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Datasheet for the decision of 11 February 2014

Case Number: T 1097/10 - 3.2.07

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Title of invention:
A FITTING FOR THE USE AS A MEANS FOR THE GRIPPING OF ONE OR MORE OBJECTS

Patent Proprietor:
Shore, Jeffrey Pascal

Opponent:
H. Hiendl GmbH & Co. KG

Headword:

Relevant legal provisions:
EPC Art. 56
RPBA Art. 12(2), 13(1), 13(3)

Keyword:
Inventive step - obvious modification
(main, first and second auxiliary requests)
Late-filed third auxiliary request - submitted during oral proceedings - justification for late filing (no)

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Catchword:

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Case Number: T 1097/10 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 11 February 2014

Appellant: (Patent Proprietor)	Shore, Jeffrey Pascal Vestergade 18h 1456 Copenhagen K (DK)
Respondent: (Opponent)	H. Hiendl GmbH & Co. KG Industriestrasse 5+6 94327 Bogen-Furth (DE)
Representative:	Graf Glück Kritzenberger Hermann-Köhl-Strasse 2a 93049 Regensburg (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 16 March 2010 revoking European patent No. 1360121 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: H. Meinders
Members: H. Hahn
I. Beckedorf

Summary of Facts and Submissions

I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division to revoke the European patent 1 360 121.

II. The following documents of the opposition proceedings are relevant for the present decision:

D1 = GB-A-2 297 577
D2 = DK-U-9 400 170
D3 = GB-A-2 309 257
D4 = WO-A-96/00175
D5 = SE-C-221 283

III. An opposition had been filed against the patent in its entirety based on Article 100(a) EPC, for lack of novelty and inventive step, and on Article 100(b) EPC, that the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by the person skilled in the art.

The Opposition Division held amongst others that the subject-matter of claims 1 of the main request and of the first and second auxiliary requests, all filed at the oral proceedings before it, lacked inventive step over D3 and the common general knowledge of the person skilled in the art. Consequently, the patent was revoked.

IV. With a communication dated 11 October 2013 and annexed to the summons to oral proceedings the Board presented its preliminary opinion with respect to claims 1-15 of the main request, claims 1-14 of the first auxiliary request and claims 1-10 of the second auxiliary request, all as mentioned above and underlying the

impugned decision. They were all re-filed together with the statement of grounds of appeal.

With respect to the issue of Article 56 EPC the Board remarked amongst others that it appeared that D3 represents the uncontested closest prior art for the fittings of claim 1 of the main request, which appeared to be distinguished from those of D3 only by the feature that the spacing between adjacent windings is approximately 1/5 of the largest cross-sectional dimension of the wound member. Based on the effect underlying this feature, namely a simplified handling in combination with a good grip of the fitting on the bundle of objects (see patent in suit, paragraph [0049]) the objective technical problem starting from D3 was considered to be the provision of a fitting having a good grip with simplified handling. The solution thereto, however, appeared to be obvious in the light of D3 and the common general knowledge of the person skilled in the art.

The additional features of claims 1 of the first and second auxiliary requests - i.e. that "the material is EDPM rubber having a Shore A hardness in the interval from approximately 50 to approximately 80" or that "the cross-section of the wound member is substantially square or rectangular with rounded edges", respectively - appeared to solve different independent technical problems not being common to the one attributed to the spacing feature so that there appeared to exist an aggregation of features which solved different partial problems. Consequently, the subject-matter of the claims 1 of the first and second auxiliary requests appeared to lack inventive step, as well, taking account of the teaching of D4 and of D3.

V. With letter dated 17 January 2014 the appellant submitted, as a response to the summons to oral proceedings, amended first and second auxiliary requests in combination with arguments concerning the basis of the amendments made therein and with respect to inventive step.

VI. With letter dated 28 January 2014 the respondent submitted further arguments in particular with respect to inventive step of claim 1 of the main request and the claims 1 of the amended first and second auxiliary requests.

VII. With letter dated 7 February 2014 the appellant filed slightly modified new first and new second auxiliary requests in order to take account of an objection raised by the respondent in its last submission. Furthermore, it submitted copies of two awards which the invention had received in 2002.

VIII. Oral proceedings before the Board were held on 11 February 2014. The issue of inventive step of claim 1 of the main request was discussed in respect of document D3 and documents D1, D2, D4 and D5. Then the issue of inventive step of claims 1 of the new first and new second auxiliary requests was discussed in respect of document D3 and documents D1, D2, D4 and D5. Thereafter, the admission into the proceedings of a new third auxiliary request filed at the oral proceedings was discussed.

a) The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the set of claims filed as main request with letter of 26 July 2010 or, alternatively, on the basis of

the sets of claims filed as new first and new second auxiliary requests with letter of 7 February 2014 and as third auxiliary request during the oral proceedings.

b) The respondent requested that the appeal be dismissed.

At the end of the oral proceedings the Board announced its decision.

IX. Independent claim 1 of the main request reads as follows (amendments as compared to claim 1 as granted are in bold or strikethrough; emphasis added by the Board):

"1. A fitting for the use as a means for the gripping of one or more objects (5), said fitting comprising a substantially helical coil with at least two windings formed by a wound member (1) of a resilient material with shape memory, where said helical coil has a natural shape in which the substantially helical coil comprises a spacing (d) between adjacent windings, characterized in that the spacing (d) between adjacent windings ~~comprises~~ **is** approximately 1/5 of the largest cross-sectional dimension of the wound member (1)."

X. Independent claim 1 of the new first auxiliary request differs from claim 1 of the main request in that the feature "**the largest cross-sectional dimension of the wound member (1) is approximately between 6 mm and 16 mm, preferably 8 mm and 14 mm, and most preferably between 10 mm and 12 mm and that**" has been added between the term "characterized in that" and the feature "the spacing (d) between adjacent windings is ...".

XI. Independent claim 1 of the new second auxiliary request differs from claim 1 of the main request in that the feature "**the largest cross-sectional dimension of the wound member (1) is approximately between 10 mm and 12 mm and that**" has been added between the term "characterized in that" and the feature "the spacing (d) between adjacent windings is ...".

XII. Independent claim 1 of the third auxiliary request reads as follows (amendments as compared to claim 1 as granted are in bold or strikethrough; emphasis added by the Board):

"1. A fitting for the use as a means for the gripping of one or more objects (5), said fitting comprising a substantially helical coil with at least two windings formed by a wound member (1) of a resilient material with shape memory, ~~where said helical coil has a natural shape in which the substantially~~ **preferably natural or synthetic rubber, a silicone based product or plastic, where said** helical coil comprises a spacing (d) between adjacent windings, characterized in that **the largest cross-sectional dimension of the wound member (1) is approximately between 6 mm and 16 mm, preferably 8 mm and 14 mm, and most preferably between 10 mm and 12 mm and that** the spacing (d) between adjacent windings comprises approximately 1/5 of the largest cross-sectional dimension of the wound member (1)**, where the cross-section of the wound member is substantially circular, or square with rounded edges, and where the number of windings is 2 to 10.**"

XIII. The appellant argued, insofar as relevant for the present decision, essentially as follows:

Document D3 discloses a fitting having a coiled winding with a spacing (i.e. a gap) that is either zero or which corresponds to the largest dimension of the rectangular wound member, i.e. the ratio is 1/1 (see e.g. figure 2). D3 gives no hint that this gap has any importance. A series of steps is necessary in order to arrive at the subject-matter of claim 1 of the main request. There are three criteria for the size of this gap of the fitting:
- it allows that a cable can be introduced;
- it reduces entanglement (see patent in suit, paragraph [0014]); and
- it influences the ease of use (ergonomics).
Only an adequate spacing or gap between the windings fulfils these three requirements. The claimed fitting solves a known complex problem in an elegant manner. Further, two design awards have been given for the surprising technical effect of the fitting, related to that gap.

The ratio 1/5 for the gap is not arbitrarily selected although it could have been 1/4 or 1/6. However, a range for the gap was unfortunately not included in the patent in suit. This value of approximately 1/5 is a very good solution to make the invention work and gives better results with minimum entanglement compared to other ratios.

The difference in handling between the two fittings produced at the oral proceedings, the first being in accordance with the invention made of rubber (red spiral) and the other being an example manufactured by the respondent (black spiral) and made from a relatively stiff thermoplastic material, is obvious. The materials of the claimed fitting are defined in claim 14 of the main request.

The friction of the material is not a great issue since only in case that it were very slippery it would not work but all other materials will work. Friction is not a key-element of the invention.

Entanglement is primarily influenced by the gap, the size of the fitting and the number of windings. The shape of the spiral ends also may have an influence on entanglement with other fittings or other objects.

The trial and error method for determining said gap as mentioned in the Board's communication does not properly consider the use of the claimed cable holder with one hand as described in paragraph [0050] of the patent in suit. It is, however, admitted that there are different ways of applying the cable holder.

The subject-matter of claims 1 of the new first and new second auxiliary requests is similar. Both attempt to define the cable holder with respect to the size of the hand and it is the size of the windings and of the gap that are essential.

The cable holder can be applied with one hand. It does not solve the same problems as D3 which is silent with respect to entanglement and to the use of one hand when applying it. The claimed fitting of the new first and second auxiliary requests allows that
a) the cable holder holds the cables, and
b) the cable holder is functional and can be easily applied.

It is not just finding a specific size for the gap but of a section since it is necessary that the gap can be increased to properly insert the cable through it. On

the other hand, if the gap is too wide then the holder could slip down on the cable.

The above argumentation applies equally to claim 1 of the second auxiliary request which defines the largest cross-sectional dimension of the wound member being approximately between 10 mm and 12 mm.

The new first auxiliary and second auxiliary requests were attempts to define the claimed object adequately. However, the discussions on inventive step have shown that further features have to be included in a modified claim 1 in order to support inventive step, also with respect to the issue of entanglement. The avoidance of entanglement is influenced by the cross-section of the wound member of the fitting. That is why the new third auxiliary request is filed so late; it is the last chance to have the patent in suit maintained.

XIV. The respondent argued, insofar as relevant for the present decision, essentially as follows:

The subject-matter of claim 1 of the main request is distinguished from the spiral cable holder of D3 only by the distance d between adjacent windings of approximately 1/5 of the largest cross-sectional dimension of the wound member thereof.

The patent in suit mentions as problems to be solved the provision of a fitting which has a simplified handling with an improved grip of the fitting on the bundled elements (see paragraphs [0011] to [0013]).

However, these objects are not solved by a distance d between two adjacent windings of 1/5 of the largest cross-sectional dimension of the wound member. In order

to solve these problems claim 1 would additionally need to define the coefficient of friction and the length of the spiral.

The difference between the red spiral fitting (made from rubber) and the black spiral fitting (made from a thermoplastic material), both produced during the oral proceedings, resides in the properties of the two different materials used for them but does not reside in their somewhat different distance d between two adjacent windings.

This distance d of approximately 1/5 is arbitrarily selected since neither a visible effect is obtained with that value nor an at least theoretically plausible effect. It is also not plausible why a ratio for the spacing between adjacent windings and the largest cross-sectional dimension of the wound member should be decisive for the handling. In case that the said cross-sectional dimension is very small, then as a result of this ratio the spacing between adjacent windings is also very small which complicates the introduction of any object to be bundled into the fitting instead of simplifying it. The person skilled in the art could likewise select a ratio of 1/4 or 1/6 as admitted by the appellant.

Furthermore, D3 teaches specifically that in any case the distance should be wide enough to slip the looped cable between them (see page 3, lines 17 to 19; figures 1-3).

D1 shows in its figures 1 and 2 spirals with contiguous windings or windings which are separated by a distance which corresponds to about the width of them. D4 shows distances between two adjacent windings which are

smaller than the largest cross-sectional dimension thereof (see e.g. figures 3 and 4I). D5 likewise shows a distance between two adjacent windings which is smaller than the width thereof (see figure 1).

The problem of avoiding entanglement does not require a distance d of 1/5 since it would identically work with a gap of 1/3 or 1/4. This effect is additionally dependent upon the material used for making the fitting and also dependent upon the cross-section of the windings, e.g. a circular cross-section will be beneficial. Therefore it is not plausible why this feature of a distance of 1/5 of the largest cross-sectional dimension of the wound member should solve this problem. There exists no reason to select this distance d.

Since D3 discloses a width of the windings of 10-20 mm (see page 3, lines 21 and 22) the only distinguishing feature between the subject-matter of claim 1 of the new first auxiliary request and the fitting according to D3 resides only in the distance d. This is due to the fact that the claimed ranges of 6-16 mm, 8-14 mm and 10-12 mm are anticipated by the known range of 10-20 mm according to D3.

The features of these ranges have nothing in common with the solution of the objective problem.

Therefore the arguments concerning claim 1 of the main request apply likewise to claim 1 of the new first auxiliary request.

These arguments apply likewise to claim 1 of the new second auxiliary request which defines a cross-sectional dimension of approximately between 10 mm and

12 mm which overlaps with said range of 10-20 mm according to D3.

The person skilled in the art will try smaller distances (gaps) between adjacent windings if necessary. In this context it is emphasised that the gap between two adjacent windings of the spiral must be sufficiently wide so that the cable can be introduced but it must not necessarily have the width of the cable since the spiral is made from a resilient material. Therefore the skilled person could select a distance of 1/5 but could at the same time select 1/2 which would also avoid entanglement.

Therefore the subject-matter of claims 1 of the new first and new second auxiliary requests lacks inventive step.

The new third auxiliary request should not be admitted into the proceedings for being late filed and for raising new issues introduced by the appellant only at the oral proceedings.

A circular cross-section of the fitting, the number of windings, preferred materials of the fitting have never been an issue of discussion in the entire proceedings before the filing of this new auxiliary request at the oral proceedings.

Reasons for the Decision

1. *Admissibility of amendments (Articles 84 and 123(2) EPC)*

Since the Board considers that the claims 1 of the main request and the new first and second auxiliary requests

do not comply with Article 56 EPC (see point 2 below) there is no need to consider in this decision whether these claims comply with Articles 84 and 123(2) EPC.

2. *Inventive step (Article 56 EPC) - New second auxiliary request*

The discussion of inventive step is more efficient if the Board first turns to the most limited product claim 1 of the new second auxiliary request (see point XI above), since this embodiment of the fitting which requires "**that the largest cross-sectional dimension of the wound member is approximately between 10 mm and 12 mm**" is encompassed by the subject-matter of claims 1 of the main request and the new first auxiliary request of which the former does not define any value of said cross-sectional dimension at all and the latter defines a broader range of "approximately between 6 mm and 16 mm" (see points IX and X above).

2.1 D3 represents the uncontested closest prior art for the fitting of product claim 1 of the new second auxiliary request. D3 also forms the most promising spring board towards the invention with respect to an improvement of this known fitting (see Case Law of the Boards of Appeal, 7th edition 2013, sections I.D.3.4 and I.D.3.5).

2.1.1 D3 discloses a cable holder (i.e. a fitting) comprising a substantially helical coil with at least two windings being formed from a wound member of a resilient (elastic or substantially rigid) material with shape memory which helical coil in its natural shape has a spacing between adjacent windings (see figure 3 and page 4, lines 11 to 19). Said fitting is for holding a plurality of cables and wires pressed into the interior of the helix between its windings (see page 1, lines 2

and 3 and line 32 to page 2, line 5). At one end the wound member is slightly curved inwards at an angle of about 30° so as to hold the cables or wires firmly in place, thus preventing the cables from slipping out (see abstract). The interior of the helix can have a frictional surface to prevent the cables from slipping inside the helix (see page 2, lines 6 to 12). The fitting is made from semi-rigid material that is rigid enough to hold a cable in folded-up form but that is sufficiently resilient to enable the holder to be bent slightly when introducing cable into the helix or removing cable from it. This permits easy introduction and removal of the cable, whilst retaining grip on the cables when the cables are in place (see page 2, lines 22 to 29). A cable can be removed from the holder by twisting or turning the clip and the cable or wire is then removed (see page 3, lines 9 to 13).

D3 further shows that the distance between (adjacent) windings is about the same as the width of the strip and in any event discloses that it should be wide enough to slip the looped cable between them. The flat form gives a good degree of elasticity and plenty interior space for the cable. The width may be 1-2 cm and the diameter of the helix perhaps 3-6 cm (see page 3, lines 13 to 22; figure 1). The holder need consist only of the helix itself and is supported by the flex which it contains (see page 3, line 36 to page 4, line 2). The embodiments with two and three windings according to figures 2 and 3 are made of a semi-rigid plastic material with a good "memory" so that it retains its shape (see page 4, lines 11 to 19).

2.1.2 The disclosed width of 1-2 cm (= 10 mm to 20 mm) represents the largest cross-sectional dimension of the wound member of the fitting according to D3 which

entirely overlaps with and therefore anticipates the range of "approximately between 10 mm and 12 mm" of claim 1 of the new second auxiliary request.

Therefore the subject-matter of claim 1 of the new second auxiliary request is distinguished from the fitting of D3 **only** by the feature that the spacing d between adjacent windings is approximately 1/5 of the largest cross-sectional dimension of the wound member.

2.1.3 The effect underlying this spacing (or gap) d between two adjacent windings of the fitting in its natural shape is a simplified handling of the fitting, which allows easy passage of the elongated objects between two adjacent windings, in combination with a good grip.

According to the patent in suit this spacing, related to the largest cross-sectional dimension of the wound member, facilitates the application of the fitting by allowing the thumb or a finger of the manipulating hand to easily enter deep enough into the gap to allow the application of force in a direction substantially along the longitudinal axis of the helical coil whereby a sufficient gap between adjacent windings can be easily opened to pass the (bundle of) elongated object(s) between them (see patent in suit, paragraphs [0011], [0014], [0016] and [0049]).

This spacing is also stated to be still small enough to provide a fitting which avoids entanglement with other objects through its compact shape when applied to a bundle of elongated objects (see patent in suit, paragraph [0014]). Furthermore, it is this original compact shape which allows for tangle-free storage and easy re-application (see paragraph [0054]).

Consequently, this distance d also avoids entanglement between a plurality of these fittings.

2.2 Therefore the objective technical problem starting from D3 is considered to be the provision of a fitting having a good grip with simplified handling which avoids entanglement between a plurality of fittings.

2.3 This problem is solved by the subject-matter of claim 1 of the second auxiliary request. The solution thereto, however, is obvious in the light of D3 and the common general knowledge of the person skilled in the art for the following reasons:

2.3.1 D3 teaches the person skilled in the art that the distance d between adjacent windings of the fitting has to be selected such that the cables to be bundled can be easily introduced between them and mentions a width of the (rectangular) windings of 10 mm to 20 mm (see page 3, lines 18, 19, 21 and 22). Thus D3 teaches the skilled person, in order to improve the handling of the fitting and for simplification of the introduction of the cables through said spacing d between two adjacent windings, to select a spacing d which is sufficiently large.

The selection of a value of said spacing d of approximately 1/5 of the largest cross-sectional dimension of the wound member, i.e. a distance d of about 2 mm to 2.4 mm, is considered to be arbitrary since neither a visible effect nor at least a theoretically plausible effect is combined with that value. The patent in suit discloses in this context **only** that the "size of the gap d depends partially on the cross-section of the elongated element, but is preferably 1/5 of the largest dimension of the cross-

section of the wound member 1"(see column 7, lines 10 to 13).

It is, however, neither apparent nor supported by any evidence that the specific value of (approximately) 1/5 results in a different effect than the values 1/4 or 1/6 as admitted by the appellant at the oral proceedings. A distance of e.g. 4 mm is thus considered to likewise be suitable for this purpose.

The two samples of fittings shown by the appellant at the oral proceedings, namely the red spiral fitting made from rubber in accordance with the invention and the black spiral fitting made from a thermoplastic material not in accordance with the invention (i.e. the distance d was not approximately 1/5) showed that the difference in handling between them actually resides in the different surface and elasticity properties of the two different materials used for making them but does not reside in their somewhat different distance d between two adjacent windings.

With respect to entanglement between a plurality of fittings it is, however, clear to the person skilled in the art that principally any value substantially smaller than the largest cross-sectional dimension of the wound member, e.g. 1/2 or 1/3, will avoid entanglement between two fittings since such a distance would prevent that a winding of one fitting can enter on its own into the gap between adjacent windings of another fitting.

Similarly it is clear to the person skilled in the art that the cables or the bundle of elongated objects have (has) to pass through an opening between adjacent windings of the fitting created by increasing this

distance (or gap) between these adjacent windings by applying a certain force to these windings in a direction substantially along the longitudinal axis of the resilient fitting when applying the fitting thereto.

2.3.2 Taking account of the above the Board considers that the person skilled in the art will select said spacing d such that the finger or thumb, for the mounting of said fitting, can easily enter into the spacing between two adjacent windings. It is considered that the person skilled in the art will determine this spacing by trial and error to find the proper spacing for general use and thereby will arrive at the subject-matter of claim 1 of the new second auxiliary request without inventive skills.

2.4 The appellant's arguments to the contrary cannot hold for the following reasons.

First of all, all arguments based on the application with "one hand only" cannot be accepted since claim 1 of all requests is directed to a product claim *per se* which is - even if it would contain any such definitions of a specific use which, however, is not the case - **not** restricted to such a use. This fact was acknowledged by the appellant at the oral proceedings.

Secondly, the arguments concerning all other possible influences with respect to avoiding entanglement of the fitting, such as the size of the fitting and the number of windings, the shape of the cross-section or the shape of the end of the windings, cannot be considered since claim 1 of the new second auxiliary request does not contain any corresponding restriction.

The argument that the fitting could slip over the cable in case the gap is too wide cannot hold either since claim 1 defines neither the diameter of any cable or bundle of elongated objects, nor the internal diameter of the winding or the material of the fitting (or its friction value) which obviously has an influence in this respect.

Likewise all arguments based on the properties of the material of the fitting cannot hold since independent claim 1 does not contain any corresponding restriction since the materials specified in claim 14 are only optional, because of its dependent character and thus have no limiting effect on claim 1.

2.5 The objective technical problem defined by the Opposition Division with respect to claim 1 of the main request - based on the conclusion that the spacing of D3 is larger than that in the fitting of claim 1 and the alleged effect that the spacing increases the lateral surface of the fitting (see point 3.3 of the reasons of the impugned decision) - to improve the grip of the fitting on the bundle of elongated objects in view of paragraph [0048] of the patent in suit is **not** acceptable for the following reasons.

First of all, if the ratio value of about 1 to the largest cross-sectional diameter of the wound member according to D3 is considered large it is not apparent how the **smaller** spacing of about 1/5 according to the patent in suit should **increase** the lateral frictional surface of the helical coil since the contact area with the elongated objects should actually be smaller than that of D3. Furthermore, the friction of the surface is also influenced by the choice of material of the fitting, which is not specified other than that it is

resilient with shape memory. Secondly, claim 1 of the main request does **not** require the use of non-circular and particularly flattened cross-sections of the wound member which in view of paragraph [0048] would imply an improvement of the grip of the fitting.

Main request and new first auxiliary request

2.6 Since claim 1 of the new second auxiliary request is narrower in scope than claim 1 of the main and the new first auxiliary requests (compare points IX to XI above) the above conclusion with respect to claim 1 of the new second auxiliary request applies *mutatis mutandis* to the claims 1 of the main and the new first auxiliary requests.

The Board therefore concludes that their subject-matter does not comply with the requirements of Article 56 either. The main request and the new first auxiliary request are thus not allowable.

3. Admission into the proceedings of the new third auxiliary request (Articles 12(2), 13(1) and 13(3) RPBA)

Towards the end of the oral proceedings - after the respective discussions on inventive step of claim 1 of the main request and of claims 1 of the new first and new second auxiliary requests and the deliberation on these new requests - the Board had presented its respective negative conclusions, firstly with respect to claim 1 of the main request, and secondly with respect to the claims 1 of the new first and the new second auxiliary requests, see point VIII above. At that point in time the appellant, who had stated during the discussions that he might intend to do so, filed a

third auxiliary request. This third auxiliary request was essentially directed to a combination of claims 1, 2, 3, 7, 9 and 14 of the patent as granted (see point XII above).

3.1 The respondent requested that this new request should not be admitted into the proceedings for being late filed and for raising new issues. A circular cross-section of the fitting, the number of the windings, preferred materials of the fitting or the deletion of the feature concerning the natural shape of the helical coil (see point XII above) have never been an issue of discussion in the appeal proceedings.

3.2 According to Article 12(2) RPBA the statement of grounds of appeal and the reply thereto shall contain a party's complete case. Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion which 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 (Article 13(1) RPBA).

Amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings (Article 13(3) RPBA).

In exercising this discretion in particular to the admission of amended claims submitted during oral proceedings the boards amongst others consider the following criteria (see Case Law of the Boards of

Appeal, 7th edition 2013, sections IV.E.4.2 to IV.E. 4.4):

i) there should be a justification for the late filing, i.e. the amendment should be justified by the development in the appeal proceedings but it should not extend the scope or framework of discussions as determined by the decision under appeal and the statement of the grounds of appeal;

ii) in order to be admitted into the proceedings, an amended claim belatedly filed in the oral proceedings must be clearly allowable by virtue of a clearly admissible amendment, i.e. it must be immediately apparent to the Board that the amendments successfully address the issues raised without giving rise to new ones;

iii) the subject-matter of the new claims should not contain subject-matter which has previously been withdrawn in the proceedings.

3.3 The Board remarks that in the present case the appellant has already amended its original case - which was based on the main and two auxiliary requests underlying the impugned decision (see point III above) - as a reaction to the Board's communication (see point IV above) by filing with its letter dated 17 January 2014, i.e. about three weeks before the oral proceedings scheduled for 11 February 2014, amended first and second auxiliary requests (see point V above). These amended first and second auxiliary requests were then replaced by the present new first and new second auxiliary request which were submitted by online filing in the afternoon of 7 February 2014

(see point VII above), i.e. less than two working days before the oral proceedings.

3.4 At the oral proceedings - except for the **new issue** of **avoiding entanglement** of the claimed fittings which was, however, introduced there by **the appellant** for the first time in the entire proceedings - no new matter arose which had not already been addressed in the Board's communication, in the preceding written proceedings or in the decision under appeal.

3.5 The appellant, when asked by the Board why this new third auxiliary request has been filed so late, stated that the new first auxiliary and second auxiliary requests were attempts to define the claimed object adequately but that the discussions have shown that further features have to be included in a modified claim 1, also with respect to the issue of entanglement which is influenced by the cross-section of the wound member of the fitting, and that it is a genuine attempt to maintain the patent.

The appellant could also not make plausible why the additional feature of the former second auxiliary request defining a square or rectangular cross-section with rounded edges (see point IV above), which according to its arguments was related to the issue of avoiding entanglement of the fittings, has been removed from the subject-matter of claims 1 of the new first and new second auxiliary requests but now should be re-introduced into claim 1 of the new third auxiliary request in the form of a substantially circular or square cross-section with rounded edges (see point XII above).

3.6 Taking account of the above the appellant's arguments are no justification for the very late filing of this auxiliary request. It cannot be that a party, in the present case the appellant, raises a completely new issue at the oral proceedings (here avoiding entanglement) and then attempts to file a new auxiliary request which addresses this new issue. In the present case this also creates further issues such as the shape of the cross-section (previously absent from the claim) and the material of the fitting (such as plastic) which have never been discussed before in the appeal proceedings. It is evident that the scope of discussion compared to the written proceedings would be substantially extended and the Board is not prepared to deal with it.

Furthermore, in the Board's view the appellant had the opportunity to file this further auxiliary request together with its submission of either 17 January 2014 or 7 February 2014.

3.7 The Board therefore decided not to admit the third auxiliary request into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

G. Nachtigall H. Meinders

Decision electronically authenticated