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Datasheet for the decision of 26 September 2012

Case Number: T 2363/10 - 3.2.06

Application Number: 07824482.9

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IPC: B62B 3/00, B62B 5/00

Language of the proceedings: EN

Title of invention:
Walk-with apparatus

Applicant:
Arpino, Mario Peter

Headword:
-

Relevant legal provisions:
EPC Art. 54, 84, 123(2)
EPC R. 139
RPBA Art. 13(1)

Keyword:
"Correction of description (no)"
"Main request: clarity (no), novelty (no)"
"Auxiliary request 1: clarity (no), novelty (no), late-filed, not admitted"
"Auxiliary request 2: clarity (no), novelty (no), late-filed, not admitted"
"Auxiliary request 3: clarity (no), novelty (no), late-filed, not admitted"
"Auxiliary request 4: clarity (no), late-filed, not admitted"
"Auxiliary request 5: amendments - intermediate generalisation, clarity (no), late-filed, not admitted"

Decisions cited:
-

Catchword:
-

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Case Number: T 2363/10 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 26 September 2012

Appellant: (Applicant)
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 28 July 2010 refusing European patent application No. 07824482.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: M. Harrison
Members: G. de Crignis
K. Garnett

Summary of Facts and Submissions

I. With its the decision posted on 28 July 2010 the Examining Division refused European patent application No. 07 824 482.9 for lack of novelty in view of
D1: US-A-2 937 706
with regard to claim 1, and also due to a lack of inventive step.

II. The appellant (applicant) filed an appeal against this decision and with its grounds of appeal filed a replacement main request, upon which grant of a patent was requested.

III. In a communication annexed to the summons to oral proceedings, the Board indicated that the requirements of Articles 84 EPC and 123(2) EPC appeared not to be met and *inter alia* that the examining division's finding of lack of novelty did not appear to have been overcome.

IV. With letter of 31 August 2012, the appellant filed an amended main request and first to fourth auxiliary requests, and additionally maintained the previous main request filed with its grounds of appeal, renumbered as auxiliary request 5.

V. Oral proceedings were held before the Board on 26 September 2012. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main, alternatively the first to third auxiliary requests filed on 31 August 2012, alternatively the fourth or fifth auxiliary requests filed during the oral proceedings.

VI. Claim 1 of the main request reads:
"Walk-with apparatus (101) having a reference member (18) and a handle (1) adapted to be used to hold and guide the apparatus, the handle being movable in a forwards and backwards direction (103) relative to the reference member (18) to produce electric signals (104) to vary the speed of the apparatus, characterised in that the apparatus comprises damping means (13, 14) and the handle (1) is movable in the forwards and backwards direction relative to the reference member to produce the electric signals to vary the speed of the apparatus under the effect of the damping means thereby to inhibit hunting."

Claim 1 of the first auxiliary request (auxiliary request 1) further defines the damping means as "damping means (13, 14) which comprise a mechanical damper".

Claim 1 of the second auxiliary request (auxiliary request 2) reads:
"Walk-with apparatus (101) having a reference member (18), a handle (1) adapted to be used to hold and guide the apparatus, and continuous position sensor means, the handle being movable in a forwards and backwards direction (103) relative to the reference member (18) and the continuous position sensor means being arranged to produce electric signals (104) to vary the speed of the apparatus, characterised in that the apparatus comprises damping means (13, 14) and the handle (1) is movable in the forwards and backwards direction relative to the reference member to produce the electric signals to vary the speed of the apparatus

under the effect of the damping means thereby to inhibit hunting."

Claim 1 of the third auxiliary request (auxiliary request 3) includes the amendments to claim 1 made in both auxiliary requests 1 and 2.

Claim 1 of the fourth auxiliary request (auxiliary request 4) reads:
"Walk-with apparatus (101) having a reference member (18), a handle (1) adapted to be used to hold and guide the apparatus, and continuous position sensor means, the handle being movable in a forwards and backwards direction (103) relative to the reference member (18) and the continuous position sensor means being arranged to produce electric signals (104) from movement of said handle to vary the speed of the apparatus, characterised in that the apparatus comprises a DC motor controller (110) adapted to provide an acceleration ramp for a motor (111), and comprises rotary damping means (13, 14) and the handle (1) is movable in the forwards and backwards direction relative to the reference member to produce the electric signals to vary the speed of the apparatus under the effect of the rotary damping means thereby to inhibit hunting."

Claim 1 of the fifth auxiliary request (auxiliary request 5) reads:
"Walk-with apparatus (101) having a reference member (18), a handle (1) adapted to be used to hold and guide the apparatus, and continuous position sensor means, the handle being movable in a forwards and backwards direction (103) relative to the reference member (18)

and the continuous position sensor means being arranged to produce electric signals (104) from movement of said handle to vary the speed of the apparatus, characterised in that the apparatus comprises a DC motor controller (110) adapted to provide an acceleration ramp for a motor (111), and comprises rotary damping means (13, 14) connected between the handle and the reference member and the handle (1) is movable in the forwards and backwards direction relative to the reference member under the effect of the rotary damping means, wherein the rotary damping means and the acceleration ramp controller (110) are adapted for adjustment in combination to enable the speed of travel of the apparatus (101) to be smoothly regulated to match the speed of an operator (108) walking with the apparatus (101) simply by the operator (108) moving the handle (1), thereby inhibiting hunting."

VII. The arguments of the appellant may be summarised as follows:

All requests should be admitted into the proceedings. They represented an appropriate attempt to overcome the objections raised by the Board.

It was clear from the description as a whole and from the embodiment shown in e.g. Figure 1.1, that the only sensible technical meaning of "thereby to inhibit hunting" concerned the damping of the interaction between the handle and the reference member. Hunting of these parts of the apparatus was reduced or prevented by the damping means and concerned any erratic movement linked to acceleration or deceleration of the speed of

the device such as set out in page 13, lines 23 - 28 of the description.

Further, the skilled person knew that hunting could also be defined as a "self-exciting oscillation" (such as defined in Wikipedia). It was the movement of the handle relative to the reference member which was subject to hunting and it was this hunting which was inhibited. This was clear from the description, when understood correctly. A self-exciting oscillation could not be damped by a spring means. It was the mass-spring-damper model which was used to calculate harmonic oscillation by mechanical engineers which were thus well aware that dampers and springs represented different entities having different functions. Hence, a spring could not reduce or prevent hunting and therefore did not correspond to a damping means. The portions of the description referring to the damping means comprising spring means were simply erroneous and this problem was overcome by deleting these references in accordance with Rule 139 EPC as correction of an error.

The meaning of the wording "under the effect of the damping means" referred to the movements of the reference member and the handle relative to each other being damped. The hunting between these two elements was thus inhibited by the damping means. It was not necessary to define in the claim that hunting between these specific elements was intended, as this would be implicit. It was also not necessary to define "damping means" more specifically as the skilled person knew which means were encompassed thereby.

The wording of the claim would only be reasonably interpreted such that the movement of the handle was apt to produce electric signals via sensor means detecting its relative movement. Such possibility was well-known to the skilled person and hence sensor means were implicitly included in claim 1. It was also implicit in the wording of the claim that the speed of the apparatus was directly dependent on the relative positions of the handle and that the apparatus included a motor (see page 13, lines 23/24). Such self-evident features did not need to be defined explicitly in the claim.

D1 did not disclose a mechanical damper since a spring was not a damping means and thus not capable of inhibiting hunting. Hence, the subject-matter of claim 1 was novel over e.g. D1.

Concerning auxiliary request 1, the amendment whereby the damping means comprised a mechanical damper had been made on the assumption that a spring would not be considered to be a damper. Apart from this, all the arguments put forward in support of allowability of the main request applied equally.

Concerning auxiliary request 2, claim 1 additionally included continuous position sensor means in the apparatus, whereby it was clarified how the electric signals were produced. With regard to the further objections, all arguments put forward with regard to the previous requests applied equally.

Claim 1 of auxiliary request 3 combined the features of claim 1 of auxiliary requests 1 and 2, so that all the arguments set out before were also applicable here.

Claim 1 of auxiliary request 4 was further amended in that it specified that the damper means were rotary damping means and in that the movement of the handle effected the variation of the speed of the apparatus. Moreover, claim 1 included the feature of a DC motor controller adapted to provide an acceleration ramp for a motor. It was implicit that this was the motor which drove the apparatus. Accordingly, the wording of claim 1 was clear and its subject-matter was novel over D1.

Claim 1 of auxiliary request 5 included features concerning the adaptation of the rotary damping means and of the acceleration ramp controller for adjustment to enable the speed of travel of the apparatus to match the speed of an operator via a smooth regulation when moving the handle. It was thus specified how the inhibition of hunting was achieved. Hence, a lack of clarity could not be present. Such combination of features was in the originally filed description on pages 1 and 2 under a series of bullet points and the skilled person would consider this particular combination as being a justifiable combination of features since he could select the appropriate combination of features from the individual features disclosed so as to provide the necessary components to solve the problem of hunting.

Reasons for the Decision

1. Main request - Clarity

1.1 In claim 1, the apparatus is defined by the structural features of a reference member, a handle and damping means. The handle is defined as being movable relative to the reference member. Hence, in the context of these structural features, the meaning of the features "thereby to inhibit hunting" and "under the effect of damping means" in claim 1 has to be identified.

1.2 As explained below it is not clear, contrary to the requirement of Article 84 EPC, what is meant by "hunting" in the context of the present application. Further, it is not clear which parts of the claimed apparatus might be considered as being subject to "hunting" and thus consequently what exactly is being inhibited from "hunting".

1.2.1 The appellant referred to the description on page 13, lines 23 - 28 which states:
"*In order to prevent erratic movement of the piston/handle assembly, particularly over uneven terrain, a damping mechanism is used*. ... *Introduction of the damper mechanism allows for smooth acceleration to be achieved through the damped movement of the handle while preventing hunting.*"

Claim 1 as originally filed read in this respect:
"*thereby to inhibit (i.e. reduce or prevent) hunting*".

1.2.2 First, the above citation from the description merely states that the damper mechanism performs the function

of allowing smooth acceleration; it does not give a definition of "hunting" since the word "while" specifies that the smooth acceleration is merely something which is allowed at the same time as hunting is prevented. Originally filed claim 1 also does not specify the nature of "hunting" but merely clarifies what "inhibited" should mean. Thus, from these extracts cited by the appellant, it cannot be deduced what "hunting" means, nor which parts of the apparatus are considered responsible for the "inhibition" of this "hunting". Further, the cited extract refers to a piston/handle assembly, whereas no piston/handle assembly is claimed, and the same extract refers only generally to a damping means without specifying its positional or structural interrelationship with other parts of the device. Thus, even when using the description to try and resolve the lack of clarity in the claim itself, the lack of clarity is not overcome.

1.2.3 The further reference of the appellant to the citation in Wikipedia that hunting could be defined as a "self-exciting oscillation" is not suitable to overcome the above objections since it is not clear which parts of the present device are subject to a self-exciting oscillation, nor what conditions might cause this to occur.

1.2.4 Second, it should be clear which parts of the claimed apparatus are to be considered with respect to the wording "under the effect of the damping means".

It is not specified in the wording of claim 1 which components of the apparatus are to be considered "under the effect of the damping means" or even whether this

relates to a functional aspect of the device. Nor is it clear whether or how this effect of the damping means is linked to the feature of "thereby to inhibit hunting".

1.2.5 It is also, contrary to the appellant's assertion, not disclosed anywhere in the description that the wording "under the effect of the damping means" is to be linked to the movement of the handle relative to the reference member or that it is linked to the variations of the speed of the apparatus. Moreover, it is not specified whether further structural means are provided or necessary for such effect.

1.2.6 Hence it remains undefined what exactly results "under the effect of the damping means" and which parts of the apparatus are to be considered. Thus, also with regard to this wording, the requirement of clarity in Article 84 EPC is not met.

1.3 The main request is therefore not allowable, at least as regards the requirement of clarity (Article 84 EPC).

2. Main request - novelty

The only feature identified by the appellant allegedly distinguishing the subject-matter of claim 1 from the disclosure in D1 was the apparatus comprising "damping means", which in the appellant's view excluded springs (such as disclosed in D1).

The description in the application as filed refers at several locations in the text to damping means or inhibiting means as including a spring (e.g. page 7,

lines 19, 32; page 8, line 27/28; page 9, lines 1/2; page 17, line 14; page 20, line 5). In view of the various citations in this respect, the conclusion can only be drawn that the application in suit also included this possibility intentionally. Although the appellant filed a request deleting this terminology from the description, this does not change the content of the application as filed, nor does it alter the components which may fall under the term "damping means".

Such finding is also consistent with the function of a spring in a real-life mechanical application. Although the equations (Fs = kx; where k represents the spring constant and x represents the displacement; and Fd= cv; where c represents the damping constant and v represents the velocity) referred to in the submissions of the appellant clearly distinguish between damping and spring forces, such a distinction applies purely under specific or theoretical conditions (such as for example for hydraulic dampers where the damping force Fd is approximately proportional to the velocity of the piston) whereas in a practical system such theoretical conditions do not prevail and realistic conditions have to be taken into account. In particular, the choice of the materials (metal, plastics) and the location and interactions of a spring in an apparatus (system conditions) influence the function in such a way that a certain aspect of damping is inherent in a spring mechanism. Therefore, in particular the citation in the application as filed (page 8, line 27) referring to the damping means as comprising spring means sufficiently stiff to help prevent hunting action of the movement of the apparatus can only be understood as being generally

correct. Consistently, springs are included in the general term "damping means" and such citations in the description cannot be regarded as simply being erroneous (and therefore also cannot simply be deleted under Rule 139 EPC without infringing Article 123(2) EPC), as such an amendment would result in subject-matter which is not clearly the only possible correction of the text.

Thus, consistent with the examining division's finding - that springs are included in the general term "damping means" -, the subject-matter of claim 1 lacks novelty (Article 54 EPC) with regard to D1 (see point 1 of the appealed decision).

3. Auxiliary request 1

This request was filed after the Board's communication. It lies within the discretion of the Board to admit any amendment to a party's case after it has filed its grounds of appeal or reply according to Article 13(1) RPBA. In order to be admitted, such a request should clearly be allowable at least in the sense that it overcomes the foregoing objections and does not give rise to further objections, which is however not the case here, as explained below.

Since a spring is considered to fall under the definition "damping means" in the context of claim 1, the further definition in claim 1 that the damping means comprises a mechanical damper does not change the finding on novelty (Article 54 EPC) with regard to D1, since the spring in D1 is a mechanical element acting as a damper, and thus a mechanical damping means. Nor

is the finding of lack of clarity (Article 84 EPC) with regard to the wording "under the effect of the damping means" and "thereby to inhibit hunting" overcome by this amendment. Hence, the request was *prima facie* not allowable and was thus not admitted into the proceedings.

4. Auxiliary requests 2 and 3

These requests were also filed after the Board's communication and the provisions according to Article 13(1) RPBA set out above apply equally.

Although claim 1 of auxiliary request 2 includes the feature concerning continuous position sensor means, this has no effect on the Board's finding of lack of clarity (Article 84 EPC) in regard to the main and first auxiliary requests, at least with regard to the wording "under the effect of the damping means" and "thereby to inhibit hunting". The appellant also did not contend that the amendments made in these requests would address the objection of lack of clarity in some way. Hence, these requests were also not *prima facie* allowable and were therefore not admitted into the proceedings.

5. Auxiliary request 4

The request was filed during the oral proceedings, hence at the latest possible stage in the proceedings and as already set out above the provisions according to Article 13(1) RPBA apply. In order to be admitted such a request should clearly be allowable which is not

the case for claim 1 of this request, for the following reasons.

Claim 1 still includes the above objected wording "thereby to inhibit hunting" and the slightly amended wording "under the effect of the "rotary" damping means". Additionally, it is added that the apparatus should comprise "a DC motor controller adapted to provide an acceleration ramp for a motor".

However, the position and function of the DC motor controller in respect of the apparatus as well as the position of the rotational damper and its structural relation to the further components of the apparatus remain unspecified. Further, the lack of clarity objections concerning the terminology "to inhibit hunting" and "under the effect of…damping means" are not addressed. The appellant relied on its previous submissions as to how these amendments met the requirement of clarity in this regard. Thus, for the same reasons as already given above under item 1, these amendments were not suitable to overcome the clarity objections existing already in the main request, and auxiliary request 4 was therefore not admitted into the proceedings at least because *prima facie* it did not comply with the requirement of clarity in Article 84 EPC.

6. Auxiliary request 5

6.1 Amendments

Claim 1 has been amended compared to claim 1 as originally filed by adding the following features:

- continuous position sensor means,
- the continuous position sensor means being arranged to produce electric signals (104) from movement of said handle to vary the speed of the apparatus,
- the apparatus comprises a DC motor controller (110) adapted to provide an acceleration ramp for a motor (111), and comprises rotary damping means (13, 14) connected between the handle and the reference member
- the handle (1) is movable in the forwards and backwards direction relative to the reference member under the effect of the rotary damping means
wherein the rotary damping means and the acceleration ramp controller (110) are adapted for adjustment in combination to enable the speed of travel of the apparatus (101) to be smoothly regulated to match the speed of an operator (108) walking with the apparatus (101) simply by the operator (108) moving the handle (1) thereby inhibiting hunting.

6.2 The appellant argued that such combination of features was literally disclosed as originally filed in the description of the published WO-specification on page 1, line 37 and page 2, lines 20 - 26.

6.3 The citation on page 1, line 37 however lists one hundred and forty three bullet points, each bullet point being followed by one or more features. The list of bullet points is preceded by the following statement: "Any such apparatus, means or method has or may have any of the following features:".

The features inserted into claim 1 originate from the bullet points referred to on page 2, lines 20 - 26, which bullet points each of the individual bullet

points is followed by the following wording respectively:

"the damping means comprise rotary damping means."

"the damping means are connected between the handle and reference member."

"the inhibiting means comprise a DC motor controller to provide an acceleration ramp for the motor."

"in which the damping means and the acceleration ramp controller are capable of adjustment in combination to enable the speed of travel of the apparatus to be regulated to match the speed of an operator walking with the apparatus simply by the operator holding the handle, smoothly and so as to inhibit hunting."

"comprising linear position sensor means to produce said signals from movement of said handle."

"comprising continuous position sensor means to produce said signals from movement of said handle."

6.4 The application as originally filed refers generally to a walk-with apparatus and discloses a huge multiplicity of individual means and features which might be chosen for connection or adaptation when being applied in such an apparatus.

6.5 However, there is no disclosure in the description of the application as filed for a particular walk-with apparatus having the combination of features now claimed.

6.6 The selection of features disclosed in six out of one hundred and forty three bullet points represents a particular selection which is however not disclosed as such. The skilled person has no hint or incentive to choose exactly such a combination of features. The general statement "any such apparatus, means or method has or may have any of the following features" does not change this conclusion, since for a combination of selected elements to form a disclosure, additional information is required which directs the skilled person to this combination. Indeed, it is clear that some of the possible combinations of these features from the description are utterly mundane and could not have been intended by the applicant to disclose the invention. As a consequence, the characteristics used to define the apparatus in claim 1 represent a specific yet undisclosed combination of features from the entirety of features disclosed in the application as filed. No basis could be identified in the application as filed which clearly refers to a walk-with apparatus having this specific combination of features. Although the appellant argued that a skilled person would recognise that this specific combination of elements was the required combination of components which would solve the problems underlying the invention and in particular the problem of "hunting", no indication supporting this can be found in the application. Consequently the subject-matter of claim 1 at least *prima facie* extends beyond the content of the application as originally filed, contrary to Article 123(2) EPC.

6.7 Moreover, the amendments are not suitable to clarify how the wording "under the effect of (rotary) damping means" should be understood (Article 84 EPC). Likewise, merely replacing the wording "to inhibit hunting" by "thereby inhibiting hunting" does not overcome the fundamental problem as to the nature and location of "hunting" in the walk-with apparatus.

6.8 This request was also filed during the oral proceedings, and the provisions according to Article 13(1) RPBA apply. Hence, the fifth auxiliary request was not admitted into the proceedings, at least because *prima facie* it does not comply with either Article 123(2) EPC or Article 84 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar The Chairman

M. Patin M. Harrison