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**Datasheet for the decision
of 5 March 2015**

Case Number: T 0887/11 - 3.2.06

Application Number: 06112898.9

Publication Number: 1847436

IPC: B62B3/06

Language of the proceedings: EN

Title of invention:

Pallet truck

Patent Proprietor:

Toyota Industries Sweden AB

Opponent:

Jungheinrich Aktiengesellschaft

Headword:

Relevant legal provisions:

EPC Art. 84, 123(2), 56, 111(1), 114(2)

RPBA Art. 13(1)

Keyword:

Claims - clarity - main request (no)
Late-filed auxiliary requests - auxiliary request 1 and 2 -
clearly allowable (no)
Amendments - deletion of feature - auxiliary request 3A (yes)
Exception to the prohibition of refomatio in peius -
auxiliary request 3A (yes)
Late submitted material - evidence admitted (yes)
Appeal decision -
remittal to the department of first instance (yes)

Decisions cited:

G 0001/99, T 1002/92

Catchword:



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Chambres de recours**

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Case Number: T 0887/11 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 5 March 2015

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Respondent: Toyota Industries Sweden AB
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
17 February 2011 concerning maintenance of the
European Patent No. 1847436 in amended form.**

Composition of the Board:

Chairman M. Harrison
Members: T. Rosenblatt
W. Ungler

Summary of Facts and Submissions

- I. European patent No. 1 847 436 is based on European patent application No. 06112898.9 which was filed on 21 April 2006.

- II. An opposition was filed against the patent. Together with its reply, dated 25 February 2010, to the notice of opposition the patent proprietor submitted amended claims as its main request, in which besides the amendment of independent claim 1 by combining granted claims 1 to 3, further dependent claims were introduced based on features taken from the description. The parties were summoned to oral proceedings before the opposition division to take place on 25 January 2011. With a letter of 23 December 2010 the respondent then submitted an amended main request, the amendment being based on features taken from the description. Two auxiliary requests were also filed, each including a claim 1 comprising amendments relying on features derived from the description and on the previously newly-introduced dependent claims. These submissions of the proprietor were notified to the opponent by the communication of the opposition division dated 29 December 2010. The oral proceedings took place on the date appointed in the summons.

- III. In its interlocutory decision dated 17 February 2011 the opposition division found that European patent No. 1 847 436 in an amended form according to a first auxiliary request (filed first during the oral proceedings before the opposition division) met the requirements of the EPC.

IV. The appellant (opponent) filed an appeal against this decision and relied on the following documents and evidence:

E2: DE 1 969 914 U,

E5: EP-A-0 338 254,

E6: six pages relating to "MPW-E MPE-E Walkie/Rider Pallet Trucks, Yale Materials Handling Corporation";

E7: patent search results conducted by a department of the University Dresden in 2009;

E8: photography of the steering assembly of a Yale pallet truck;

E9: seven pages entitled "Roadshow Yale Warehouse Products".

Also, witness testimony by a Mr. Lohmann was offered.

V. The respondent (proprietor) requested dismissal of the appeal.

VI. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), the Board informed the parties of its preliminary opinion on the case. It stated *inter alia* that the admittance of documents E6 to E9 into the proceedings could require discussion and that this in turn might require the hearing of the witness offered by the appellant. However, the Board noted that the witness had been identified only by name but without any details of his address or position, let alone information given as to the way in which the witness allegedly gained access to, or knowledge of, the alleged facts. It was also stated that if the Board nevertheless decided to admit the evidence, remittal of the case to the opposition division would then appear appropriate.

- VII. The appellant replied to the Board's communication by providing further information on the witness and stated the issues on which the witness should be heard.
- VIII. With its letter of 5 February 2015 the respondent also replied to the Board's preliminary opinion and submitted auxiliary requests 1 to 5.
- IX. Oral proceedings were held before the Board of Appeal on 5 March 2015.
- X. The appellant requested that the decision under appeal be set aside and the patent be revoked. Furthermore it requested that Mr. Lohmann be heard as a witness.
- XI. The respondent requested that the appeal be dismissed, or that the decision under appeal be set aside and the patent be maintained in amended form on the basis of one of the auxiliary requests 1, 2, 4 or 5 as filed with letter dated 5 February 2015, or on the basis of auxiliary request 3A as filed during the oral proceedings of 5 March 2015.
- XII. Claim 1 of the appellant's main request, i.e. the request considered allowable by the opposition division, reads:

"Pallet truck (2), comprising:

- a chassis (4),
- a drive motor (3) and a gear box (5) arranged in the chassis (4) of the pallet truck (2),
- a drive wheel (7), wherein the drive motor (3) is arranged to transmit power to the drive wheel (7) via the gear box (5) for driving of the pallet truck (2),
- a tiller arm (6) to be manoeuvred by hand by an operator for adjusting the direction of travel of the

pallet truck (2),
wherein the drive motor (3) is fixedly arranged in the chassis (4), the gear box (5) and the drive wheel (7) are interconnected and pivotally arranged in the chassis (4), and the tiller arm (6) is connected to the gear box (5) in such a way that the gear box (5) and the drive wheel (7) together are pivoted when the operator manoeuvres the tiller arm (6),
wherein the tiller arm (6) is attached to the gear box (5) via a tiller arm bracket (21), which is mounted to the gear box (5), and the drive motor (3) is arranged on top of the gear box (5), **characterized in that** the tiller arm bracket (21) comprises a first portion (25) which extends upwards along the side of the drive motor (3), a plurality of conceivable fastening points for the tiller arm being hereby achieved along the first portion, wherein the tiller arm bracket (21) comprises a second portion (27) which is connected to the first portion (25) and which extends radially inwards on top of the drive motor (3), an attachment point for the tiller arm being hereby achieved which facilitates casing of the drive motor and the gearbox."

XIII. In claim 1 of the **first auxiliary request**, the feature

"a plurality of conceivable fastening points for the tiller arm being hereby achieved along the first portion", in the following referred to as the "fastening points feature", has been deleted.

In claim 1 of the **second auxiliary request**, in addition to the deletion of the fastening points feature, the following feature has been added at the end of the claim:

"wherein the first portion (25) is radially separated from the drive motor (3) to avoid interference with the drive motor (3) when the gear box (5) and the drive wheel (7) are pivoted".

The preamble of claim 1 of **auxiliary request 3A** is the same as that of claim 1 of the main request, whereas its characterising portion has been amended to read as follows:

"characterized in that the tiller arm bracket (21) comprises a first portion (25) which extends upwards along the side of the drive motor (3), wherein the tiller arm bracket (21) comprises a second portion (27) which is connected to the first portion (25) and which extends radially inwards on top of the drive motor (3), wherein the first portion (25) is radially separated from the drive motor (3) to avoid interference with the drive motor (3) when the gear box (5) and the drive wheel (7) are pivoted, wherein the second portion (27) comprises a recess (29) for attachment of the tiller arm (6), and wherein the position of the recess (29) coincides with the motor axis (17) of the drive motor (3), an attachment point for the tiller arm being hereby achieved which facilitates casing of the drive motor and the gearbox."

XIV. The wording of claim 1 of auxiliary requests 4 and 5 is not stated here, since they are not of relevance for the decision.

XV. The appellant's case can be summarised as follows:

Main request

The "fastening points feature" and the feature "an attachment point for the tiller arm being hereby achieved which facilitates casing of the drive motor and the gearbox", in the following referred to as the "casing feature", lacked clarity.

Auxiliary request 3A

The amendments of claim 1 were not allowed due to the principle of prohibition of *reformatio in peius*. By the deletion of the fastening points feature, the appellant was put in a worse position than if it had not appealed. Contrary to the procedural situation underlying the decision of the Enlarged Board of Appeal in G 1/99, in which the respondent-proprietor was not adversely affected by the decision of the opposition division, as mentioned in item 9 of the Reasons, in the present case the respondent had its main request refused and its auxiliary request allowed by the opposition division and was thus adversely affected by the decision. In order to ascertain that the claims found allowable could be broadened in the subsequent appeal proceedings the respondent should and could have appealed the decision. That the patent would otherwise possibly have to be revoked was therefore not a direct consequence of the inadmissible amendment allowed by the opposition division. Consequently, the prerequisite for allowing an exception to the principle of prohibition of *reformatio in peius* as stipulated in the Headnote of G 1/99 was not fulfilled.

The re-positioning of the casing feature to the end of the claim after the additionally inserted features, changed the meaning of the expression "hereby" as used in the casing feature. It referred now to the recess's axis position, whereas it originally related to the

bracket's second portion and its radial inward extension, as disclosed on page 3, lines 9 to 12 of the originally filed description. The amendment was therefore not allowable under Article 123(2) EPC.

The subject-matter of claim 1 did not involve an inventive step in view of the combination of E2, forming the closest prior art, and E5.

It also lacked an inventive step in view of the disclosure in E6 alone or in combination with the common general knowledge of the skilled person. E8 and E9 confirmed the features known from E6. E6, E8 and E9 were only found during a search conducted by the opponent in response to the claim amendments submitted by the proprietor one month before the oral proceedings before the opposition division. The search was however only completed after those oral proceedings so that the results thereof could only have been filed with the appeal grounds. E6 was a brochure which carried a copyright mark of 2001 and a print mark indicating a printing date in 2002. Following the decision T 804/05 it had to be concluded that the brochure was publicly available before the filing date of the patent, which could further be confirmed by the witness. E8 was a photograph of a pallet truck shown in E6 and was taken on the trade fair "ProMat 2003" in Chicago by a former employee of the opponent, to be confirmed by the witness Mr. Lohmann ("Mr. L." in the following), an employee of the appellant, who also attended this trade fair. Mr. L. was also able to confirm that document E9 was available to him at the time of the trade fair. The pallet truck disclosed in E6 comprised all features of claim 1 except for the feature that the second portion comprises a recess for the tiller arm. It was thus highly relevant.

XVI. The respondent argued as follows:

Main request

The fastening points feature provided a clear structural limitation to the subject-matter of claim 1 since it defined the bracket's suitability for providing a plurality of conceivable fastening points for the tiller arm. This implied certain structural limitation in terms of its material or its geometry. For example, a very thick bracket would not allow a tiller arm to be additionally fixed thereto, since this would further increase the thickness of the resulting construction which in turn would impede the bracket's free rotation with respect to surrounding components. Also a bracket with a large hole in it might not allow the tiller arm to be fastened to it. A bracket made as a box section might be strong enough to take moments exerted on it by the tiller arm, but not strong enough when holes were drilled in to attach the tiller arm with screws or bolts. Therefore a clear distinction between brackets suitable for the requirements implied by the fastening points feature and such brackets which were unsuitable in this respect could be drawn. Similarly, also the casing feature defined a clear limitation for the position of the tiller arm's attachment point by the requirement of facilitating the casing of the drive motor and gear box. In this respect, the skilled person was taught by the exemplary embodiment shown in Figure 1 of the patent, in combination with the statements made in paragraphs [0013] and [0014], that the attachment point would have to lie on the radial extension of the bracket's second portion since otherwise the size and shape of the opening in the casing for allowing the tiller arm to

rotate could not be so simple with a single central hole on the top of casing.

Auxiliary request 3A

The deletion of the fastening points feature constituted the only possible way to overcome the objections raised against the amendments found allowable by the opposition division.

Starting from E2 as the closest prior art, the information in E5 did not lead the skilled person to the subject-matter of claim 1 because, for example, the features relating to the recess for attachment of the tiller arm were not disclosed in these documents. It was an entirely different construction.

E6 to E9 should not be admitted into the proceedings because they were filed after the end of the opposition period. E6 did not constitute a brochure as such. The copyright mark thereon did not prove that the document was publicly available before the filing date of the patent in suit. The print mark could also be read according to Swedish practice as meaning February 2010. There was also no proof that E6 had ever been distributed. In this respect the Board was not bound to follow decision T 804/05, rather T 805/05 should be considered instead. E8 and E9 did not carry any date stamp at all. It was unproven whether, and if so, at what date the trucks shown therein were made publicly available. The witness testimony had not been initially offered on all these issues. This offer was made only in reply to the Board's communication and represented a change of the appellant's case. Moreover, being an employee of the appellant, statements made by the witness would anyway have low relevance. In regard to

the features of claim 1, the documents were not relevant. It could not be derived from E6 whether the upstanding bracket-like component comprised a second portion extending radially inward on top of the drive motor and, if so, whether it comprised a recess for the attachment of the tiller arm, let alone one having an axis coinciding with the motor axis. Similarly it was unclear whether the bracket-like component was mounted to a gear box. The function of steering the wheel, whether by tiller arm or by other means, for example electrical steering, was also not derivable from the document.

Reasons for the Decision

Main request

1. Amended claim 1 underlying the impugned decision does not meet the requirements of at least Article 84 EPC because the fastening points feature and the casing feature, both taken from the description of the application as filed and added to the claim during the opposition procedure, render its subject-matter unclear.
- 1.1 Contrary to the arguments of the respondent, the fastening points feature does not impose any clear structural limitation on the pallet truck of claim 1. The feature in the context of the preceding features defines that by its upward extension along a side of the drive motor a plurality of conceivable fastening points is achieved along the first portion of the tiller arm bracket. The respondent argued that this implies that any first portion of the bracket according to the definition of claim 1 must be suitable for the tiller arm attachment and, inversely, any first portion which would not be suitable for such attachment would not fall under the claim. However the respondent could not convince the Board that embodiments of a first portion existed which fell into the second category, i.e. not being suitable for attachment of the tiller arm to the bracket's first portion. For example, if the first portion would be so thick that the attachment of the tiller arm on its circumferential surface would impede its rotation, the radial sides of such first portion would indeed offer conceivable fastening

points. Also there are no particular materials or particular structural configurations of the bracket's first portion which would clearly render it unsuitable for attachment of the tiller arm to it. As pointed out by the appellant, the claim defines that the tiller arm is attached to the bracket and via this bracket to the gear box, implying that torque has to be transmitted from the tiller arm to the wheel via the bracket (and the gear box). If the bracket's first portion would be of such material or structural configuration that the tiller arm could not be attached thereto but would have to be attached to the bracket's second portion, the first portion would still require the presence of certain parts able to transmit the torque, which in turn render exactly these torque transmitting parts of the first portion also suitable as conceivable fastening points. The examples of a bracket with a large hole not falling under the fastening points feature cannot be accepted since, even if for some reason the tiller arm could not be bolted or screwed (and the Board cannot see why this could ever be the case for the material surround the hole), the manner of attachment is not stated. It could equally be by industrial adhesive or by welding for example. The same applies to the respondent's example of a box-section bracket. Therefore any upwardly extending first portion of the tiller arm bracket, intended to transmit steering torque, must be considered to be suitable to achieve a plurality of conceivable fastening points for the tiller arm. The added fastening points feature does therefore not add any clear structural limitation to the previously defined feature "tiller arm bracket comprises a first portion extending upwards along the side of the drive motor".

- 1.2 Also, the casing feature added to the end of claim 1 renders the claim unclear. The feature immediately preceding the casing feature defines that "the tiller arm bracket (21) comprises a second portion which is connected to the first portion (25) and which extends radially inwards on top of the drive motor (3)". This definition does not exclude that the bracket's second portion comprises another part in addition to the radial extension, for example for fixing the second portion to the bracket's first portion, which could extend parallel along some length to the first portion. Nor is the claim limited to the configuration of the second portion disclosed in the preferred embodiment depicted in Figures 1 to 3 or to the particular embodiment mentioned in paragraph [0014] of the description. The casing feature does not clearly specify at which part of the tiller arm bracket's second portion the attachment point would be achieved "hereby". Also the technical effect sought by the "hereby" achieved attachment point, namely to facilitate the casing of the drive motor and the gear box, does not provide any clear indication for the skilled person how to select the attachment point, in particular since the casing is not even a feature of the pallet truck of claim 1. It remains therefore unclear what further structural limitation to the pallet truck might be implied by the casing feature.

Auxiliary requests 1 and 2

2. These auxiliary requests were submitted after the time limit for filing the response to the appeal grounds (Article 12(1) and (2) RPBA) and therefore constitute an amendment to the respondent's case. According to Article 13(1) RPBA, any amendment to a party's case may be admitted and considered at the Board's discretion.

The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. In order to be in line with the requirement of procedural economy, amendments should be prima facie or clearly allowable in the sense that they at least overcome the objections raised against previous requests.

In claim 1 of the first and second auxiliary requests, the fastening points feature has been deleted but the casing feature maintained unamended. The respondent did not argue that the further amendment to claim 1 of the second auxiliary request, which consists in the addition of the features of granted claim 4 at the end of claim 1 of the main request, would affect the clarity objection raised against the casing feature and the Board can also not see that this further amendment has any effect on the outstanding objection. The amendments to claim 1 of these two auxiliary requests therefore do not overcome all objections raised against the main request. The Board therefore exercised its discretion according to Article 13(1) RPBA not to admit auxiliary requests 1 and 2 into the proceedings.

Auxiliary request 3A

3. This request was submitted during the oral proceedings before the Board of Appeal in response to the discussions around the main request and then a third auxiliary request, subsequently withdrawn. Taking into account the criteria referred to above in Article 13(1) RPBA, the Board decided to exercise its discretion to admit auxiliary request 3A into the proceedings. The former clarity objections raised against the main and the first and second auxiliary request are overcome by

the amendments. The appellant also did not raise any objection under Article 84 EPC to this claim.

4. Claim 1 is based on the addition of the features of granted claims 4 and 6 to claim 1 of the main request. Its subject-matter is essentially a combination of all originally filed and granted claims 1 to 6 and the casing feature taken from the description, on page 3, lines 10 to 12. Compared to the main request, the fastening points feature has been deleted, and the casing feature added at the end of claim 1 of the main request follows in present claim 1 on from the definitions of the recess for attachment of the tiller arm at the second portion and of its position with respect to the motor axis.

4.1 The appellant objected to the deletion of the fastening points feature based on the argument that it shouldn't be allowed due to the principle of prohibition of *reformatio in peius*.

4.1.1 The Headnote of the decision G 1/99 of the Enlarged Board of Appeal (OJ EPO 2001, 381), on which the appellant relied, reads:

"In principle, an amended claim, which would put the opponent and sole appellant in a worse situation than if it had not appealed, must be rejected. However, an exception to this principle may be made in order to meet an objection put forward by the opponent/appellant or the Board during the appeal proceedings, in circumstances where the patent as maintained in amended form would otherwise have to be revoked as a direct consequence of an inadmissible amendment held allowable by the Opposition Division in its interlocutory decision.

In such circumstances, in order to overcome the deficiency, the patent proprietor/respondent may be allowed to file requests, as follows:

- in the first place, for an amendment introducing one or more originally disclosed features which limit the scope of the patent as maintained;
- if such a limitation is not possible, for an amendment introducing one or more originally disclosed features which extend the scope of the patent as maintained, but within the limits of Article 123(3) EPC;
- finally, if such amendments are not possible, for deletion of the inadmissible amendment, but within the limits of Article 123(3) EPC."

- 4.1.2 It appears questionable at all whether the deletion of the unclear fastening points feature, which, as the Board found above, did not imply any clear structural limitation to the claimed subject-matter, could put the appellant in a worse condition than if it had not appealed.
- 4.1.3 But even if the appellant's situation were considered to be worse, the Board cannot find anything in G 1/99 which would contradict the application of the principles stated therein to the present case.
- 4.1.4 The appellant did not contest that the only option of overcoming the deficiency created by the inadmissible addition of the fastening points feature to claim 1 consisted in the deletion of this feature, corresponding to the last option mentioned in the headnote of G 1/99. The Board is also convinced that the higher ranking options set out in the headnote of G 1/99 are not available here.

4.1.5 The appellant instead contested that the exception to the general prohibition of *reformatio in peius* stated in G 1/99 applied in the present case, since its application was limited to cases in which the proprietor was not adversely affected himself.

The Board does not accept the appellant's interpretation of G 1/99. Point 9, referred to by the appellant in this respect, belongs to that section of the reasons in G 1/99, in which the Enlarged Board gives an interpretation of the reasons for its earlier decision G 4/93 (OJ EPO 1994, 875 and footnote). In point 9, the Enlarged Board addresses specifically points 15 and 16 of the reasons for G 4/93, concerning the case where the opponent is the sole appellant. The Enlarged Board distinguishes in point 9.1 of the reasons for G 1/99 between the two possible situations of a respondent-proprietor and concludes that the principle of prohibition of *reformatio in peius* of G 4/93 applies independently of whether the respondent-proprietor was or was not itself adversely affected by the interlocutory decision. The equivalence of these two situations of the respondent-proprietor and its consequence for the application of the general prohibition is once more expressed in the last sentence of point 9.1, which reads: "This means that, if the version of the patent held allowable by the Opposition Division is also held allowable by the Board, then, because the patent proprietor intentionally accepted this version **either by making it the basis of its main request before the Opposition Division or by not filing an appeal**, the proprietor/respondent may not in principle request another version of the patent during the appeal proceedings, unless this version is a restriction of the maintained version" (emphasis added

by the present Board). In the following points of the reasons for G 1/99 the Enlarged Board states its considerations which led to the order of the decision without again distinguishing between the two possible procedural situations of a respondent-proprietor. The conclusions drawn by the appellant based on Reasons, 9 lack support.

If, based on the general principle of prohibition of *reformatio in peius*, the respondent were refused the proposed amendments to remedy the clarity objection against the fastening points feature raised in the appeal proceedings, the revocation of the patent would thus be the direct consequence. The Enlarged Board held in point 14 of the reasons for G 1/99 that it would be inequitable to deny the respondent-proprietor in such situation a fair opportunity to mitigate the consequences of errors of judgement of the opposition division. In the present case, the requested deletion of the fastening points feature is appropriate and necessary, and thus admissible.

- 4.2 The appellant further argued that the meaning of the casing feature, in particular by use of the term "hereby", had been altered and did not correspond to the original disclosure, so that the resulting subject-matter infringed the requirement of Article 123(2) EPC.

The Board also finds this argument unconvincing. The addition of the casing feature to claim 1 of the higher ranking requests is judged to lack clarity since the position of the attachment point for the tiller arm was left unclearly defined (see above). By specifying the recess and its position with respect to the motor axis, the position of the attachment point is now clearly confined to the radial extension of the bracket's

second portion and excludes undetermined positions on other parts of the second portion, such as a part extending parallel to the upstanding first portion. The resulting structural limitation corresponds also to e.g. the particular embodiment of the pallet truck disclosed in Figures 1 and 3. Such an attachment point achieved according to the features in claim 1 also contributes to the technical effect of facilitating casing of the drive motor and the gear box defined in claim 1. The meaning of the term "hereby" indeed is altered compared to its (originally unclear) meaning in the original statement of the description on page 3, lines 9 to 12. It has also been clarified, without introducing subject-matter which was not originally disclosed.

The requirement of Article 123(2) EPC is thus met.

Since the subject-matter of claim 1 has been further limited compared to the granted claim, the Board finds that the requirement of Article 123(3) EPC is also met. The appellant did not argue the contrary.

5. The subject-matter of claim 1 involves an inventive step, when considering the appellant's attack based on a combination of elements known from or taught by E2 and E5.
- 5.1 E2 discloses a pallet truck which comprises the features defined in the preamble of claim 1. Its tiller arm 25 is attached to one extremity of a fork-shaped bracket 24 which in turn is pivotably mounted at its second extremity to the gear box housing 11. Since the bracket 24 is arranged outside the truck's drive casing 2 and underneath its lower wall 3 and is thereby limited in its pivot movement it does not (and cannot)

extend upward along the side of the motor (irrespective of any pivoted position it might be placed in) as required by the first feature of the characterising portion of claim 1, contrary to the appellant's argument.

- 5.2 The pallet truck according to claim 1 is thus distinguished from the known pallet truck of E2 by the features defined in the characterising portion. These provide for a different attachment point for the tiller arm.
- 5.3 Starting from E2 as the closest prior art, an objective technical problem may therefore be seen in providing for a different point of attachment for the tiller arm.
- 5.4 Neither E2 nor E5 contain any indication which would lead the skilled person in an obvious manner to the combination of features defined in claim 1. E2 deals with problems arising with non-stationary drive motors and as a solution provides mounting the drive motor in a stationary manner to the truck's chassis (see pages 1 and 2). Besides disclosing the attachment of the tiller arm to the bracket 24 mounted to the gear box housing 11, it does not comprise any further indication for modifying this arrangement. The invention underlying the pallet truck of E5 is directed to the problems of providing for a simple and safely-operating steering arrangement in order, on the one hand, to reduce the required torque to steer the drive wheel and, on the other hand, to ensure that the necessary forces for driving and braking are maintained by continuous adaptation of the pressure on the driving wheel as a function of the load, which are solved by a particular arrangement of the lifting cylinder with respect to the chassis (see col. 2, lines 32-49). According to Figure

5 of E5 the tiller arm 4 is pivotably mounted to an upstanding bearing journal 35 which journal is arranged on a mounting structure 34. Steering torque of the tiller arm is transmitted to a non-stationary drive motor via an assembly consisting of the mounting structure 34, a flange 32 fixed thereto, distance bushings 33 and a flange 30 mounted to the motor. The appellant equated the horizontal part of the mounting structure 34 with the radial extension of the tiller arm bracket's second portion of claim 1 in suit, and the distance bushings 33 with the bracket's first portion. Contrary to the appellant's argument, the Board finds that the particular connection of journal 35 and mounting structure 34 is not disclosed. There is no indication that the journal 35 would be received in a recess of the mounting structure 34 as alleged by the appellant. Clearly the journal and mounting structure could be formed as an integral part, or the journal could be connected on top of the mounting structure by any other means. Importantly, the steering arrangements of E2 and E5 are of completely different constructions. They cannot simply be combined by replacement of the fork-shaped bracket 24 in E2 with the assembly of E5 made up from components 30 to 35. Such combination would require substantial modifications of the chassis and the casing of the truck of E2 and of the components 30 to 35 of the steering assembly of E5, exceeding just simple lengthening of the distance bushings 33 and then mounting them via the flange 30 to the pegs on the gear box housing of the truck of E2, as argued by the appellant. Lengthening the distance bushings 33 to the necessary extent would also weaken the stability of that assembly and negatively affect the transmission of torque from the tiller arm to the wheel. There is nothing in E5, apart from via an impermissible use of hindsight, which would have led the skilled person to

modify the steering assembly of E5 in all the mentioned respects and the casing and chassis of the truck of E2. Thus, without using inventive skill, the skilled person cannot arrive at the subject-matter of claim 1 in an obvious manner.

6. The appellant further raised an objection of lack of inventive step against claim 1 based on documents E6, E8 and E9 and the testimony by the offered witness, either on this evidence alone or in combination with the common general knowledge of the skilled person. E6 together with documents E7 to E9 were submitted with the appeal grounds.

- 6.1 The respondent objected to the admission of the new material and essentially argued, in relying *inter alia* on decision T 1002/92 (OJ EPO 1995, 605), that

"as regards **proceedings before the boards of appeal**, new facts, evidence and related arguments, which go beyond the "indication of facts, evidence and arguments" presented in the notice of opposition pursuant to Rule 55(1(c) EPC [1973] in support of the grounds of opposition on which the opposition is based, should only very exceptionally be admitted into the proceedings" (emphasis added by the respondent).

The Board notes that this wording is in fact extracted from point II of the Headnote of the cited decision which continues however as follows:

", if such new material is *prima facie* highly relevant in the sense that it can reasonably be expected to change the eventual result and is thus highly likely to prejudice maintenance of the European patent; and having regard also to other relevant factors in the

case, in particular whether the patentee objects to the admissibility of the new material and the reasons for any such objection, and the degree of procedural complication that its admission is likely to cause".

This Board has no reason to doubt the principles expressed in the Headnote of T 1002/92. Indeed, the simple fact that the new material has been filed only with the appeal grounds, and not already during the opposition period, is thus not decisive by itself. Rather, in accordance with the accepted case law of the Boards of Appeal, the admissibility of the newly filed material has to be assessed in view of its relevance for the validity of the patent in suit and taking further into account the circumstances which led to its filing only in the appeal proceedings and the possible procedural complications introduced by its admittance. The Board's discretion to disregard such evidence not submitted in due time relies thereby on the provision of Article 114(2) EPC.

6.2 E6 relates to a series of pallet trucks manufactured by "Yale Materials Handling Corporation". On the page entitled "Superbly designed / Yale Gold ServiceTM", a large photograph of an uncovered steering assembly of such a pallet truck is reproduced (see the key on the lower left of the photograph). This pallet truck at first sight seemingly comprises an extensive number of features in common with the subject-matter of claim 1. It is nevertheless arguable, for example, how the component which seems to be equatable with the bracket according to claim 1 is connected at its lower portion to the assembly which seems to be a drive assembly comprising drive motor, wheel and a gear box. The respondent argued that steering of the truck could be realised electrically instead of manually by a tiller

arm. The remaining uncertainties in regard to potential distinguishing features of the pallet truck according to claim 1 in regard to the truck disclosed in E6 could possibly be assessed and/or resolved by reference to the other documents, E8 and E9, which seemingly show at least very similar, if not identical pallet trucks. The offered witness testimony would also appear to be relevant in this context. The content of E6 thus appears at least *prima facie* very highly relevant in the sense that it could well prejudice the maintenance of the patent when considering the requirement of inventive step, if it were established that E6 itself or a pallet truck shown therein, or in E8 or E9 had indeed been made available to the public before the filing date of the patent in suit.

- 6.3 The respondent contested that there was any proof that E6, E8 or E9 had been publicly available before the filing date of the impugned patent (21 April 2006). The Board could agree with the respondent to the extent that it may indeed be questioned on the basis of this material alone whether and, if so, when E6, E8 and/or E9, or the trucks shown therein, were publicly made available. Mr. L. was however offered as a witness to testify on several issues in this regard. The Board finds therefore that the appellant provided sufficient evidence suggesting that a Yale pallet truck having seemingly a large number of features in common with the pallet truck of claim 1 could well have been made available to the public before the filing date of the patent in suit, either by E6 and/or by a similar truck, as shown in E8, allegedly displayed at a trade fair "ProMat 2003" in Chicago. In order to finally decide on these questions, the hearing of the offered witness would appear appropriate. The fact that the Mr. L. is himself an employee of the appellant and might

therefore appear to have some interest in his company being successful against others does not immediately disqualify the relevance of his testimony ahead from a hearing. The departments of the EPO apply the principle of unfettered consideration of evidence. The probative value of such testimony, if hearing of the witness would be ordered by the competent department of the EPO, would have to be assessed by that department, considering all circumstances of the particular case (see for example sections III.G.4.1 and 4.2 of the Case Law of the Boards of Appeal of the EPO, 7th Ed. 2013).

- 6.4 The Board does not accept the respondent's contention that the new documents E6, E8 and E9 could and should have been filed already in preparation for the oral proceedings before the opposition division. The Board notes that the amendments of the claims submitted with the letter on 15 February 2010 in reply to the notice of opposition were to some extent based on the combination of granted claims but also introduced subject-matter from the description in newly added dependent claims. Contrary to the respondent's allegation that the appellant could thus have carried out the necessary search already after the respondent's reply to the opposition, some further features, i.e. those related to the first and second portion of the bracket, which were also taken from the description and which became relevant in the further course of the procedure had been introduced into claim 1 only by the amendments filed on 23 December 2010. These amendments were transmitted to the appellant by the communication of the opposition division dated 29 December 2010 and received, according to the appellant, on 30 December 2010, which was less than one month before the oral proceedings on 25 January 2011 before the opposition division. It is entirely credible for the

Board that in this short period the time available for the opponent for conducting a further search was rather limited and that the search could not reasonably have been completed until only after those oral proceedings. The Board also cannot see any evidence of procedural abuse in the appellant's behaviour.

- 6.5 Although the admittance of the new material into the proceedings will clearly lengthen the procedure, the Board finds this complication nevertheless acceptable having regard to the time remaining before the patent expires and having regard to the substantive amendments of the claims based on features introduced from the description during the opposition and appeal proceedings.
- 6.6 The Board is also not persuaded by the respondent's contention that the appellant changed its case by providing the required information concerning the identification of the witness only with the letter in preparation for the oral proceedings before the Board. The witness was already named in the appeal grounds to give testimony in regard to documents E8 and E9. The additional indications submitted thereafter complete the appellant's case but do not constitute any substantial amendment to the appellant's case.
- 6.7 Taking all circumstances of the present case into account and considering the high relevance of the (new) evidence E6, E8 and E9 as well as the offered witness testimony submitted with the appeal grounds, the Board exercised its discretion under Article 114(2) EPC not to disregard the new evidence so that it forms part of proceedings.

6.8 As regards document E7 concerning a search for prior art conducted on behalf of the appellant in 2009, thus after the filing date of the patent in suit, this document was not admitted into the proceedings since it does not itself constitute prior art according to Article 54(2) EPC and is of no relevance in view of the issues to be decided in view of the new evidence E6, E8 and E9.

6.9 The new material filed with the appeal grounds constitutes a fresh case. In its communication in preparation for the oral proceedings, the Board had already stated its preliminary intention to remit the case to the opposition division in the case the new material would be admitted into the proceedings. The parties did not provide any argument against remittal in this regard. The Board thus decided to exercise its discretion under Article 111(1) EPC to remit the case to the department of first instance for further prosecution.

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.

The Registrar:

The Chairman:



B. Atienza Vivancos

M. Harrison

Decision electronically authenticated