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Datasheet for the decision of 18 September 2013

Case Number: T 0886/11 - 3.2.01

Application Number: 06425749.6

Publication Number: 1918179

IPC: B62D53/12

Language of the proceedings: EN

Title of invention:
A device for coupling a semi-trailer to a tractor

Patent Proprietor:
V. Orlandi - Societa' per Azioni

Opponent:
Jost-Werke GmbH

Headword:

Relevant legal provisions:
EPC 1973 Art. 100(c), 54(1), 56, 111(1), 104(1)
RPBA Art. 13(1)

Keyword:
Amendments - added subject-matter (no)
Novelty - (yes)
Admissibility of new arguments on inventive step - (yes)
Inventive step - (yes)
Admissibility of new document filed with statement of grounds of appeal - (yes)
Remittal to the department of first instance - (yes)
Apportionment of costs - (no)

Decisions cited:
T 0006/80, T 0795/92, T 0113/96, T 1171/97, T 0507/03, T 0992/10

Catchword:

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Case Number: T 0886/11 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 18 September 2013

Appellant: (Opponent)	Jost-Werke GmbH Siemensstrasse 2 D-63263 Neu-Isenburg (DE)
Representative:	Mehler Achler Patentanwälte Bahnhofstraße 67 65185 Wiesbaden (DE)
Respondent: (Patent Proprietor)	V. Orlandi - Societa' per Azioni Via Quinzano, 3 25020 Flero (BS) (IT)
Representative:	Tansini, Elio Fabrizio Bugnion S.p.A. Viale Lancetti 17 20158 Milano (IT)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 14 February 2011 rejecting the opposition filed against European patent No. 1918179 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman: G. Pricolo
Members: W. Marx
P. Guntz

Summary of Facts and Submissions

I. On 14 April 2011 the appellant (opponent) lodged an appeal against the decision of the opposition division, posted on 14 February 2011 and rejecting the opposition against European patent No. 1 918 179, and paid the appeal fee. The statement setting out the grounds of appeal was received on 20 June 2011.

II. In its decision the opposition division held that the subject-matter of claim 1 as granted did not extend beyond the content of the application as filed and was new and inventive over, inter alia, the following prior art:

D1: WO 2008/009659 – prior art under Art. 54(3) EPC;

D2: EP 0 084 712.

Together with its statement setting out the grounds of appeal the appellant filed the following document:

D5: US 2,092,115.

III. In the oral proceedings before the board, held on 18 September 2013, the appellant requested that the decision under appeal be set aside and that the European patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed and, as an auxiliary request, that the case be remitted to the opposition division along with a decision on apportionment of costs. As further auxiliary requests the respondent requested that the decision be set aside and the patent be maintained in amended form on the basis of one of the first to eighth Auxiliary Requests filed on 1 December 2010 or any combination thereof or the ninth Auxiliary Request as filed on 21 December 2011.

At the end of the oral proceedings, the chairman announced the board's decision that the decision under appeal is set aside, the case remitted to the department of first instance for further prosecution and the request for apportionment of costs rejected.

IV. Claim 1 as granted according to the main request reads as follows (the numbering of the features in **bold** was added by the board and corresponds to the numbering used in the contested decision):

(1) A device for coupling a semi-trailer to a tractor, comprising:
(2) a knuckle pin or kingpin (2) having an anchoring portion (3) to be fixed to a chassis (3a) of a semi-trailer and a head (8) projecting downwards relative to a rest plane (P) of the semi-trailer, and suitable for operative engagement by a fifth wheel (FW) carried by a tractor;
(3) a coupling member (13)
(3.1) rotatably engaged around a geometric axis (X) of the kingpin (2) and
(3.2) carrying connecting terminals (16a, 16b) each connectable to a feeding line (17a, 17b) coming from the tractor;
(4) distribution lines (15a, 15b) each extending from one of the connecting terminals (16a, 16b) and each connectable with a user device carried by the semi-trailer;
characterised in that:
(5) each of said distribution lines (15a, 15b) has
(5.1) a proximal length (18a, 18b) extending from the respective connecting terminal (16a, 16b) towards the kingpin (2),
(5.1.1) the proximal length (18a, 18b) of each distribution line (15a, 15b) being housed in a

longitudinal portion (21) of the coupling member (13), radially extending relative to the kingpin (2),
(5.2) an intermediate length (20a, 20b) rising up on the continuation of the proximal length (18a, 18b) to pass through the rest plane (P) of the semi-trailer on the fifth wheel (FW),
(5.2.1) the intermediate length (20a, 20b) of the distribution lines (15a, 15b) being disposed close to the kingpin (2), and
(5.3) a distal length (19a, 19b) connectable to said user device and extending in the continuation of the intermediate length (20a, 20b) away from the kingpin (2).

V. The appellant argued essentially as follows:

Feature 5.1.1 relating to the proximal length, which was introduced during examination, was not supported by the application as originally filed because the last part of the passage in the description forming the basis for said amendment (see page 10, lines 7 to 11) was not included in claim 1, which reads "between the supporting base 6 and the kingpin itself". Moreover, the first part of the corresponding sentence in the description relating to the distal length (page 10, lines 4 ff.: "Consequently, the distal length 19a, 19b is housed ... between said rest plane P and the anchoring plate 6") was also omitted. Since there was a functional relationship between all portions of the distribution lines, i.e. the arrangement of the proximal length also determined the arrangement of the intermediate and the distal length, the arrangement of the distal length according to the description should have been included in feature 5.3.

As to the erroneous term "supporting base 6" in the

passage mentioned above, either the reference sign "6" was a typing error and had to be replaced by "13a", or the term "supporting base" should read "anchoring plate" (as mentioned in the first part of the corresponding sentence on page 10, lines 4 ff.). The criterion for correction of errors required that the error as well as its correction must be immediately evident. In first-instance proceedings, the respondent initially used the terms "supporting base 6" and "anchoring plate 6" synonymously, and only later indicated that "13a" was the correct reference sign to be used instead of "6", i.e. it was immediately evident only that "supporting base 6" meant "anchoring plate 6". Moreover, on an objective view, since the term "anchoring plate 6" was mentioned in the first part of the corresponding sentence of the description as originally filed, it was obvious that also in the last part of the sentence the "anchoring plate 6" was meant, especially since the horizontally arranged anchoring plate together with the vertical kingpin defined a space for "housing" the proximal length of the distribution lines. Such reference to the "housing" of the distribution lines, necessary for protecting the lines, required that also the first part of this sentence had to be included in claim 1 (in feature 5.3). According to decision T 795/92, the requirements of Article 123(2) EPC precluded allowing an amendment if there was any doubt as to whether or not it was derivable from the original application.

Replacing, in the term under discussion, reference sign "6" by "13a" defined a radial extension (not a space) for the proximal length of the distribution lines between the supporting base and the kingpin. Said feature was not implicitly included in features 3, 3.2, 4 and 5.1 which described the coupling member carrying

connecting terminals and distribution lines each extending from one of the connecting terminals and having a proximal length extending from the connecting terminals towards the kingpin. It was not derivable from said features that the connecting terminals were disposed at a "supporting base", in particular since claim 1 did not define the mounting of the connecting terminals. Claim 1 as originally filed was silent on whether a supporting base was present at all. The description as originally filed, however, referred to the supporting base as the starting point of the distribution lines. Therefore, the last part of the sentence on page 10, line 11 had to be included in order to overcome the objection under Article 123(2) EPC.

Document D1 showed the features of the preamble of claim 1 and also features 5 and 5.1, as noted in the contested decision. However, further features were known from D1. The connector 5 depicted in Figure 1 of D1, pointing radially outwards, represented a longitudinal housing, and the proximal length of the distribution lines was housed in the connector and extended relative to the kingpin as required by feature 5.1.1. Figure 2 showed distribution lines having a distal length 6a, 6b extending away from the kingpin according to feature 5.3. An intermediate length according to features 5.2 and 5.2.1 was required in order to connect the proximal length and the distal length, i.e. was implicitly disclosed, so that D1 showed all the features of claim 1.

Document D2 showed features 1 to 4 according to the preamble of claim 1 and also distribution lines 8 comprising an intermediate length and a distal length according to features 5.2, 5.2.1 and 5.3. As regards

feature 2, it did not exclude the kingpin "fixed to a chassis" being rotatably fixed to the chassis, i.e. indirectly fixed to the chassis via a rotatable plate as shown in D2. Moreover, the expression "close to the kingpin" in feature 5.2.1 did not indicate any dimension. The "proximal length" as defined by feature 5.1 did not require a direct connection to the connecting terminal. In D2, although not illustrated in Figure 6, the proximal length extending from abutting joints 7 was guided within engagement member 6. However, the distribution lines which extended from abutting joints 7 away from the kingpin had to be provided with a loop before leaving the housing in the upper part as service lines 8, as recognised by the skilled person and also supported by the large size of the engagement member 6 which extended further in a radial direction outwards compared to the outlet of service lines 8. In particular, the person skilled in the art knew that a minimum radius of curvature was required for cables or pneumatic lines (mentioned in D2 on page 6, line 22) depending on their diameter. Based on the proportions of kingpin and harness as represented in Figure 6 in D2, including the radius of curvature of the harness and the arrangement of abutting joints 7 and exit of the harness out of housing 6, the skilled person knew that a loop within housing 6 was mandatory. As a consequence, features 5.1 and 5.1.1 were implicitly disclosed in D2. The board in decision T 6/80 had found that, where a further functional attribute of an element of a device disclosed in a document was immediately apparent to a person skilled in the art reading the document, such attribute formed part of the state of the art with regard to that device. According to established case law, a prior-art document anticipated the novelty of claimed subject-matter if the latter was directly and

unambiguously derivable from that document, including any features implicit to a person skilled in the art.

An inventive-step objection was maintained solely on the basis of a combination of document D2 with the knowledge of the skilled person. The statement setting out the grounds of appeal, in particular when dealing with novelty over D2, dealt with the ratio decidendi and what the skilled person - in view of his expertise - would implicitly understand when reading D2, and addressed already the knowledge of the skilled person. Moreover, the new inventive-step argumentation with regard to D2 only required discussion of feature 5.1, i.e. the new subject-matter was not complex in the sense of Article 13(1) RPBA.

D2 showed a longitudinal housing ("engagement member 6") representing the coupling member that housed the distribution lines and guided them upwards close to the kingpin according to feature 5.2.1. It was contested that feature 5.1 was known from D2. But as discussed already with respect to novelty, the subject-matter of claim 1 was obvious for the skilled person because he would understand feature 5.1 when studying document D2. The person skilled in the art - a mechanical engineer working in the field of vehicle construction and coupling devices - knew the relevant standards and problems in terms of safety (see also contested patent, para. [0012]) and would consider the problems associated with back pressure in distribution lines which were designed as pressure lines or air lines as described in D2. He would provide loops within the distribution lines in D2 and, in this way, additional radial portions within the distribution lines. There was no mention in D2 that the engagement member 6 was a solid block. However, problems with back pressure

existed also in solid blocks, and the skilled person would provide a large radius of curvature for distribution lines (such as brake lines) to avoid any time delay which would compromise safety, and he would thereby realise feature 5.1.

Document D5 had been filed only with the statement of grounds of appeal because the contested decision made clear that the feature "proximal length" of the distribution lines, in particular the extension of the proximal length towards the kingpin according to feature 5.1, played a crucial role. An additional search had been conducted with respect to the connecting situation of the distribution lines in D2 in order to prove the knowledge of the skilled person that, when distribution lines were extending from connecting terminals away from the kingpin and leading upwards to the trailer close to the kingpin as known from document D2, the distribution lines had to extend in a direction towards the kingpin again. During this search document D5 had been found, showing a connector as known from D2, which was directed towards the kingpin, and a proximal length of distribution lines extending towards the kingpin. Moreover, in first-instance proceedings inventive step starting from D2 as closest prior art had been discussed in detail only during oral proceedings.

D5 was also prima facie highly relevant because it showed distribution lines having three portions as claimed (see Figures 2 and 2a: proximal length 9, intermediate length 10, distal length 11) and also feature 5.1. D5 should therefore be admitted into the proceedings. The feature "intermediate length of the distribution lines being disposed close to the kingpin"

comprised also distribution lines disposed within the kingpin or at least in the upper part of the kingpin.

Remittal of the case to the department of first instance was considered appropriate. However, according to established case law such remittal did not justify in itself a disproportionate cost burden. A different apportionment of costs was not justified because an additional search had been caused by the decision of the department of first instance.

VI. The respondent's arguments relevant to the present decision can be summarised as follows:

The skilled reader would immediately realise that an error existed in line 11 on page 10 of the description as originally filed with regard to the term "supporting base 6", because the term "supporting base" was used throughout the description to identify element 13a in the drawings, while the expression "anchoring plate" was used to identify element 6. The two terms were not used by the respondent synonymously but only when reasoning following the opponent's interpretation. The fact that the "anchoring plate 6" was mentioned in the first part of the sentence on page 10, lines 7 to 11, did not suggest or imply that also the wording "supporting base 6" in the second part of the sentence should read "anchoring plate 6". The use of two different expressions clearly meant that different features were referred to, and the expression "supporting base" consistently identified the supporting base 13a carrying the connecting terminals 16a, 16b. Thus, the skilled reader would not rely on the upper limit in space provided by the anchoring plate 6 and the lateral limit provided by the kingpin to identify a vertical plane in which the proximal

portion of the distribution lines had to be arranged. Moreover, it would not make sense for the proximal length to extend between the anchoring portion and the kingpin.

As established by the opposition division, the only restriction implied by "the proximal length extending between the supporting base and the kingpin" was that at least a portion of the distribution lines extended at least partly therebetween, which was implied by features 5.1 and 5.1.1. Moreover, the omitted features referred to features belonging to the longitudinal portion 21 of coupling member 13, not to the proximal length of the distribution lines, and expressed the fact that the longitudinal portion extended at least partly between the supporting base and the kingpin. Since claim 1 (see features 3 and 3.2) recited the connecting terminals carried by the coupling member, which was also expressed in the description as originally filed (col. 6, lines 4 to 7 of the patent specification), a "supporting base" was implicitly present to support the connecting terminals. The omitted feature "between the supporting base and the kingpin" expressed nothing more and therefore provided no further restriction of the claimed subject-matter.

The introduction of feature 5.1.1 in claim 1 did not require introduction of the first part of the sentence on page 10 relating to "... the distal length 19a, 19b is housed within the semi-trailer ..." because it did not affect the housing of the proximal length 18, 18b in a longitudinal portion of the coupling member. Features belonging to the proximal length were clearly unrelated to the distal length. Moreover, nowhere in the description was the distal length being housed

within the semi-trailer identified as being essential or necessary for achieving the invention.

Document D1 provided no hint concerning how distribution lines were guided through the connector bracket 5 and did not show connecting terminals. Only line section 6 was shown in Figure 1, and as mentioned in D1 on page 8 (see second paragraph), this line section 6 was led out from the connector bracket 5 at the side away from the kingpin. This suggested exactly the opposite of a proximal length as claimed by feature 5.1. Moreover, D1 was silent about the shape of the connector bracket 5, and it was not possible to derive unambiguously from the drawings a longitudinal portion as required by feature 5.1.1. Since D1 failed to provide teaching about any proximal length, no teaching about an intermediate length was derivable either.

Feature 2 according to claim 1 required a fixed kingpin and a rotatable plate. However, the embodiment of Figure 6 in D2 showed a kingpin 5 attached to a rotatably mounted disk plate 4. An intermediate length and a distal length of the distribution lines could be identified in D2, but no proximal length at all extending towards the kingpin as required by feature 5.1. The connecting terminals of the coupling member in D2 were facing towards the kingpin (see Figure 7), so that the proximal length of the distribution lines did not run towards the kingpin (see Figure 6). Indeed, distribution lines radially extending from the connecting terminals 7 in D2 and folded back on themselves within the engagement member 6 were not necessarily required, because different technical measures, such as a 90° connecting joint carried by the connecting terminals 7 within the engagement member,

could be provided instead. In particular, it was known that hydraulic lines could be realised by angular sections, e.g. by providing a hydraulic block with hydraulic channels realised by borings. Moreover, D2 was also lacking any suggestion directed to an intermediate length of the distribution lines disposed close to the kingpin. According to the definition given in claim 1, the intermediate length was situated between the connecting terminals and the kingpin.

In its interlocutory decision, the opposition division had decided, inter alia, that the subject-matter of granted claim 1 was based on an inventive step with respect to a combination of documents D3 and D4 and a combination of document D2 with the skilled person's common general knowledge. Any discussion of inventive step had been omitted by the appellant in its statement setting out the grounds of appeal, which however had to contain its complete case (see Article 108 EPC and Article 12(2) RPBA). All arguments filed afterwards regarding inventive step were new and should have been brought forward already in the statement of grounds of appeal. All arguments with respect to inventive step should be rejected as being late-filed. Inventive step had been addressed by the appellant only in its last submission.

The subject-matter of document D2 already differed from claim 1 by virtue of feature 5.1, because the distribution lines in D2 extended from the connecting terminals in a direction away from the kingpin. There were many possibilities to arrange the distribution lines in D2, so that the skilled person had no reason to arrange the distribution lines as defined in granted claim 1. Taking into account the coupling between tractor and semi-trailer according to D2 (page 6, lines

7 to 9: "engagement member 6 from which extend service lines 8"; page 6, lines 25 ff.: "provide the abutting joints 7 with a predetermined amount of resilience"), engagement member 6 was formed as a solid block. In this respect, hydraulic blocks were often used with angularly arranged distribution lines. Moreover, in order to meet high safety standards, distribution lines should be as short as possible and advantageously not realised by loose pipes. Any curved routing of distribution lines would increase line length and also flow resistance. Moreover, more space would be required, so that there was no reason for the skilled person to provide bending radii.

As regards late-filed document D5, there was only one passage in the contested decision dealing with the "proximal length" and it had not been considered essential in the decision. Moreover, the disclosure of D5 did not go beyond the disclosure of the documents filed together with the opposition. In particular, it did not anticipate all features of granted claim 1, so it could not be assumed to be prima facie relevant. D5 disclosed a solution in which the kingpin – integrally connected to the coupling member - was pivotable with respect to the trailer and the intermediate length of the distribution lines was provided within the kingpin, contrary to granted claim 1 which clearly defined that the kingpin was fixed to the trailer and the coupling member was rotatably engaged around a geometrical axis of the kingpin (features 2 and 3.1). Therefore, D5 had to be rejected as late-filed.

With respect to the request for remittal, the parties had the right to a full examination by two instances. The request for a decision on apportionment of costs in favour of the respondent was justified because document

D5 could have been found in the first-instance proceedings, in particular since the appellant had already filed a new document at a later stage in opposition proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. *Allowability of the amendments in claim 1 as granted (Art. 100(c) EPC 1973)*

Feature 5.1.1 was introduced in the examination phase on the basis of the following passage of the description as originally filed (see page 10, lines 7 to 11; in the following referred to as "passage **A**"):
(A) "... while the proximal length 18a, 18b of each distribution line 15a, 15b is housed in a longitudinal portion 21 of the coupling member 13, radially extending relative to the kingpin 2 **between the supporting base 6 and the kingpin itself**. ..."

It is acknowledged that passage **A** contains the erroneous term "supporting base 6". Since the supporting base is characterised by reference sign "13a" in other passages of the description, whereas reference sign "6" normally denotes the anchoring plate, the term should either read "supporting base 13a" or "anchoring plate 6". When looking at Figure 1 and reading features 3, 3.1, 3.2 and 5.1 ("a coupling member (13) rotatably engaged around a geometric axis (X) of the kingpin (2) and carrying connecting terminals (16a, 16b)..., a proximal length (18a, 18b)

extending from the respective connecting terminal (16a, 16b) towards the kingpin (2)"), the connecting terminals are associated with the rotatable coupling member which is situated below the rest plane P (see Figure 1) of the semi-trailer, whereas the anchoring plate 6 is fixed to the chassis of the semitrailer in a plane above the connecting terminals and above the rest plane P. Moreover, passage **A** clearly relates to the **radial extension of the longitudinal portion of coupling member** 13 (housing the proximal length 18a, 18b) relative to the kingpin between two endpoints ("kingpin", "supporting base 6"), which indicates an extending direction already ruling out the "anchoring plate 6" which is situated above the longitudinal portion. Also Figure 1 clearly shows that the longitudinal portion of the coupling member, carrying the supporting base 13a (and not the anchoring plate 6), is situated in the area below the rest plane P. By simply replacing the reference sign "6" by "13a" a radial extension for the proximal length would be defined, as conceded by the appellant. Therefore, the board is of the opinion that it is immediately evident to the skilled reader that the correct expression can only read "supporting base 13a". Decision T 795/92 cited by the appellant, dealing with amendments under Article 123(2) EPC, is not applicable in the given context which relates to the correction of obvious errors within the meaning of Rule 139 EPC (former Rule 88 EPC 1973). The fact that the "anchoring plate 6" is mentioned in the first part of the sentence preceding passage **A** is irrelevant because this part of the sentence refers to a different space situated between the rest plane P and the anchoring plate 6, i.e. the area above the rest plane P, which houses the distal length of the distribution lines and not their proximal length.

When correctly reading the passage on page 10, lines 4 to 11, as argued in the preceding paragraph, it becomes apparent that it does not define a single space or "housing" defined by the anchoring plate and the kingpin. The rest plane P of the semi-trailer separates a space above the rest plane housing the distal length of the distribution lines from the space below housing the proximal length, i.e. two structurally separate areas are specified which can be defined separately from each other in more detail. This is emphasised by the term "while" used in the respective sentence on page 10 of the description as originally filed, which distinguishes the two parts of this sentence from each other and makes clear that they are not directly related. Moreover, the only structural feature directly related to the proximal length and determining the arrangement of the proximal length is the adjacent portion of the distribution lines, i.e. the intermediate length which is already specified in claim 1 by feature 5.2. It is true that the portions of the distribution lines are functionally related to each other; however, such functional relationship is already adequately considered by features 5.1, 5.2 and 5.3 defining a proximal length, an intermediate length and a distal length. Therefore, the board finds that it is not necessary to include in feature 5.3 the first part of the sentence preceding passage **A**, relating to the arrangement of the distal length, when introducing feature 5.1.1 (relating to the proximal length) into claim 1 as originally filed.

With regard to the term "between the supporting base and the kingpin itself", which was omitted from the corresponding passage in the description (page 10, lines 7 to 11) when introducing feature 5.1.1 into

claim 1, the board finds that omission of this feature does not extend the subject-matter claimed. Incorporating this term into feature 5.1.1 would describe the two endpoints of a line along which the longitudinal portion of the coupling member (which houses the proximal length of the distribution lines) extends. Since features 5.1.1 ("longitudinal portion of the coupling member radially extending ... towards the kingpin") already specifies the kingpin as one endpoint of extension, it remains to be discussed whether definition of the supporting base as second endpoint is required. As defined already by features 3 and 3.2, the coupling member is carrying the connecting terminals, which – contrary to the appellant's opinion - describes the mounting of the connecting terminals to the coupling member. This also means that the coupling member comprises some portion which "carries" or, in other words, "supports" these terminals and therefore represents a "support" or "supporting portion". The expression "supporting base" does not define anything more, except perhaps for indicating (due to the term "base") the point of attachment for the distribution lines. However, features 4 and 5.1 already indicate that the distribution lines - in particular the proximal length - extend from the connecting terminals which therefore represent the attachment points at the coupling member, in particular at the longitudinal portion thereof housing the proximal length. Therefore, a longitudinal portion of the coupling member between a supporting base and the kingpin itself is already implied by features 3, 3.2, 4 and 5.1 of claim 1, and omission of the term "between the supporting base and the kingpin itself" does not amount to an intermediate generalisation.

In view of the above, the board finds that the subject-matter of the patent in suit does not extend beyond the content of the application as filed. Hence, the ground for opposition raised under Article 100(c) EPC 1973 does not prejudice the maintenance of the European patent.

3. *Main request (patent as granted) – novelty over D1, D2 (Article 54(1) EPC 1973)*

Documents D1 and D2 provide no clear disclosure as to how the distribution lines are guided from the connecting terminals onwards as required by feature 5.1.

The figures of D1 give no details about this. D1 even mentions on page 8 (see second paragraph) that a line section 6 is led out from the connector bracket 5 at the side away from the kingpin, which means that the distribution lines are extending in a direction opposite to what is defined by feature 5.1.

D2 shows (see Figure 6) an engagement member 6 provided with abutting joints 7 from which service lines 8 extend in the upper part. However, no details are given on how the lines are guided within engagement member 6. As conceded by the appellant, the distribution lines first have to extend from the abutting joints 7 away from the kingpin, but the board is not convinced that it is implicit for the skilled person that a loop has to be provided in the distribution lines guided within the engagement member before leaving the engagement member in the upper part. In particular, angular sections might be provided, such as a 90° connecting joint, which are commonly known for hydraulic lines that are explicitly mentioned in D2 (see page 6,

line 22). As to decision T 6/80 cited by the appellant, feature 5.1 relates to the routing of distribution lines, which specifies a structural feature of the claimed device but does not represent a functional attribute as mentioned in T 6/80.

Since already feature 5.1 of claim 1 is not directly and unambiguously derivable from documents D1 or D2 and also not implicitly disclosed in these documents, the subject-matter of claim 1 according to the main request is new over the cited prior art (Article 54(1) EPC 1973).

4. *Main request (patent as granted) - inventive step*

4.1 Admissibility of new arguments on inventive step (Article 13(1) RPBA)

The contested decision deals with the issue of inventive step with regard to, inter alia, D2. In its statement setting out the grounds of appeal the appellant only argued lack of novelty over D2. However, the assessment of novelty hinged on the question whether the skilled person would implicitly understand features 5.1 and 5.1.1 when studying document D2. The arguments based on D2 are considered – although not convincing the board with respect to novelty – as implicitly also directly relating to an objection of lack of inventive step. Therefore, the board exercised its discretion under Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2007, 536) and admitted the amendment of the appellant's case to make specific arguments on inventive step in relation to D2 in the light of the board's finding on novelty (cf. decision T 992/10, points 4.1 to 4.3 of the reasons).

4.2 Inventive step (Article 56 EPC 1973)

When starting from document D2, which according to the appellant represented the closest prior art, the subject-matter of claim 1 is distinguished from the prior art disclosed in D2 at least by feature 5.1. According to feature 5.1, a proximal length of the distribution lines extends from the respective connecting terminals towards the kingpin, which describes the concrete routing of the distribution lines extending from the connecting terminals.

The objective technical problem underlying this distinguishing feature can be regarded as to suitably guide the distribution lines within the engagement member 6 in D2 which is not further specified there.

It might be argued that an obvious possibility is to have the distribution lines in D2 extend from the connecting terminals, represented by the abutting joints 7, first in a direction away from the kingpin. However, the board is not convinced by the appellant's argument that the skilled person would provide a loop within the distribution lines guided within the engagement member 6 of D2. There is no mention at all in D2 about whether the engagement member is formed as a solid block, which might contain borings, e.g. angled at 90°, to connect the abutting joints 7 with the outgoing service lines 8, or whether the engagement member represents a case housing flexible distribution lines which might be provided with a bending radius. Moreover, the problem of possible back pressure when not providing a large radius of curvature in distribution lines, as addressed by the appellant, contrasts to the problem of increased flow resistance

when increasing line length, as addressed by the respondent.

Therefore, in the absence of any hint to the solution according to feature 5.1, the board concludes that it was not obvious for the skilled person to arrange the proximal length of the distribution lines in engagement member 6 in D2 as required by feature 5.1, i.e. extending from the connecting terminals towards the kingpin. The subject-matter according to claim 1 therefore involves an inventive step when considering D2 on its own (Article 56 EPC 1973).

5. *Admission of new document D5 into the appeal proceedings*

Document D5 was only filed with the statement setting out the grounds of appeal. As argued by the appellant, the contested decision made clear that feature 5.1 played a crucial role when assessing novelty and inventive step over D2. The term "proximal length" might appear only once in this context in the contested decision, but, as to the substance, the contested decision - with regard to both novelty and inventive step over D2 (see pages 7 and 8 of the decision) - dealt with the question whether the distribution lines were "guided radially outward and then double back on themselves", which describes in other words what is claimed by feature 5.1. Moreover, the department of first instance in its summons to oral proceedings with regard to document D2 only addressed the issue of novelty, i.e. the discussion of inventive step starting from D2 as closest prior art only took place during oral proceedings before the first instance.

Therefore document D5, filed with the statement setting out the grounds of appeal, can be considered as a reaction to the finding in the contested decision that document D2 does not provide any hint as to the arrangement of the distribution lines within the connector member, in particular that the proximal length extended towards the kingpin.

Under these circumstances, the board decided not to make use of its power under Article 12(4) RPBA to decline to admit document D5 into the appeal proceedings.

6. *Remittal of the case to the department of first instance (Article 111(1) EPC 1973)*

Document D5, which for the reasons given above is to be taken into account by the board, explicitly shows distribution lines in the area below the rest plane having a portion extending in a direction towards the kingpin. Introduction of this new document gives rise to a substantially new situation as regards the assessment of inventive step. Moreover, the respondent and - when asked by the chairman of the board – also the appellant requested remittal to the department of first instance. Therefore, the board considers it appropriate to remit the case to the first instance for further prosecution in accordance with Article 111(1) EPC 1973, so as to give the parties the possibility to argue their case before two instances.

7. *Apportionment of costs (Article 104(1) EPC 1973)*

The respondent's request for a different apportionment of costs relates to the additional costs it incurred because the appellant filed document D5 only with the

statement of grounds of appeal, when allegedly it could have been found in the first-instance proceedings, in particular since the respondent had already filed another new document at a later stage in opposition proceedings.

As already stated above, the filing of document D5 together with the grounds of appeal was considered as a reaction to the reasons given in the impugned decision. According to Article 108 and Rule 65 EPC, the statement of grounds of appeal should identify the extent to which amendment or cancellation of the decision is requested. This however does not forbid a losing opponent to file new pieces of prior art if it is felt that they could counter the reasons given in the appealed decision (see T 507/03, not published in OJ EPO, point 10.1 of the reasons; also T 1171/97, not published in OJ EPO, point 8 of the reasons). Such filing of a new document for reinforcing the line of attack already made before the first instance has to be considered as the normal behaviour of a losing party and does not constitute an abuse of procedure, in particular if the filing of the document is made at the earliest possible moment in appeal proceedings (see T 113/96, not published in OJ EPO, point 11 of the reasons).

Therefore, the respondent’s request for apportionment of costs is refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution.

3. The request for apportionment of costs is rejected.

The Registrar: The Chairman:

A. Vottner G. Pricolo

Decision electronically authenticated