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Datasheet for the decision of 31 January 2012

Case Number: T 1421/09 - 3.2.06

Application Number: 02789406.2

Publication Number: 1463605

IPC: B23Q9/00

Language of the proceedings: EN

Title of invention:
FLEXIBLE TRACK POSITIONING MACHINE

Applicant:
The Boeing Company

Opponent:
AIRBUS SAS/AIRBUS OPERATIONS/AIRBUS OPERATIONS Ltd
AIRBUS OPERATIONS GmbH/AIRBUS OPERATIONS S.L.

Relevant legal provisions:
EPC 1973 Art. 84
EPC Art. 111(1), 123

Keyword:
Admittance into the proceedings (new main request) - yes
Remittal to the opposition division - yes

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T1421/09 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 31 January 2012

Appellant: (Patent Proprietor)	The Boeing Company 100 North Riverside Plaza Chicago, IL 60606-1596 (US)
Representative:	McLeish, Nicholas Alistair Maxwell Boult Wade Tennant Verulam Gardens 70 Gray's Inn Road London WC1X 8BT (GB)
Appellant: (Patent Proprietor)	AIRBUS SAS/AIRBUS OPERATIONS/AIRBUS OPERATIONS Ltd AIRBUS OPERATIONS GmbH/AIRBUS OPERATIONS S.L. 1 Rond-Point Maurice Bellonte 316 route de Bayonne/New Filton House Filton/Kreetslag 10/Avenida de John Lennon S/N F-31700 Blagnac/F-31060 Toulouse GB-Bristol BS99 7AR/D-21129 Hamburg Madrid, ES (FR)
Representative:	Moutard, Pascal Jean Brevalex 22, Avenue du Doyen Louis Weil 38024 Grenoble Cedex 1 (FR)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted 7 May 2009 concerning maintenance of the European Patent No. 1463605 in amended form.**

Composition of the Board:

Chairman: M. Harrison
Members: G. Kadner
W. Sekretaruk

Summary of Facts and Submissions

I. The mention of grant of European patent No. 1 463 605, with 24 claims, on the basis of European patent application No. 02789406.2 filed on 4 November 2002, and claiming a US priority of 10 December 2001, was published on 1 February 2006.

Claim 1 of the patent as granted reads as follows:

"Apparatus for guiding and positioning a machine component relative to a compound-contoured surface of a workpiece, the apparatus comprising:
first and second elongate flexible rails (22, 24), the rails (22, 24) being spaced apart and approximately parallel to each other;
a plurality of vacuum attachment devices (26) connected to each rail (22, 24) and spaced at intervals therealong for releasably attaching each rail (22, 24) to the surface of the workpiece by vacuum, with the widths of the rails (22, 24) extending substantially parallel to the surface of the workpiece, the rails bending and twisting as needed to substantially follow the surface of the workpiece; and
an X-axis carriage (30) structured and arranged to support the machine component, the X-axis carriage slidably engaging the rails (22, 24) and being traversable along the rails (22, 24) so as to position the machine component relative to the workpiece."

II. Notice of opposition, in which revocation of the patent on the grounds of Article 100(a), 100(b) and 100(c) EPC 1973 was requested, was filed against the granted patent by five joint opponents.

With its interlocutory decision posted on 5 May 2009, the opposition division found that the European patent in an amended form according to the fourth auxiliary request met the requirements of the EPC. The opposition division held that the requirements of Article 123(2) and 123(3) EPC were met as well as those of Articles 83 and 84 EPC. Novelty was not contested, and the subject-matter of claim 1 and the method according to independent claim 10 involved an inventive step.

III. Notice of appeal was filed against this decision by both appellant I (patentee) and appellant II (joint opponents) on 7 July 2009, and the appeal fee was paid on the same day. The grounds of appeal were filed on 7 September 2009 by appellant I and on 14 September by appellant II. On 26 January 2010 appellant I filed its reply to the appeal of appellant II whereas no reply by appellant II to the appeal of appellant I was filed.

IV. In a communication accompanying the summons to oral proceedings, the Board expressed its preliminary view that there was doubt as to whether the amendments made in all requests met the requirement of Article 123(2) EPC.

V. With letter dated 29 December 2011 the appellant replaced all previous requests by a new main request and three auxiliary requests.

VI. Oral proceedings were held on 31 January 2012, during which appellant I replaced all previous requests by a single new request.

Claim 1 of the new request includes the wording of claim 1 as granted, to which the following features

taken from granted claims 2, 4, 5, 6, 7, 8, 20, 21 and 9 (in that order) have been appended:

"... wherein each rail (22, 24) is relatively stiff in bending about a first bending axis and relatively flexible in bending about a second axis orthogonal to the first bending axis, and each rail (22, 24) is mounted on the workpiece such that the first bending axis is substantially normal to the workpiece surface and the second bending axis is substantially parallel to the workpiece surface;
the attachment devices comprise vacuum cups (26);
the X-axis carriage (30) is connected to the rails (22, 24) by flexible mounts;
the flexible mounts comprise plate-shaped springs (34, 36);
further comprising an X-axis drive device for driving the X-axis carriage (3) along the rails (22, 24), the X-axis drive device being mounted on one of the plate-shaped springs (34, 36);
the X-axis drive device includes a drive member that engages a cooperating member on one of the rails (22, 24);
further comprising a drive motor (40) mounted on one of the supports and in driving connection with a drive element that engages a cooperative driven element extending along one of the rails (22, 24); and
the drive element is a rotary gear element and the driven element is a linear gear element, the supports being resilient and supporting pairs of spaced rollers that receive each of the rails (22, 24) therebetween, the rotary gear element being arranged such that a rotational axis thereof is coplanar with rotational axes of one of the pairs of rollers mounted on the support that supports the drive motor (40);

the drive member extends through an aperture (46) in the plate-shaped spring."

Appellant I requested that the decision under appeal be set aside and that the European patent be maintained on the basis of the main request, dated 31 January 2012.

Appellant II requested that the decision under appeal be set aside and that the European patent No. 1 463 605 be revoked.

VII. The arguments of appellant I can be summarized as follows:

Following the opposition division's interlocutory decision, the first time that doubt as to the admissibility of the amendments made to the claims filed during opposition proceedings was raised, was apparent from the communication issued by the Board together with the summons to oral proceedings. Appellant II had not responded to Appellant's I appeal at all, so that the patentee had no reason or opportunity to file amended requests earlier than after the receipt of the summons. Therefore, the requests filed on 29 December 2011 should not be regarded as late-filed. Furthermore, if those filed requests did not entirely remove the deficiencies of the former, filing of a new request should then be allowed. In accordance with the Case Law of the Boards of Appeal and in view of the procedural deficiency caused by the opponents' lack of a response to the proprietor's appeal grounds and requests filed therewith, the late-filed request should be allowed because this was the last chance of the patentee to save its patent yet the first time that it was able to address all the issues mentioned by the Board and by the opponents.

VIII. Appellant II argued that the requests filed on 29 December 2011 and also the auxiliary request newly filed during the oral proceedings (and later withdrawn) did not meet the requirements of the Convention, in particular not those of Articles 84 and 123(2) EPC. Therefore they should not be admitted into the proceedings. The new single main request based on only granted claims and which was submitted during the oral proceedings was late-filed and should not be admitted. Arguments and objections against the requests filed by the patentee with its appeal grounds were implicit from the opponents' own grounds of appeal. Since the sole request included new subject-matter which had not been the subject of proceedings, and appellant II (opponents) did not have sufficient time to deal with this, it should not be admitted into proceedings.

Reasons for the Decision

1. The appeals are admissible.

2. *Amendments to appellant I's (patent proprietor's) case (Article 13(1) RPBA)*

2.1 Admittance into the proceedings

According to Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA) any amendment to a party's case after it has filed its grounds of appeal may be admitted and considered at the Board's discretion. The discretion has to be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

Although the new request was filed during the oral proceedings before the Board, i.e. at a very late stage, it takes account of the deficiencies raised for the first time by the Board in its communication accompanying the summons to the oral proceedings and those discussed during the oral proceedings, together with new objections of appellant II raised during the oral proceedings in this respect. Since appellant I could only react to appellant's II objections in the oral proceedings, a request which *prima facie* remedies the deficiencies and does not give rise to further objections, in the present case particularly any objections with respect to Articles 84 and 123 EPC which had existed in previous requests, although late-filed, may be admitted into the proceedings.

Although appellant II argued that its objections to the claims of all the requests filed with appellant I's grounds of appeal were implicit from its own grounds of appeal made in respect solely of the fourth auxiliary request (i.e. the request found allowable by the opposition division), the Board found appellant II's argument in this respect unconvincing as an implicit basis for its various objections under e.g. Article 123(2) EPC could not be found. Moreover, it is stated in Article 12(2) RPBA (when referring to the grounds of appeal and any reply thereto as mentioned in Article 12(1)(a) and (b) RPBA)) that "…the reply shall contain a party's complete case … and should specify expressly all the facts, arguments and evidence relied on". Any such specifically expressed arguments were simply absent, due to the entire lack of any reply to appellant I's appeal.

2.2 The amendments

Claim 1 of the new request is a combination of the features of granted claim 1 together with dependent claims 2, 4, 5, 6, 7, 8, 20, 21 and 9 as granted. All method claims were deleted. Based purely on the parties' submissions concerning admittance of the new main request into proceedings, the Board was not presented with any compelling reason *prima facie* as to why the requirement of Article 123(2) EPC or Article 84 EPC 1973 would not be fulfilled when considering those submissions alone.

Nonconformity with Article 84 EPC 1973 is not a ground for opposition (Article 100 EPC 1973), and since the Board does not see a lack of clarity which would have been generated by the new combination of granted claims, the request *prima facie* meets the requirement of Article 84 EPC 1973.

As regards Article 123(2) EPC, it was noted that claim 1 was formulated on the basis only of granted apparatus claims and that the features of all the granted dependent claims are reflected in the terminology used in the originally filed dependent claims. Additionally, since claim 1 was restricted by further features to which the opposition division had not previously raised any objection, the requirement of Article 123(2) EPC was *prima facie* not in doubt.

2.3 Remittal to the opposition division

Following the examination as to the allowability of the appeal, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible

for the decision appealed or remit the case to that department for further prosecution (Article 111(1) EPC). To allow both parties a fair opportunity to develop any potential arguments and counter arguments, also in respect of Article 84 EPC 1973 and Article 123 EPC, remittal to the department of first instance is appropriate in the present circumstances. Also, neither party objected to the remittal of the case.

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 continuation of the opposition proceedings.

The Registrar: The Chairman:

M. Patin M. Harrison

Decision electronically authenticated