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**Datasheet for the decision
of 23 June 2010**

Case Number: T 2389/09 - 3.2.06

Application Number: 06250541.7

Publication Number: 1688214

IPC: B23Q 11/00

Language of the proceedings: EN

Title of invention:

Dust and debris extraction apparatus for power tool

Patentee:

Power Box AG

Opponent:

Black & Decker Inc.

Headword:

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Relevant legal provisions:

EPC Art. 123(2)

RPBA Art. 13(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Requests not admitted into proceedings"

Decisions cited:

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Catchword:

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Case Number: T 2389/09 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 23 June 2010

Appellant: Power Box AG
(Patent Proprietor) Poststrasse 6
CH-6301 Zug (CH)

Representative: Wood, Graham
Bailey Walsh & Co
5 York Place
Leeds LS1 2SD (GB)

Respondent: Black & Decker Inc.
(Opponent) 1207 Drummond Plaza
Newark DE 19711 (US)

Representative: Bell, Ian Stephen
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 16 October 2009
revoking European patent No. 1688214 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: M. Harrison
W. Sekretaruk

Summary of Facts and Submissions

- I. The appellant (patent proprietor) filed an appeal against the opposition division's decision revoking European patent number 1 688 214.
- II. Together with its grounds of appeal, the appellant filed a replacement set of claims and requested that the patent be maintained in an amended form.
- III. The respondent (opponent) requested dismissal of the appeal.
- IV. With its summons to oral proceedings, the Board issued a communication in which it was stated *inter alia* that the requirements of Article 123(2) EPC and Article 84 EPC 1973 did not appear to be met by the amended claims.
- V. In its submission dated 20 May 2010, the appellant filed a replacement main request and a first auxiliary request, mentioning that the amended claims might allow the oral proceedings to be avoided.
- VI. With its communication of 28 May 2010, the Board informed the parties that the oral proceedings would be held as planned and that at least certain further matters under Article 84 EPC 1973 and Article 123(2) EPC arising out of the newly filed claims appeared to be relevant for discussion. Reference was also made to Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA) concerning the question of admittance of new requests into proceedings.

VII. With its submission of 7 June 2010, the appellant filed a main request and an auxiliary request replacing the previous requests.

VIII. In its submission of 18 June 2010, the appellant informed the Board that it would not attend the oral proceedings.

IX. During the oral proceedings of 23 June 2010 held before the Board, the respondent confirmed its request for dismissal of the appeal.

Since the appellant was not present (as announced), its requests remained as filed, i.e. setting aside the decision under appeal and maintenance of the patent in an amended form based on the main or auxiliary request as filed with its submission of 7 June 2010.

X. Claim 1 of the main request reads as follows:

"1. A router power tool, said power tool including a base (12) to be located at or adjacent a work piece on which an operation is to be performed by the power tool, and dust extraction apparatus including a passage (30) mounted on the power tool, said passage (30) includes a passage portion (36) and, whilst the passage is mounted to the power tool, the passage portion can be selectively moved between an in-use position at which an end of the passage is located adjacent the base, and a storage position in which the said end of the passage portion is in a position spaced from the base, characterized in that said base is provided with a port or aperture through which dust and debris passes from the workpiece operation to be guided through the

passage, and when the passage portion (36) is in the storage position a further dust extraction passage (32) can be connected to the said aperture or port (21)."

XI. Claim 1 of the auxiliary request is the same as claim 1 of the main request, with the exception that the characterizing portion of the claim has been amended as follows:

"characterized in that said base is provided with a port or aperture through which dust and debris passes from the workpiece operation to be guided through the passage, and when the passage portion (36) is in the storage position most of the passage portion is housed within the passage and a further dust extraction passage (32) can be connected to the said aperture or port (21)."

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

The amendments in the main and auxiliary requests do not contravene Article 123(2) EPC or Article 84 EPC 1973. As regards the main request, further minor amendments were introduced in light of the Board's communication of 28 May 2010. Support for the amendments regarding the location of the further dust extraction passage was to be found in paragraph [0029] in light of paragraph [0010]. Support for the amendments made in the auxiliary request could be found in paragraph [0028] and the Figures.

XIII. The arguments of the respondent may be summarised as follows:

The newly filed claim 1 of both requests included the terminology "a port or aperture through which dust and debris passes from the workpiece operation to be guided through the passage". The only apparent basis for this amendment was claim 2 as filed, which however additionally required that the dust or debris passed through the passage "when connected thereto", which feature was however not defined in claim 1. The requirements of Article 123(2) EPC were not fulfilled at least for this reason.

Reasons for the Decision

1. *Admittance of requests into proceedings - Article 13(1) RPBA*

1.1 The requests of the appellant were filed with the letter of 7 June 2010. These requests are thus an amendment of the appellant's case and thus may be admitted and considered at the discretion of the Board (Article 12(2) and (4) and Article 13(1) RPBA). In accordance with Article 13(1) RPBA, "the discretion shall 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."

- 1.2 In exercising its discretion, the Board decided not to admit either the main or the first auxiliary request into proceedings, since these requests appear *prima facie* not to be allowable for the reasons given below.
- 1.2.1 Whilst the appellant had provided main and auxiliary requests with its letter of 7 June 2010 which were an attempt to overcome specific objections raised by the Board, claim 1 of each of these requests contained the wording "a port or aperture through which dust and debris passes from the workpiece operation to be guided through the passage", without however specifying that this is the situation when the passage is "connected" to the aperture or port.
- 1.2.2 No basis can however be found in the originally filed application which discloses an arrangement whereby "dust or debris passes" from the workpiece operation to be guided through the passage unless the passage is indeed "connected" to the port or aperture. Claim 2 as filed indeed defines this connection, as does paragraph [0009].
- 1.2.3 Nor can claim 1 be interpreted unambiguously such that, in the in-use position (i.e. during a workpiece operation), the end of the passage portion is necessarily connected to the aperture. Whilst claim 1 defines that the end of the passage portion moves between an in-use location "adjacent the base" to a storage position "spaced from the base", this does not unambiguously require that the passage portion when "adjacent the base" is also "connected" to the port or aperture.

1.2.4 No further relevant disclosure in this regard can be found in the filed application, nor was any mentioned by the appellant in its written submissions. Whilst reference was made by the appellant to paragraphs [0010], [0029], these concern the feature of the connection of a further dust extraction passage to the aperture or port.

The appellant's further reference to paragraph [0028] makes no reference to dust and debris passing from the aperture through the passage, but merely to an extended position and a storage position. The Figures, referred to broadly as relevant disclosure by the appellant, provide only very schematic information and only in a specific embodiment, none of which provides a disclosure from which it could be inferred unambiguously that a connection might not be required when dust or debris is to pass through the passage from the aperture or port.

1.2.5 The requirements of Article 123(2) EPC are thus *prima facie* not fulfilled by claim 1 of either request.

1.3 *Absence of the appellant at the oral proceedings*

1.3.1 According to Article 15(3) RPBA the Board is not obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned. Under these circumstances the party not present at the oral proceedings is treated as relying only on its written case. Consequently a party has to take care that its written submissions deal with the issues that can reasonably be expected to be of relevance. When filing

new requests with amended claims just over two weeks in advance of the oral proceedings, a proprietor can expect that objections under Article 123(2) EPC and Article 84 EPC 1973 may indeed arise (even for the first time, as in this case) during the oral proceedings and should consider providing arguments at least on both of these matters, in particular when claims are filed which are not a pure combination of granted claims and when non-attendance at oral proceedings is envisaged.

1.3.2 This is also in line with the established case law of the Boards of Appeal (see e.g. Case Law of the Boards of Appeal of the European Patent Office, 5th Edition, VI.B.4.3.2, from which it is clear that a party by its non-attendance has waived the opportunity of discussing late-filed requests and, if necessary the filing of further amendments to overcome any objections arising during the oral proceedings).

2. *No requests in the proceedings*

Since none of the requests on which the appellant wishes to have the patent maintained are admitted into proceedings, there is no text in the proceedings on which the EPO can take a decision regarding maintenance of the patent.

The appeal must therefore be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau