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**Datasheet for the decision
of 12 December 2012**

Case Number: T 1713/11 - 3.2.04

Application Number: 03721127.3

Publication Number: 1511541

IPC: A63C 17/01

Language of the proceedings: EN

Title of invention:

Skateboard with direction-caster

Patentee:

Razor USA LLC

Opponents:

JD Components Co., Ltd
STAMM Sport & Freizeit GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 100 a) b) c), 105
EPC R. 89(1), 103(1)a)

Keyword:

"Admissibility of the interventions (yes)"
"Oral submissions by accompanying person (allowed)"
"Feasibility and/or added subject-matter - main request and
auxiliary requests 1 to 17 - requirements not fulfilled"
"Auxiliary request 18 - admissibility (yes) - inventive step (no)"
"Reimbursement of the appeal fee (no)"

Decisions cited:

G 0004/91, G 0001/94, G 0004/95, T 0389/86, T 1067/97,
T 0714/00, T 0452/05, T 0305/08

Catchword:

1. Intervention is conceived as a procedurally exceptional situation which is justified only by a substantial legitimate interest of the presumed infringer to enter the opposition proceedings. On deciding admissibility of an intervention it is preferable to concentrate on whether the action of the proprietor reaches the level sufficient to establish a substantive legitimate interest to intervene (reasons 2.2 and 2.6).

2. As long as a patent proprietor or any other party entitled to do so initiates proceedings meant to establish whether a third party is commercially active in an area that falls within the patent proprietors right to exclude, such proceedings are "proceedings for infringement" in the sense of Article 105.



Case Number: T 1713/11 - 3.2.04

DECISION
of the Technical Board of Appeal 3.2.04
of 12 December 2012

Appellant: Razor USA LLC
(Patent Proprietor) 16200 A Carmenita Road
Cerritos, CA 90703 (US)

Representative: Steimle, Josef
Dreiss Patentanwälte
Postfach 10 37 62
D-70032 Stuttgart (DE)

Respondent I: JD Components Co., Ltd
(Intervener 1) 80 Nan Dee Lane, Shah His Village
Show Shui Hsiang
Chang hua 504 (TW)

Representative: Straus, Alexander
Patentanwälte
Becker, Kurig, Straus
Bavariastrasse 7
D-80336 München (DE)

Respondent II: STAMM Sport & Freizeit GmbH
(Intervener 2) An der Nordhelle 19
D-51645 Gummersbach (DE)

Representative: Buchenau, Thomas
Patentanwälte Freischem
Salierring 47-53
D-50677 Köln (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 1 August 2011
revoking European patent No. 1511541 pursuant
to Article 101(3) (b) EPC.

Composition of the Board:

Chairman: A. de Vries
Members: C. Scheibling
C. Heath
P. Petti
T. Bokor

Summary of Facts and Submissions

- I. By its decision announced at the end of the oral proceedings held on 7 July 2011 the Opposition Division revoked the European patent. The written decision was dispatched on 1 August 2011. On 8 July 2011 the Appellant (patentee) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 1 December 2011.
- II. European patent 1 511 541 was granted on 7 November 2007. On 6 August 2008, an opposition was filed by JoLi Förvaltning AB based on Article 100 a), (b) and (c) EPC. The opposition was withdrawn on 16 July 2010. While opposition proceedings were still pending, JD Components (intervener 1) on 7 October 2009 declared its intervention according to Art. 105 EPC. This intervention was based on a "Privatanklage" raised against the intervener on behalf of Street Surfing LLC before the Landesgericht für Strafsachen Wien on 7 July 2009. This "Privatanklage" (which under Austrian law is a request or complaint for instituting criminal proceedings) alleged a wilful infringement of European patent 1 511 541 of which Street Surfing LLC was the exclusive licensee for Austria. The Landesgericht Wien dismissed the "Privatanklage" on 5 August 2009 as manifestly flawed. A second intervention was subsequently withdrawn.
- III. The Opposition division considered that the intervention by JD components was admissible and that the subject-matter of claim 1 as granted could not be carried out and added unallowable subject-matter.

Furthermore none of the auxiliary requests were found to overcome the objections based on Article 123 EPC.

- IV. The following documents played a role in the present proceedings:
D2: US-A-4 076 267
D5: DE-U-82 21 787
- V. On 15 November 2011 during the ongoing appeal, Stamm Sport & Freizeit GmbH (intervener 3) intervened in the proceedings based on infringement proceedings before the Landgericht Düsseldorf.
- VI. Oral proceedings took place on 12 December 2012 before the Board of Appeal.
- VII. The Appellant requests as main request that the decision under appeal be set aside and that the patent be maintained as granted, in the alternative that the patent be maintained on the basis of the claims of one of the auxiliary requests 1 or 17 filed with letter dated 12 November 2012 or on the basis of the claims of auxiliary request 18 filed during the oral proceedings before the Board. He also requests the reimbursement of the appeal fee.

The Respondents I and II (Interveners 1 and 3) request that the appeal be dismissed.

- VIII. The independent claim 1 of the main and auxiliary requests reads as follows:

Main request

"A skateboard comprising:

a front board (10),
a rear board (20),
a connecting element (40, 65) which interconnects the front board (10) and the rear board (20) in a spaced relationship, wherein the connecting element (40, 65) comprises an elastic member (55, 65) that restores the connecting element (40, 65) to its original shape after at least one of a twisting or bending force applied to the connecting element (40, 65) has been removed, characterized in that there is at least one direction-caster (13, 23) that is freely movable about its pivot axis, mounted on the underside of each of the front board (10) and the rear board (20) so that the pivot axis of each direction-caster (13, 23) is inclined at an acute angle with respect to the front and rear boards (10, 20)."

Auxiliary request 1

In claim 1 of this request the feature of claim 1 of the main request: "one of a twisting or bending force" has been replaced by "one of a twisting or bending and twisting force".

Auxiliary request 2

In claim 1 of this request the feature of claim 1 of the main request: "at least one of a twisting or bending force" has been replaced by "a twisting force".

Auxiliary request 3

In claim 1 of this request the feature of claim 1 of the main request: "at least one of a twisting or bending force" has been replaced by "a twisting or bending force".

Auxiliary request 4

In claim 1 of this request the feature of claim 1 of the main request: "direction-caster (13, 23) that is freely movable about its pivot axis" has been replaced by "direction-caster (13, 23) that is movable about its pivot axis".

Auxiliary request 5

Claim 1 of this request adds to claim 1 of the main request: "in that the direction-casters make rolling angles with respect to an advancing direction proportional to a magnitude of a biasing force received by the board".

Auxiliary request 6

Claim 1 of this request adds to claim 1 of the main request: "in that the direction-caster easily changes its rolling direction by application of a minimal turning force".

Auxiliary request 7

Claim 1 of this request adds to claim 1 of the main request: "and so that each direction-caster turns the front or rear board, respectively, in a same direction with respect to an advancing direction as a side of said board which is leaned, during operation".

Auxiliary request 8

Claim 1 of this request adds to claim 1 of the main request: "wherein the pivot axis of the front board (10) and the pivot axis of the rear board (20) are each inclined with respect to the front and rear boards (10, 20) with a common orientation, when no force is applied to the connecting element".

Auxiliary request 9

With respect to claim 1 of the main request, the characterizing portion of claim 1 of this request is changed to: "there is at least one direction-caster (13) that is freely movable about its pivot axis, mounted on the underside of the front board (10) in that there is at least one direction-caster that is freely movable about its pivot axis, mounted on the underside of the rear board (20) so that the pivot axis of said direction-casters (13, 23) are inclined at an acute angle with respect to the front and rear boards (10, 20), respectively and in that said direction casters are aligned along a longitudinal centre line of the front and rear boards"

Auxiliary request 10

Claim 1 of this request adds to claim 1 of the auxiliary request 9: "wherein the pivot axis of the front board (10) and the pivot axis of the rear board (20) are each inclined with respect to the front and rear boards (10, 20) with a common orientation, when no force is applied to the connecting element".

Auxiliary request 11

With respect to claim 1 of the main request, the characterizing portion of claim 1 of this request reads: "there is a single direction-caster (13, 23) that is freely movable about its pivot axis, mounted on the underside of one of the front or rear board (10, 20) in that there is at least one direction-caster (13, 23) that is freely movable about its pivot axis, mounted on the underside of the other of the front or rear board (10, 20) so that the pivot axis of said

direction-casters (13, 23) are inclined at an acute angle with respect to the front and rear boards (10, 20), respectively and in that said single direction caster is aligned along a longitudinal centre line of the front and rear boards".

Auxiliary request 12

With respect to claim 1 of the main request, the characterizing portion of claim 1 of this request reads: "there is a single direction-caster (13) that is freely movable about its pivot axis, mounted on the underside of the front board (10) in that there is a single direction-caster (23) that is freely movable about its pivot axis, mounted on the underside of the rear board (20) so that the pivot axis of said direction-casters (13, 23) are inclined at an acute angle with respect to the front and rear boards (10, 20), respectively and in that said single direction caster is aligned along a longitudinal centre line of the front and rear boards".

Auxiliary request 13

Claim 1 of this request adds to claim 1 of the auxiliary request 12: "wherein the pivot axis of the front board (10) and the pivot axis of the rear board (20) are each inclined with respect to the front and rear boards (10, 20) with a common orientation, when no force is applied to the connecting element".

Auxiliary request 14

Claim 1 of this request comprises the preamble of claim of auxiliary request 1 and the characterising portion of claim 1 of auxiliary request 9 with the additional

feature that "wherein the connecting element (40, 65) is a twist pipe (40) having an elastic matter therein".

Auxiliary request 15

Claim 1 of this request adds to claim 1 of auxiliary request 12: "wherein the connecting element (40, 65) is a twist pipe (40) having an elastic matter therein".

Auxiliary request 16

Claim 1 of this request adds to claim 1 of auxiliary request 14: "wherein the pivot axis of the front board (10) and the pivot axis of the rear board (20) are each inclined with respect to the front and rear boards (10, 20) with a common orientation, when no force is applied to the connecting element".

Auxiliary request 17

Claim 1 of this request adds to claim 1 of auxiliary request 13: "wherein the connecting element (40, 65) is a twist pipe (40) having an elastic matter therein".

Auxiliary request 18

The claims of this request differ from the claims of auxiliary request 2 in that claim 2 has been deleted and the remaining dependent claims renumbered.

- IX. The Appellant mainly argued as follows: the intervention of the first intervener does not comply with the requirements of Article 105 EPC and should therefore not be admitted.
- The original disclosure refers to a "twisting or bending force". Thus applying a bending force alone is originally disclosed. This embodiment is exemplified in figure 5b. Therefore, the invention as defined in the

main request and in auxiliary requests 3 to 13, 15 and 17 can be carried out.

The introduction of "a bending and twisting force" in claim 1 of auxiliary requests 1, 14 and 16 is implicitly derivable from figures 4b and 5b, whereas the features of claim 2 common to auxiliary requests 1, 2 and 14 and which are included in claim 1 of auxiliary request 16 is derivable from figure 1.

Auxiliary request 18 does not change the factual framework and not create any new and surprising situation, so that it is admissible. Its subject-matter further involves an inventive step. Starting from D5 there would be no incentive for the skilled person to consider D2. Moreover this combination would not exhibit all the claimed features.

X. The Respondents (interveners 1 and 3) mainly argued that the intervention of intervener 1 complies with the requirements of Article 105 EPC and is therefore admissible.

Although applying a sole "bending force" is originally disclosed, there is no embodiment that details how to implement this alternative. Therefore, the main request and auxiliary requests 3 to 13, 15 and 17 must fail.

There is no direct and unambiguous disclosure of having a "bending and a twisting force" acting together in the original application. Already therefore, auxiliary requests 1, 14 and 16 must fail. Furthermore, the features of claim 2 as granted which are present in auxiliary requests 1, 2, 14 and 16 were taken in isolation from a group of features disclosed in combination. This results in an unallowable extension of subject-matter.

Auxiliary request 18 is late filed and should therefore not be admitted into the proceedings. Moreover claim 1 of this request does not involve an inventive step when starting from D5 and taking into consideration the teaching of D2.

Reasons for the Decision

1. The appeal is admissible.
2. *Admissibility of the intervention by JD Components (Respondent 1)*
 - 2.1 A number of arguments have been raised by the patentee both in opposition and on appeal why the above intervention by JD Components should be held inadmissible, namely:
 - Intervention under Art. 105 EPC should be limited to civil proceedings, and criminal proceedings under Austrian law did not provide for injunctive relief or damages;
 - Proceedings should be pending at the time the intervention was raised;
 - The "Privatanklage" was rejected a limine and therefore deemed never to have existed or "instituted";
 - Neither "Privatanklage" nor dismissal thereof were officially communicated to the intervener;
 - Abuse of process due to ownership interests of JD Components in Street Surfing LLC (or vice versa).

The patentee in this respect remarks that the Austrian proceedings "were incorrectly filed as criminal proceedings and were procedurally flawed, lacking the

requisite evidence and basis and being directed to an association rather than a natural person", and for its view of inadmissibility further relies upon the travaux préparatoires and a statement of the Austrian law firm Schwarz Schönherr. During oral proceedings, the patentee further advanced the argument that proceedings according to Art. 105 EPC required a two-party procedure in order to avoid conflicting decisions. Thus, two parties should be involved. This was clear from decisions **T 305/08** and **T 452/05**. In the case at issue, no proceedings were instituted because the judge dismissed the case without involvement or notification of the other party. Thus, there was no date for calculating the time period under Rule 89(1) EPC, and consequently these proceedings would not be eligible for triggering an intervention. In the absence of an official notification, no intervention could be made.

- 2.2 Art. 105 EPC establishes a link between national laws of the Member States and the EPC in that it allows a party to intervene in ongoing opposition proceedings after expiry of the opposition period if faced with an infringement action or allegation of infringement which can only be instituted in a national jurisdiction under national law. As the EPC must accommodate for different national proceedings in its Member States, current and future, it can give no specific definition of what constitutes proceedings for infringement but can only refer to infringement in the broadest of terms. Furthermore, it is clear that intervention was conceived as a procedurally exceptional situation, which is justified only by a substantial legitimate interest of the assumed infringer to enter the opposition proceedings. This substantial legitimate

interest does not arise from the fulfilment of special procedural provisions, but from the fact of actually having been confronted with infringement proceedings (or at least having been called upon to cease an alleged infringement seriously enough so as to justify a counteraction). Given this exceptional nature of the intervention, it does not appear likely that there would have been a legislative intent to create an elaborate and intricate system of procedural provisions for the admissibility of interventions, and therefore the Board should also refrain from creating such a system through its jurisprudence. Rather, it appears preferable to concentrate on the examination of the substantive conditions for admitting an intervention, namely whether the action of the proprietor reaches the level which is sufficient to establish a substantive legitimate interest to intervene. The fulfilment of the requirements of Rule 89(1) EPC should be examined similarly, concentrating on the legislative intent instead of creating further procedural preconditions.

- 2.3 Article 105(1) EPC draws up two scenarios: First, "proceedings for infringement of the same patent have been instituted against" the intervener, and, second, "the proprietor of the patent has requested that [the intervener] cease alleged infringement of the patent and that [the intervener] has instituted court proceedings for a ruling that he is not infringing the patent." In the first case, the right to intervene rests upon "proceedings for infringement", in the second case, on proceedings for ascertaining non-infringement. The first option is more broadly worded. It does not require "court" proceedings, or a request by the patentee to cease and desist the allegedly

infringing behaviour. But it does require the patentee to take the first step.

2.4 As the patentee rightly points out, not any step will do. The patentee in this respect particularly points to the decision **T 305/08** of 18 February 2010. Here, the Board held that nullity proceedings concerning the patent at issue are not proceedings that could lead to the determination whether the patent was infringed, and would thus not qualify. The Board found the same also for *saisie contrefaçon* proceedings, and in this respect held the following:

"1.3.5 As regards the fact that a "saisie-contrefaçon" (seizure procedure) in Zaragoza/Spain had been instituted earlier, it is stated in A1 (see item 2a) that this procedure does not constitute infringement proceedings. In order to find the correct definition of infringement proceedings in the sense of Article 105 EPC reliance has to be placed on the specific national law. The respondent provided no evidence which could lead to a contrary interpretation under Spanish national law than that given in A1.

1.3.6 OT2 is an order regarding the findings of a seizure procedure according to a Court resolution of 29 December 2006 (see third item in OT2a) providing conclusions as to the patent of the present appeal (see item 8 on page 5 of OT2a) stating that "we cannot determine if there exists hints of a potential violation as the information is not sufficient...". In accordance with Article 130 of the Spanish Patents Act (see OT2a, e.g. page 2, item "Second"), it is evident that the procedure does not simply continue as though an infringement action has been brought, but that a new

procedure must commence. In as far as concerns Article 130 of the Spanish Patents Act (see OT2a, page 2, under the heading "Second") a judge must indeed order the opening of a separate file in cases where "the Judge considers that it is not presumable that the devices inspected serve to execute the violation of the patent." The case relating to OT2 is therefore also not proceedings which correspond to Article 105(1) (a) or (b) EPC."

- 2.4.1 The Board however fails to see how decision **T 305/08** could assist the patentee. Decision **T 305/08** aims to distinguish proceedings for infringement from other proceedings that may concern the patent at issue but are not aimed at ascertaining whether there is infringement or not. To this end, the present board would agree with **T 305/08** that the "saisie contrefaçon" is such a procedure. In countries where the saisie exists, it is not a procedure for ascertaining infringement, but for preserving evidence: "As a preliminary measure prior to an infringement action, the saisie contrefaçon...allows for a surprise inspection and...does not depend on the likelihood of success in the main action....the applicant may proceed with a request for saisie even on the basis of a patent that takes no effect in France...This is completely consistent with the saisie-contrefaçon being a provisional measure meant to preserve evidence...." (L. Petit, *The Enforcement of Patent Rights in France*, in: Heath/Petit, *Patent Enforcement Worldwide*, IIC Studies 23, Hart Publishing 2005, 152/153). The same holds true for the Italian descrizione: "The "description" is an order granted by the President of the competent court authorising the plaintiff...to inspect and describe the

allegedly infringing products/processes...The aim and use of this procedure is to collect official evidence of infringement for the purpose of using it in the trial" (G. Casucci, *The Enforcement of Patent Rights in Italy*, in: Heath/Petit, *Patent Enforcement Worldwide*, IIC Studies 23, Hart Publishing 2005, 196/197). The decision **T 305/08** points to the same situation for Spain.

2.4.2 The patentee could have further pointed to decision **T 223/11** of 22 May 2012. Here, the patentee had instigated proceedings before the National Authority of Medicines and Health Products and the Ministry of the Economy and Innovation in Portugal in order to prevent the defendants from issuing a marketing authorisation to the intervener. While the Board appreciated that a ruling in this case could have adverse commercial effects on the marketing position of the intervener, it found that in making a ruling on this issue, the Lisbon Administrative Court did not have to rule on the issue of infringement:

"Although the present board appreciates that these proceedings can obstruct the intervener's possibilities of (future) market entry with an allegedly infringing product, it is neither the patent proprietor's claim nor the court's assessment that the intervener is in fact infringing the patent. The court is rather assessing that the granting of the marketing authorisation opens up the possibility for a future infringement.

It is internationally a widely accepted principle that the submission of a request for a marketing authorisation for a pharmaceutical product by a generic

company does not constitute patent infringement (the so-called Bolar exemption). The EU Council and the EU Commission have for instance adopted the following common position: "The Council and the Commission consider that the submission and subsequent evaluation of an application for a marketing authorisation as well as the granting of an authorisation are considered as administrative acts and as such do not infringe patent protection" (Official Journal of the European Union 2003, C 297 E/66, footnote 1).

The principle behind the Bolar exemption is that generic companies should be in a position to take the necessary preparatory measures in order to be able to enter the market without delay once patent protection expires.

The Portuguese legislator has in the meantime codified this principle in law No. 62/2011 of 12 December 2011. This law entered into force after the judgement of the Administrative Court was rendered. However, this circumstance does not mean that prior to the promulgation of the new law the proceedings instigated by the patent proprietor, no matter how obstructive these may have been to a future market entry of the intervener's product, can be considered as equivalent to infringement proceedings.

The present board thereby notes that according to the judgement of the Administrative Court, one of the intervener's arguments, in line with the Bolar exemption, was that it "has the right to undertake the preliminary and preparatory steps so as to be in a position to sell the medicinal products the day after the industrial property rights held by the Plaintiff lapse". It can therefore not even be established by the

board that the intervener had the actual intention of bringing its product onto the market while the patent was still in force.

Thus, as the proceedings before the Lisbon Administrative Circuit Court cannot be considered to be infringement proceedings, the intervention is inadmissible." (reasons 2 of the decision)

The Board in the above case therefore examined whether the proceedings in substance amounted to infringement proceedings, and denied this, because the question of infringement was not determinative on the outcome of the case.

- 2.5 It is not apparent to the Board why the definition of "proceedings for infringement" should be limited to civil proceedings, to proceedings that allow for certain remedies to be claimed, or two party proceedings. This is all the less so, given that Art. 105 EPC has to be read onto national infringement proceedings of all Member States with often widely different national systems of ascertaining infringement of patents. It would therefore seem inappropriate to give Art. 105 EPC a particular interpretation that might be tailored to national infringement proceedings in some Member States, but not in others. On an international level, the WTO/TRIPS Agreement ratified by all EPC Member States in Part III (Arts. 41 - 61) lists civil (Arts. 44 - 47), administrative (Art. 49) and criminal (Art. 61) proceedings in order to ascertain infringement, and mentions a wide variety of possible remedies. Apart from injunctive relief (Art. 44), there are damages (Art. 45) and "other remedies" (Art. 46). Remedies specified in cases of

criminal enforcement are imprisonment and/or monetary fines. Mention of criminal procedures against infringement in Art. 61 TRIPS is thus indicative of the fact that this is one recognised way of enforcement (optional in the case of patents, but listed nonetheless). The patentee's argument made in this respect that Art. 105 EPC required proceedings between two parties (which criminal proceedings often are not) in order to avoid conflicting decisions (presumably between the national courts and the EPO) is not supported by the text of the provision. This argument is also difficult to sustain in light of the fact that if this had indeed been the intention behind the provision, then why does it mention only "proceedings for infringement" but not "proceedings for invalidation"? After all, national proceedings for invalidation on the one hand and opposition/appeal proceedings under the EPC on the other may well lead to conflicting results. Apart from that, infringement proceedings are meant to ascertain the question of infringement and not necessarily validity of the patent, which is what is investigated in opposition/appeal proceedings before the EPO.

- 2.6 It therefore seems to the Board that as long as a patentee (or any other party entitled to do so) initiates proceedings meant to establish whether a third party is commercially active in an area that falls within the patentee's right to exclude, such proceedings are "proceedings for infringement" in the sense of Art. 105 EPC. In the case at issue, the licensee of the patent at issue on 7 July 2009 raised a criminal complaint against the intervener alleging wilful infringement of the patent at issue. It is clear

that in the course of these proceedings, the issue of whether the patent was infringed must be determined. Sec. 159 Austrian Patent Act that is the basis for criminal enforcement of patent infringement starts with the words: "Wer ein Patent verletzt...." (whoever infringes a patent). Thus, the criminal proceedings at issue were "proceedings for infringement" according to Art. 105 EPC.

- 2.7 The patentee further argues that in order for a party to intervene under Art. 105 EPC, the proceedings for infringement must still be pending at the time the intervention is declared. The patentee in this respect relies on decisions **G 4/91** and **G 1/94** of the Enlarged Board of Appeal (respectively published in the OJ EPO 1993, 707 and OJ EPO 1994, 787). These decisions for good reason require pending opposition proceedings for an intervention. But why "the same must be true vice versa for infringement proceedings", as is argued by the patentee, is not apparent. While opposition proceedings before the EPO cannot be "reopened" due to the advent of an intervener, the Board sees no good reasons to require infringement proceedings still to be pending at the time of intervention. It is sufficient that the patentee has made its move in claiming that there is infringement and that such infringement will be sanctioned. If the Board were to agree with the patentee's line of argument, it would mean that the possibility of intervention was not only limited by the three-months period as stipulated by the provision itself, but by an additional condition, namely the pendency of such proceedings. The Board sees no cogent reasons why this should be so, quite apart from the

fact that the wording of Article 105(1) or Rule 89(1) EPC also does not suggest this in any way.

2.8 Finally, the patentee argues that in order to intervene, the infringement proceedings must have been officially communicated to the intervener, which was not the case here. In fact, the patentee's arguments seem to be two-fold: First, as long as there was no communication of the proceedings to the accused, proceedings have not been "instituted", and second, absence of such communication does not entitle a party to intervene in the first place.

2.9 In support of its first argument, the patentee mentions two points. First, that the terminology used for an Austrian "Privatanklage" does not correspond to the term "erhoben" in the German language version of the EPC. Given the fact that Art. 105 EPC must be applied to the national legal systems of all Member States (with a corresponding multitude of languages and legal terminology), and must read on civil, criminal and administrative proceedings, and on interim and ordinary proceedings alike, the Board does not find this argument convincing. Second, that proceedings have only been "instituted" once they have been communicated to the intervening party. Here again, one must refrain from determining rules that may be suitable for some countries or for some kinds of proceedings, but not for others. Rather, the Board should be satisfied that the person bringing these proceedings has done everything for the proceedings to take their course. For example, while in some countries it may be necessary in civil proceedings that the plaintiff serves the writ to the defendant, in other countries, the court will do so. In

criminal and administrative proceedings, the authorities may act ex officio upon a complaint. Equalling the instituting of proceedings with a service of the writ to the defendant (or accused) is therefore not a necessary given. Neither is it a necessary consequence of the intervener's obligation to provide proof of the infringement proceedings, see below 2.10.

2.10 In support of its second argument, the patentee relies upon decision **T 452/05** of 30 August 2006 ("Senseo") (by the present Board in a different composition). The relevant passage of this decision reads as follows:

" 1.2 Article 105 requires an intervention to be made within "three months of the date on which the infringement proceedings were instituted".

In this case, three dates could possibly have triggered the three months period: 29 November 2004, when the request for an interim injunction was made, 29 December 2004, when the request was granted, or 17 January 2005, when the injunctive order was served upon the opponent 6.

In the board's view, only the date when the order was served upon the opponent 6, i.e. 17 January 2005, should be the decisive point in time, as only from that date onwards could the opponent provide evidence of the proceedings that entitled it to intervene."

Thus, the Board in "Senseo" was concerned with how the three-months period should be calculated, not the question of whether an intervention was possible despite the lack of an official communication to the intervener. To the extent that Art. 105 EPC requires proof of infringement proceedings having been

instituted, such proof must be available to the intervener. In the absence of an official notification, the EPO cannot assume that the intervener has obtained knowledge of the proceedings, let alone require proof of such proceedings. But should the intervener have obtained knowledge of such proceedings despite a lack of communication, the Board sees no reason why the intervener should then not be entitled to intervene. Clearly, a party entering proceedings later is undesirable from a procedural point of view. Thus there is an overriding general interest that once an intervention becomes possible, it should then also be filed as soon as possible, in order to prevent any further delays of the opposition proceedings. This is exactly the purpose of the time limit of Rule 89(1) EPC (see also **T 296/93** of 28 July 1994, OJ EPO 1995, 627, point 2.3 of the Reasons, also referring to the "travaux préparatoires"). It is another matter that the time limit can only start to run once the alleged infringer has actually become aware of the institution of the infringement proceedings. An interpretation, according to which the intervener **must** under all circumstances wait for the time limit of Rule 89(1) EPC to start, would squarely contradict the very purpose of this rule. That the actual starting of a time limit for performing a procedural act is in itself no procedural prerequisite of the given procedural act is not unknown to the EPC. Decision **T 389/86** allowed the filing of an appeal even before the appellant had officially received the decision of the opposition division. Official notification that infringement proceedings have been instituted is thus no requirement for an admissible intervention.

2.10.1 In the case at issue, the criminal complaint was dated 7 July 2009. The intervention was notified to the EPO on 7 October 2009, and the opposition fee paid on the same day. Regardless of when the three-months period for the intervention should start - possibly influenced by the fact that the criminal complaint was not notified to the intervener - Rule 89(1) EPC has been complied with, because the intervention was filed within, i.e. **before the expiry of** three months of the date on which the infringement proceedings were instituted. The fact that this three-months time limit may not yet have started to run at the time when the intervention was filed, because the intervener had not been officially notified, is immaterial to this finding.

2.11 Allegations that the criminal proceedings were instituted by the patentee's licensee entitled to enforce the patent in Austria as an abuse of process and due to some sort of collusion between the licensee and the intervener were no longer upheld during oral proceedings. Already in the annex to the summons, the Board had given its preliminary view that it thought these allegations were insufficiently proven.

2.12 The Board therefore comes to the conclusion that the intervention by JD Components is admissible and that the decision of the Opposition Division was correct in this respect.

3. *Intervention by Stamm Sport & Freizeit GmbH
(Respondent 2)*

At the appeal stage, Stamm Sport & Freizeit GmbH has declared an intervention based on infringement

proceedings before the Landgericht Düsseldorf. The Board takes the view that this intervention is admissible, and no arguments to the contrary have been submitted by the patentee.

4. *Oral submissions by an accompanying person*

The Respondents asked the Board not to allow the person accompanying the Appellant to make oral submissions.

Oral submissions by a person accompanying the professional representative may be allowed with the permission of and under the discretion of the EPO. In the present case, the criteria set by the Enlarged Board of Appeal in its decision G 004/95 (OJ EPO, 1996, 412) are fulfilled. The Board therefore saw no reason for refusing to hear the accompanying person on the operation of caster boards regarding the physics involved (as announced in the submission dated 12 November 2012).

5. *Feasibility - main request and auxiliary requests 3 to 13, 15 and 17*

5.1 The Opposition division decided that the alternative in claim 1 of only applying a bending force to the connecting element is not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

5.2 The application as filed discloses that "the connecting element ... can be elastically twisted or bent when it receives twisting force or bending force and it can be restored to its original shape when the force is

removed" (see page 2, lines 13 to 16 and page 3, lines 3 to 6; claims 1 and 5).

However, although applying a "bending force" alone is therefore originally disclosed, there is no embodiment that details how to implement this alternative. The detailed embodiments described in the application as originally filed concern only skateboards with "twist pipes", i.e. with a twisting force.

- 5.3 The Appellant argued that a board according to the invention, where the connecting element is restored by a bending force is disclosed by the embodiment of figure 5b.

The corresponding passage of the description as filed, page 7, lines 3 to 8 and of the patent specification, paragraph [0026], reads: "the twist-pipe (40) is not equipped with the plate spring device (55,56, 57), but there are two flexible rubber members (65) which are parallel to the twist-pipe (40) at both side of the twist-pipe (40). The two flexible rubber members (65) are connected at each of their one ends to the front board (10) and at their other ends to the rear board (20). The restoring force can be obtained by these flexible rubber members (65) when the twist-pipe (40) is twisted".

Thus, since the flexible members are made of rubber, when the front and rear boards are twisted with respect to each other, the connecting points of the flexible rubber members move away from each other and the members are consequently stretched. Even if at their connecting points the members bend the restorative force is predominantly the elastic force caused by the member stretching.

5.4 The Appellant contended that at their point of fixing, the rubber members must bend when the front and rear board are twisted.

However, whether at this point of fixing the rubber members are bent when the front and rear boards are twisted with respect to each other, depends on how the rubber members are fixed on the front and rear boards. This is however not derivable from the originally filed documents.

Moreover, according to claim 1 the elastic member restores the connecting element to its original shape after the bending force has been removed. Since the bending force is the only force mentioned, that should then be linked to the force which restores the connecting element to its original shape, i.e. bending should give rise to the main force applied against the movement of the boards. However, in the case of Figure 5b even if it can be assumed that there is some bending, any bending force will be negligible with respect to the elastic force referred to above and definitely not a force that in itself gives rise to a force that restores the connecting element to its original shape.

5.5 The Appellant also argued that in an apparatus where different parts are in a kinematic relationship, there is never solely one single force involved. This might be true, but when the independent claim refers to a particular force producing the restorative force, the skilled person will understand that this particular force must significantly contribute to that result and not to a force which is negligible to that effect.

5.6 The Appellant also argued that the term "or" was not exclusive, so that the expression "a twisting or bending force" should be understood to encompass the possibility of both twisting and bending forces contributing to the restorative effect. However, in the passage on page 2, lines 13 to 16 and page 3, lines 3 to 6; claims 1 and 5 of the original application, it is clearly stated that "... the connecting element ... can be elastically twisted or bent when it receives twisting force or bending force and it can be restored to its original shape when **the force** is removed" (emphasis added). It can be inferred from the final mention of only one single force that these passages consider only the action of only single respective ones of the forces mentioned.

5.7 Consequently, none of the disclosed embodiments shows how the elastic elements could be submitted to a bending force alone and how the connecting element would then be restored to its original shape after that bending force has been removed. Accordingly, all requests comprising a claim 1 which includes the option of a bending force alone do not fulfil the requirements of Articles 83 and 100(b) EPC. Consequently, the main request and auxiliary requests 3 to 13, 15 and 17 must fail.

6. *Added subject-matter - auxiliary requests 1, 2, 14, and 16*

6.1 In claim 1 of auxiliary requests 1, 14, 16 a "bending and twisting force" has been introduced.

6.1.1 It is firstly noted that a "bending and twisting force" is not expressly mentioned anywhere in the originally filed application.

6.1.2 In the Appellant's view such a force would be implicitly disclosed by the embodiments of figures 4b and 5b.

As already stated above in section 5.1.5, although it might be true that in practice more than one force acts on the elastic element, the skilled person would expect that the independent claim mentions only those forces that are important or significant in producing the necessary restorative force.

In the embodiment of figure 4b, only the twisting force is of importance for achieving the desired result. In the embodiment according to figure 5b it is solely the elastic force due to stretching that is of importance in this respect.

6.1.3 Furthermore, as stated in section 5.1.6 above, on the basis of the application as filed, the term "or" can only be interpreted as an exclusive "or".

6.1.4 Accordingly, a "bending and twisting force" in the sense of the two forces acting together to restore the element to its original shape is neither explicitly nor implicitly disclosed in the original application. Consequently, the auxiliary requests 1, 14 and 16 introduce added subject-matter and must fail.

6.2 Claim 2 as granted was added during the examining phase. The Appellant acknowledged that the basis for the subject-matter of claim 2 was to be found in figure 1.

6.2.1 According to the established case law of the Boards of Appeal, it is normally not admissible to extract an isolated feature from a set of features that have originally been disclosed in combination and to add it to the claimed subject-matter, if there is a structural or functional relationship between those features; see in particular T 1067/97 and T 0714/00.

In the present case, figure 1 does not only disclose that "the pivot axis of the front board (10) and the pivot axis of the rear board (20) are each inclined with respect to the front and the rear boards (10, 20) with a common orientation, when no force is applied to the connecting element" but also various other features. Figure 1 also shows for example that there is one single direction caster mounted on the underside of each of the front and rear boards, that the front and rear boards are interconnected by a twist-pipe and that said direction casters are aligned along the axis of the twist-pipe.

All these features are linked together in a structural and functional relationship, since the skateboard according to figure 1 would not serve its intended purpose if one of these features were missing. For example the alignment of twist pipe and castors appears instrumental in achieving the typical movement of this type of waveboard.

Consequently, claim 2 which solely mentions that the pivot axis of the direction casters of the front a rear boards are each inclined with a common orientation introduces a feature that has been taken is isolation from a set of features that have originally been

disclosed in combination, contrary to the requirements of Article 123(2) EPC.

6.3 Accordingly, the auxiliary request 2 must also fail.

7. *Admissibility of auxiliary request 18*

7.1 Auxiliary request 18 differs from auxiliary request 2 in that claim 2 has been deleted.

7.2 The factual framework has thus not been changed and no new and surprising situation has been created by suppressing claim 2.

7.3 The Respondents argued that the objection against claim 2 has already been raised during the first instance proceedings and reiterated in the response to the grounds of appeal.

Although this is correct, the Board notes that this new request does not unduly delay the proceedings and does not raise new issues.

Furthermore, claim 2 was not found to infringe Article 123(2) EPC by the first instance, so that it was not mandatory for the Appellant to address this issue with the statement of the grounds of appeal and is the last chance for the proprietor to overcome the objection raised.

Accordingly, the Board considers that this request is a response to the discussion that took place during the current oral proceedings and therefore, decides to exercise its discretion to admit auxiliary request 18 into the proceedings.

8. *Inventive step of claim 1 of auxiliary request 18*

- 8.1 The Respondents considered that either D5 or D2 constitute the most promising starting point for assessing inventive step of the invention as defined in claim 1 of the auxiliary request 18.
- 8.2 D5 (page 1, paragraphs 1 to 4; figure 1) discloses a skateboard comprising at least one direction-caster (20, 40; page 2, paragraphs 4 and 6) that is freely movable about its pivot axis, mounted on the underside of each of the front and the rear portion of the board (10) so that the pivot axis of each direction-caster (20, 40) is inclined at an acute angle with respect to the board (10). Furthermore this skateboard can comprise two, three or four direction-casters as well as an additional board (page 3, last paragraph).
- 8.3 The skateboard according to claim 1 differs from that of D5 in that it comprises a front board, a rear board and a connecting element which interconnects the front board and the rear board in a spaced relationship, wherein the connecting element comprises an elastic member that restores the connecting element to its original shape after a twisting force applied to the connecting element has been removed.
- 8.4 According to the patent specification, paragraph [0006], the problem to be solved by the invention is "to provide a skateboard which is much more steerable than the conventional skateboard and which can be accelerated without the rider's stamping onto the ground".

However, D5 already solves the problem of accelerating the skateboard without the rider's stamping onto the ground, see page 1, paragraph 3.

The objective remaining problem with respect to D5 can thus be seen in providing a more steerable skateboard than that disclosed by D5.

- 8.5 Further D2, see abstract, discloses a skateboard with front and rear sections interconnected by a pivotal axis in order to improve manoeuvring. As stated in the abstract "With one foot on each section, the rider can tilt the sections independently for very rapid turning and manoeuvring with a minimum of body lean". One embodiment, see figure 5 and column 2, line 58 to column 3, line 2 of D2, comprises a front board (50), a rear board (54) and a connecting element (56, 58) which interconnects the front board (50) and the rear board (54) in a spaced relationship, wherein the connecting element (56, 58) comprises an elastic member (58) that restores the connecting element to its original shape after a twisting applied to the connecting element has been removed.

Thus, the skateboard according to D2 solves the objective problem underlying the invention (improved steerability) by dividing the board transversely into front and rear sections, which are joined by a pivotal connection having a longitudinal pivot axis (column 1, lines 21 to 23).

- 8.6 The Appellant argued that there would be no incentive for the skilled person to consider D2.

The Board sees the incentive, however, as lying in the skilled person's desire to improve steerability. It is a recognised aim in skateboarding to improve handling characteristics, in particular steerability, as expressly stated in D5, page 3, line 26 ("unterschiedlichsten Fahreigenschaften"). As this is one of D5's aims and since D2 describes how to achieve this aim, the skilled person is prompted to consider D2.

The Appellant further argued that even if the skilled person would take D2 into consideration and try to apply the teaching of D2 to D5 he would not end up with the claimed skated board, because D2 requires that a conventional skateboard truck is mounted under the rear board. Thus, the skateboard of D2 would be unable to achieve rapid turning if the rear wheels were not fixed (i.e. not freely pivotal) as conventional skateboard trucks are. This statement is however speculative and has no clear basis in D2.

There is no indication in D2 that the manoeuvrability is related to the particular type of wheels or undercarriage that are used. None of the independent claims of D2, which by definition comprise all the features which are necessary to solve the problem underlying the invention (i.e. rapid turning and manoeuvring) refer to any specific type of wheels or undercarriage. D2 thus simply teaches to divide the board transversely into front and rear sections, and to join them by a pivotal connection having a longitudinal pivot axis, irrespective of the type of wheel used. In one embodiment the Board notes, see figure 7 and column 3, lines 13 to 20, that the skateboard even has

a blade on an inclined bearing with the rear section "supported in a similar manner". This is much the same as the embodiment with direction caster skates shown in figure 6 and described in specification paragraph [0027] of the contested patent.

Furthermore, the problem D5 proposes to solve, i.e. self-propulsion, specifically requires the use of direction-casters at the front and rear side of the board. Therefore the skilled person would never consider using conventional skateboard trucks instead.

The Appellant also argued that there would be no reason for the skilled person to select the particular embodiment of figure 5 of D2 rather than that of figures 1 to 4 in order to modify D5. However, since according to D5 the skateboard necessarily comprises direction-casters and since it is the embodiment of figure 5 of D2 that features casters, the skilled person would only realistically consider this embodiment of D2 as it comes closer to the arrangement disclosed in D5 than that of figures 1 to 4 of D2. Thus, the skilled person has no reason to rely on the embodiment of figures 1 to 4.

Finally the Appellant submitted that by using in combination direction-casters and a board which is transversely divided into front and rear sections, the board was much more steerable than expected and that this represented an unexpected extra effect obtained by the invention of the patent under appeal.

Apart from the fact that no evidence has been provided in support of such an additional effect, even if it were so, this would constitute nothing more than a

bonus of the obvious combination of the teachings of D5 and D2.

An unexpected bonus effect does not by itself confer inventiveness if it is obvious for the skilled person to combine prior art teachings in order to solve the problem underlying the claimed invention.

8.7 Consequently, the subject-matter of claim 1 of auxiliary request 18 does not involve an inventive step.

9. *Reimbursement of the appeal fee*

According to Rule 103 (1) a) EPC, the appeal fee can only be reimbursed in case the Board deems the appeal to be allowable. Since in the present case none of the Appellant's requests was found to be allowable, for this reason already the request for reimbursement must be refused.

Order

For these reasons it is decided that:

1. The appeal is dismissed
2. The request for reimbursement of the appeal fee is refused.

The registrar:

The Chairman:

G. Magouliotis

A. de Vries