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**Datasheet for the decision
of 12 June 2013**

Case Number: T 0472/11 - 3.2.04

Application Number: 03763913.5

Publication Number: 1528852

IPC: A01G 23/091

Language of the proceedings: EN

Title of invention:

SAWING DEVICE AND ITS SAFETY SYSTEM FOR PRECAUTION OF A
BREAKING SAW CHAIN

Patent Proprietor:

John Deere Forestry Oy

Opponents:

Komatsu Forest AB
Ponsse Oyj

Headword:

Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 13(1)

Keyword:

Amendments - added subject-matter (yes)
Late-filed request - request clearly allowable (no)

Decisions cited:

T 0087/05

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 0472/11 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 12 June 2013

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 28 December
2010 revoking European patent No. 1 528 852
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: C. Heath
Members: A. de Vries
J. Wright

Summary of Facts and Submissions

- I. The Appellant (Proprietor) lodged an appeal, received 25 February 2011, against the decision of the Opposition Division posted 28 December 2010 to revoke European patent Nr. 1 528 852, and simultaneously paid the appeal fee. The statement setting out the grounds was received 28 April 2011.

Four oppositions were filed against the patent as a whole, two of which were withdrawn in the course of the opposition proceedings. The remaining oppositions by opponents I and III were based inter alia on Article 100(a) EPC in combination with Articles 52, 54 and 56 for lack of novelty and inventive step.

The Opposition Division held that the opposition ground of novelty prejudiced the maintenance of patent, while amendments of a sole auxiliary request added subject-matter, Article 123(2)EPC.

- II. In an annex to a summons to attend oral proceedings the Board drew attention to inter alia the issue of added subject-matter.

Oral proceedings before the Board were duly held on 12 June 2013.

- III. The Appellant-Proprietor requests that the decision under appeal be set aside and the patent be maintained on the basis of amended claims filed with the statement of grounds of appeal, or, alternatively, on the basis of claims of an auxiliary request 1 filing during the oral proceedings before the board.

Opponent I as respondent requests dismissal of the appeal.

The Appellant and the Respondent-Opponent I both request oral proceedings.

Opponent III as respondent has not made any requests or submissions.

IV. The wording of claim 1 of the requests is as follows:

Main Request

"A sawing apparatus of a forest machine, comprising a frame part (2) for fastening the sawing apparatus (1)
- a guide bar holder (3) for fastening of a guide bar (12) and arranged to rotate around a first rotation axis (A) with respect to the frame part (2) for turning the guide bar (12) during the sawing of a tree trunk,
- a drive gear (4) positioned on one end of the guide bar (12) and arranged to rotate around the first rotation axis (A) for driving a saw chain (6) around the guide bar (12) to perform the sawing, and
- a safety system comprising a protective wall (9) for receiving the saw chain (6) that has broken during the sawing,
characterized in that, for preventing the whipping movement of the broken saw chain:
- the protective wall (9) is fastened to the rotating guide bar holder (3) for
- maintaining the protective wall (9) positioned such that it is capable of receiving the broken saw chain as well as the tail of the broken saw chain, which tend to continue their movement in the direction of traction (B) past the drive gear (4), and
- guiding them to a desired direction,

- wherein the protective wall (9) is substantially perpendicular in relation to the plane on which the saw chain (6) moves during the sawing and which coincides with the guide bar (12),
- wherein the protective wall (9) is located in the vicinity of the drive gear (4), the protective wall (9) being within a distance from the drive gear (4) and having a curved shape curving in the same direction with the drive gear (4),
- wherein the protective wall (9) is dimensioned to extend across a sector area having an angle of 180° or less in relation to the first rotation axis (A), the angle starting from a point where the saw chain (6) meets the drive gear (4) and at which sector area the saw chain (6) bends around the drive gear (4), and
- wherein the inner side of the protective wall (9) is positioned to be hit by the broken saw chain continuing its movement in the direction of traction (B) between the drive gear (4) and the protective wall (9), the curved shape of the protective wall (9) guiding the broken saw chain to the side of the drive gear (4) that is opposite to the guide bar (12)."

Auxiliary Request

Claim 1 is as in the main request, but for the amendments to the opening lines of the claim and its last but one feature. The opening lines now read : "A sawing apparatus *fastened to a harvester head of a forest machine, with a saw assembly containing a shielding saw box*" (added text highlighted by the board). The last but one feature now reads (italics again indicate added text, strikethrough deleted text): "wherein the protective wall (9) is dimensioned to extend across a sector area having an angle of 90° to 180° ~~or less~~ in relation to the first rotation axis

(A), the angle starting from a point where the saw chain (6) meets the drive gear (4) and at which sector area the saw chain (6) bends around the drive gear (4), whereas this angle of 180° includes an extension at the first end of the protective wall (9) located on the side of the incoming saw chain (6), which extension comprises a wall part (10) curving away from the drive gear (4) and guiding the broken saw chain between the drive gear (4) and the protective wall (9)"

V. The Appellant argues as follows:

The basis in the original disclosure for the angle range of 180° or less in claim 1 of the main request lay mainly in the passage corresponding to paragraph [0016] of the patent specification, that the size of the safety device "can be kept as small as possible". The sector area is defined in specification paragraph [0021] as starting from the meeting point of the chain and gear. That same paragraph then states further on in lines 41 to 44 that the sector area can extend to cover an angle as wide as 180°.

The amendments to claim 1 of the auxiliary request 1 address the issues raised in the discussion at the oral proceedings. They add 90° as lower limit. The upper limit is defined in relation to the extension part and follows the wording of granted claim 8. The changes to the opening lines originate in specification paragraphs [0020] and [0006]- This request should therefore be admitted into the proceedings.

VI. The Respondent-Opponent I argues as follows:

Claim 1 of the main request adds subject-matter in that the added feature of the angle range does not include a

lower limit of 90° as originally disclosed , see specification paragraph [0021] and in that the upper value of 180° starts from the meeting point of chain and gear, rather than where the extension part starts as described in the original disclosure.

The auxiliary request 1 should not be admitted as it is filed at the latest possible stage and could have been filed already with the grounds. Moreover, there are still problems of added subject-matter. Specification paragraph [0006] cited as basis for the changes to the opening lines of claim 1 relate to the prior art, not the invention. Finally, as worded the angle subtended by the protective wall still starts from the meeting point of chain and gear, even if the protective wall includes an extension part.

Reasons for the Decision

1. The appeal is admissible.
2. *Background*

The patent concerns a sawing apparatus of a forest machine, as used in industrial tree harvesting, and which features a rotatably mounted chainsaw, with a chain guided about a guide bar under the action of a drive gear about which chainsaw can also rotate. The main idea is to use a safety system in the form of a protective wall fastened to the holder that holds the guide bar and which will therefore rotate with the saw. In the event of chain breakage this wall has the function of guiding the chain end in a controlled manner to prevent it whipping around (and causing damage or injury), specification paragraphs [009], [0010] and [0014].

3. *Main Request : Added subject-matter*

3.1 Claim 1 of the main request is based in first place on granted claim 5 directed to a sawing apparatus with the safety system. Amendments have been made to differentiate the claimed apparatus from that of prior art held to destroy novelty in the decision under appeal. Apart from structure and function, they specify in particular that the protective wall extends across a sector area angle of "180° or less starting from a point where the saw chain (6) meets the drive gear (4) and at which sector area the saw chain (6) bends around the drive gear (4)".

3.2 The only passage in the originally filed application that specifically mentions the value of 180° is the second paragraph of page 8 of the application as published which is identical to paragraph [0021] of the patent specification. The passage reads as follows:

"[The] wall 9 covers an area located at a point where the saw chain 6 is approaching the drive gear 4, meets said drive gear 4 and is curvedly positioned on top of the same. The wall 9 covers a sector area of approximately 90° to 100° starting from the meeting point, at which sector area the saw chain 6 bends around the drive gear 4. Together with the extension 10, the size of the sector area is approximately 110°. The aforementioned sector area is the most advantageous one, but it can be extended towards the upper side of the drive gear 4, wherein it covers an angle as wide as 180°. At the same time, however, the travel of sawdust is hindered."

The "meeting point" is that point "where the saw chain 6 meets the drive gear 4, see the immediately preceding sentence in the cited paragraph. "Extension" 10 refers to the part shown in figure 1 curving downwardly at and away from the lower end of the curved wall 9, see also in the bridging paragraph of pages 9 and 10 of the as filed description (specification paragraph [0023]), first sentence.

- 3.3 Though the above passage is not entirely unambiguous, what is unambiguously clear is that there is a "most advantageous" sector area or angle subtended by the protective wall, and that this most advantageous sector area can be extended "towards the upper side" i.e. *upwardly* to a value of 180° (penultimate sentence). In that case however "travel of sawdust" - taken to be out of the chain saw - is hindered (last sentence), so that this upper range of sector area values is less advantageous. The corollary of 180° as upper limit on an upward extension from the advantageous sector area angle is that the latter is a *lower* limit of a range of values. That range extends from the lower most advantageous value to increasingly less advantageous values up to 180° . This is the information that the skilled person derives clearly and unambiguously from the above passage disclosing the value of 180° .

The particular value of the lower limit, which is "afore-mentioned" in the sentence mentioning 180° , must follow from the preceding lines. It is thus either "approximately 90° to 100° " , mentioned several lines earlier as measured from the meeting point, or "approximately 110° " as stated in the sentence that immediately precedes it. There, however, it includes the extension part 10, which is positioned to the right of the meeting point in figure 1, and is thus measured

from a different point. The cited passage is ambiguous in this regard. It is thus unclear which of the two values is meant. In addition, it is unclear whether the value of 180° is to be measured from the meeting point, or, if the sentence in which it is mentioned refers to the immediately preceding one (the more likely reading), whether it is to include the extension part 10 to the right of that point.

- 3.4 The amendment mentioned in section 3.1 above has no clear basis in the application as filed.

Firstly, the requirement " 180° or less" sets no lower limit as compared to the original disclosure in the passage discussed above, which does. Vis-à-vis that original disclosure this amendment to claim 1 adds arrangements in which the protective wall has a sector area angle below the advantageous lower limit value of 90° from the meeting point or 110° with extension part.

Secondly, it states in an unambiguous and definitive manner that the value of 180° or less is to be measured from what corresponds to the *meeting point*. As noted above, the relevant passage is ambiguous in this regard. The more likely reading indeed points to the value including the *extension* part. This amendment adds information which has no clear and unambiguous basis in the original disclosure and thus extends beyond it.

- 3.5 There is no direct and unambiguous disclosure in the application documents of angles that are than less 90° or 110° , whatever the case may be, and that may even approach 0° . The Appellant cites lines 50 to 52 of the specification paragraph [0016], (identical to the paragraph bridging description pages 4 and 5 of the filed and published application), which states: "Thus,

its size [i.e. of the protective wall] can be kept as small as possible and .. covers a smaller sector-shaped area...". This sentence should be read in the broader context of paragraph [0016], which discusses the advantages of having the protective wall move along with the rotating guide bar. It is "always in the correct position" in relation to the saw chain and guide bar, the movement of which can be "rather wide". The implication is that the wall can be dimensioned to cover a smaller angle than if it also had to allow for that wide angle. Naturally, its angular extent must still be large enough for it to fulfil its primary function of preventing the whip-like movement of broken chain. "As small as possible" is to be understood in that limited context, and certainly does not offer a basis for angle values approaching 0° where clearly there would be no protective effect.

As to claim 9 (as filed and as granted) also cited by the Appellant, this defines an even narrower angular range with a lower limit of 100° and up to 120°. This does not provide any basis for the absence of any lower limit, let alone that the value of 180° should be measured from the meeting point.

3.6 The Board concludes that the amendments to claim 1 of the main request add subject-matter that extends beyond the original disclosure, contrary to the requirements of Article 123(2) EPC.

4. *Auxiliary Request 1 : Admissibility*

4.1 Auxiliary request 1 was first filed at the oral proceedings before the Board, well after filing of the grounds of appeal. The request thus amounts to an amendment to the appellant's case in the sense of

Article 13 of the Rules of Procedure of the Boards of Appeal. Under paragraph (1) of that article the Board has discretion in admitting such amendments. It shall exercise that discretion "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". Indeed any amendments that the parties cannot reasonably be expected to deal with without an adjournment should not be admitted, Article 13(4) RPBA.

An approach frequently adopted by the Boards when exercising their discretion in admitting amendments filed shortly before or in the course of oral proceedings can be summarized as follows: unless good reasons exist for filing amendments so far into the procedure - this may be the case when amendments are occasioned by developments during the proceedings -, they are only admitted at such a late stage if they are *clearly or obviously allowable*, see the Case Law of the Boards of Appeal, 5th edition, 2006, sections VII.D. 14.2.1 and 14.2.3 and the case law cited therein. This means that it must be immediately apparent to the Board, with little or no investigative effort on its part, that amendments successfully address the issues raised without giving rise to new ones, see for example T 0087/05, reasons 2.

- 4.2 The last but one feature of claim 1 of auxiliary request 1 is amended with respect to that of the main request by adding the value of 90° and specifying that the angle of 180° includes an extension at the first end of the protective wall. The claim however retains the wording that the angle of 90° to 180° starts from the *meeting point* of chain and gear. Not only do the amendments not address the second point mentioned in

section 3.4 above, in conjunction with the inclusion of the extension the claim now allows for an arrangement where the protective wall with extension starts from the meeting point. In reference to figure 1 of the patent this corresponds to a configuration in which the element 9 is rotated clockwise until the downwardly curved end of the extension 10 lies directly below the meeting point, i.e. on the dashed vertical line in the figure. There is no apparent basis in the original disclosure for such an embodiment.

- 4.3 Not only do the amendments to claim 1 of the auxiliary request fail to fully address the issue of added subject-matter noted in relation to claim 1 of the main request, they appear to give rise to further objection under that heading. The request is therefore not clearly allowable. For this reason the Board decided to use its discretion not to admit this request in the proceedings, pursuant to Article 13(1) RPBA.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

C. Heath

Decision electronically authenticated