of submissions by the appellant and communications from the Board, the appellant (with its first faxed letter of 12 July 2011) filed a new claim 1 of its main request, and withdrew all previous requests including its request for oral proceedings. This was followed by a second faxed letter of 12 July 2011 from the appellant, including a set of claims 1 to 9 forming the complete set of claims of its main request. In the appellant's final submission dated 18 July 2011, the appellant then submitted a replacement claim 1 of its main request, together with individual pages of an amended description.

The appellant's sole request for setting aside the decision under appeal and maintaining the patent in an amended form is thus based on a set of claims consisting of claim 1 as filed on 18 July 2011 together with claims 2 to 9 as filed in the second faxed letter of 12 July 2011.

- VI. Claim 1 of the appellant's sole request reads as follows, whereby underlined portions indicate additions to claim 1 as granted, and struck-out portions indicate deletions therefrom:

"A chuck (20) for holding the shank of a tool to be used with a manual or powered driver having a rotatable drive shaft, said chuck comprising:

a) a generally cylindrical body member (26) having a nose section (23) and a tail section, said tail section having an axial bore formed therein to mate with the

drive shaft of the driver, said nose section having an axial bore formed therein, ~~and~~ a plurality of angularly disposed passageways (30) formed therethrough and intersecting said axial bore of said nose section, and a front cylindrical portion (53);

b) a plurality of jaws (28), a separate one of said jaws being slidably positioned in one of each of said angularly disposed passageways (30), each of said jaws having a jaw face formed on one side thereof and threads (62) formed on the opposite side thereof;

c) a nut (60) rotatably mounted relative to said body member and in engagement with said threads on said jaws (28);

d) a generally cylindrical sleeve member (22) configured and disposed in driving engagement with said nut (60) and overlying said nose section (23) of said body member whereby rotation of said sleeve member (22) with respect to said body member (26) effects movement of said jaws (28); and

e) a pawl member (80) configured and disposed such that when said jaws (28) are desirably gripping a shank of the tool, said pawl member (80) can be disposed to become constrained against rotation with respect to said nut (60) and said body member (26) so that a predetermined releasing torque must be applied before said nut (60) can rotate with respect to said body member (26); characterised in that said chuck further comprises:

f) a nut retainer (64) configured and disposed with respect to said body member (26) to limit travel of said nut (60) in the axial direction relative to said body member, said nut retainer (64) ~~defining an engagement portion (63)~~ having a front section (65) that has a cylindrically shaped interior surface

attached to said front cylindrical portion (53), and a cylindrically shaped exterior surface that is concentric therewith; said nut retainer defining an engagement portion (63) comprising a cylindrically shaped exterior surface; and said nut retainer including disposed intermediate said engagement portion and said front section a second interior surface shaped in truncated conical form and an exterior truncated conical surface; and

g) wherein said pawl member (80) is configured to engage said engagement portion (63) when said jaws are desirably gripping the shank of a tool and said pawl member (80) becomes thereby constrained against rotation with respect to said body member (26) until a predetermined releasing torque is applied to permit said nut (60) to rotate with respect to said body member (26)."

VII. Oral proceedings were held on 26 July 2011 in the absence of the appellant.

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

The requirement of Article 123(2) EPC was met, since the terminology introduced into the claim was disclosed in the description from page 10, line 21 to page 11, line 11, whereby the expression "lower section 65" as used in the description was however replaced by the terminology "front section (65)" so as to be consistent with the description of the front cylindrical portion (53) to which it was attached.

## Reasons for the Decision

### 1. *Article 123(2) EPC / Article 84 EPC 1973*

1.1 Although the opposition division concluded that replacement of the terminology "configured and disposed" by the term "attached" in relation to feature (f) of claim 1 met the requirement of Article 123(2) EPC, the application as filed only provides a clear and unambiguous disclosure (see page 3, lines 14 to 26 and page 10, line 21 to page 11, line 15) of an attachment of the interior surface of the lower section 65 of the nut retainer member to the front cylindrical portion 53 of the body member 26. Further, this disclosure of the attachment using the interior surface of the lower section is a functionally integral part of a nut retainer which has "three distinctly shaped exterior surfaces and two distinctly shaped interior surfaces", the specific shapes of which are also described.

1.2 Further, the terminology in feature (f) "configured and disposed" has however been retained since this relates to the functional definition of the nut retainer with respect to the body member, whereby however the distinct shaped surfaces of the nut retainer including a definition of the particular surfaces which are attached have now been inserted, as disclosed on pages 10 and 11 (i.e. as mentioned in item 1.1 above). Further features described in connection with that disclosure are either found not to be inextricably functionally or structurally related to the introduced features, or are disclosed as being preferable and thus their inclusion is not necessary.

The inclusion of this combination of features in claim 1 thus defines the attachment of the nut retainer to the body member in accordance with the disclosure in the application as filed.

- 1.3 In respect of feature (a) of the claim, the amendment made by introducing the terminology "and a front cylindrical portion (53)" merely provides an antecedent basis for this part of the body member whereby at the same time it is defined clearly as being located in the nose section. The cylindrical portion 53 is disclosed e.g. on page 10. In regard to the amendment from "lower section" as used in the application as filed, to "front section" as used in the introduced terminology, this is merely an adaptation to define a consistent frame of reference in the claim since in the claim this relates to an axial horizontal direction, and in the description of Figures 1 and 2 to a vertical direction due to the vertical orientation of the elements.

The appellant also provided description pages indicating that this terminology would be amended for consistency with the language used in the claims, which changes *per se* would indeed appear appropriate when amending the description to match any final form of claim (see item 3 below).

- 1.4 No subject matter is therefore added by these limiting amendments in claim 1 compared to the content of the application as filed (Article 123(2) EPC) and the added terminology is also found to be clear in the context of the claim (Article 84 EPC 1973).



2. *Novelty and Inventive step*

2.1 As regards novelty of the subject matter of claim 1, the opposition division found that the most relevant state of the art for assessment of novelty was D1, with respect to which features (f) and (g) were found to be novel (whereby feature (f) was, in the claim under consideration, feature (f) of granted claim 1 amended only by the replacement of "configured and disposed" by "attached"). This assessment was not challenged by the appellant in its grounds of appeal, nor does the Board find any reason to differ from the opposition division's finding, whereby it should be noted - as was also noted in the decision under appeal - that the general configuration of the pawl member as in feature (g) is known *per se* from D1, but the "engagement portion" of feature (g) refers to the engagement portion of the nut retainer in feature (f), whereas in D1 the engagement surface for the pawl member is not on a nut retainer, but on a bearing ring (21) or a body ring (46) in the embodiments of D1 shown in Figures 1 and 4 respectively.

Further, since feature (f) has been additionally amended compared to the claim considered by the opposition division and to claim 1 as granted, by defining the specific shape of the nut retainer together with a definition of the surfaces forming the attachment of nut retainer and body member, these additional features are also found to be novel with respect to D1.

2.2 As regards inventive step, the subject matter of claim 1 is found to involve an inventive step when

starting from D1 as the closest prior art and considering the teaching of D5.

- 2.2.1 Starting from D1, the problem to be solved may be regarded as being the provision of a compact chuck design with reduced complexity.
- 2.2.2 In this regard, D1 (see Figure 4) discloses a pawl device engaging with a body ring 46 ("Körperring" - in D1 being a ring fixedly positioned on the body member 1 against a shoulder thereof, which shoulder also acts as the nut retaining surface against forward axial travel of same).
- 2.2.3 In attempting to reduce complexity and providing a one-piece nut in D1 (see e.g. D1, column 9, lines 36 - 38), although the opposition division concluded that simple removal of this shoulder portion would allow the body ring to be extended rearwardly and thus act as a nut retainer, it should first be observed that even a teaching regarding use of a pawl engagement surface (for engagement by a pawl member) in combination with a forward nut retainer is not part of the prior art in D1 or D5, nor does this appear to be suggested thereby. D5 suggests merely that a nut retainer 143 (see e.g. Fig. 3 and column 6, lines 45 to 61) with its interior front cylindrical portion can be attached to the nose portion 116 of the body member, and that this has attached thereto a truncated conical portion, which has no other function than retaining the nut.
- 2.2.4 Also, in D1, in order to extend the body ring 46 rearwardly to the nut, the level of the surface of the body member 1 on which the press-fitted body ring 46 is

positioned would need to be radially reduced right down to the level of the innermost thread of the nut in case of a single piece nut, because the single piece nut (which would correspond to nut 8' in D1 made in a single piece) would need to be slid over the front of the body member 1 in order to arrive at its position as shown in Fig. 4, since the innermost thread of nut 8' must of course pass over the body 1 to arrive at its final position. Thus, not only does D1 simply state that a single piece nut can be used (i.e. without further explanation of how this might be arranged), but it is evident that the surface of the body member, on which body ring 46 is fitted in Fig. 4, would also have to be removed to a far lower level. How the skilled person would proceed from that point is then not explained.

2.2.5 The Board thus finds that not only is there no teaching to provide a combination of a nut retainer in combination with a pawl engagement surface, in D1 or D5, but also that in D1 a simple extension rearwards of ring 46 after removal of the body member shoulder is not sufficient to arrive at the invention, since it must also be altered (while acting as a nut retainer) with a smaller radius internal surface. Although all these modifications can be simply done when the invention is known, there does not appear to be any teaching for the skilled person towards such a solution when considering D1 and D5.

2.2.6 Further, due to the limitation of feature (f) by the introduction of further features from pages 10 and 11 of the description, compared to claim 1 as considered by the opposition division, a specific form of nut

retainer is now defined including a cylindrical, truncated conical and further cylindrical portion acting as the pawl engagement surface. Such a configuration, in the context of the drill chuck defined in claim 1 is also not disclosed in, or taught by either D1 or D5, nor by a combination of these specific documents.

2.2.7 Consequently, the subject matter of claim 1 is found to involve an inventive step when considering the prior art disclosed in D1 and D5 and the problem to be solved.

3. *Remittal of the case to the opposition division*

3.1 The decision under appeal only provided reasons concerning inventive step with respect to documents D1 and D5 in combination, whereas the minutes of oral proceedings indicate that further attacks against inventive step were made. Additionally, further amendments have been made in claim 1 which have necessarily resulted in subject-matter being taken from the description.

Under these circumstances the Board finds it appropriate to exercise its discretion and to remit the case for further prosecution to the opposition division in accordance with Article 111(1) EPC.

3.2 In this regard it may be added that, whilst the Board has decided on clarity of claim 1, novelty of claim 1 with regard to D1 and inventive step with regard to D1 and D5 in combination, other matters such as for example the correctness of the two-part form of claim 1 of the main request have not been considered by the

Board, nor has any consideration been given to any amendments that might be required in the dependent claims or the description, apart from that mentioned at the end of item 1.3 above.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:

M. Patin

W. Sekretaruk