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**Datasheet for the decision  
of 13 August 2015**

**Case Number:** T 0720/12 - 3.2.07

**Application Number:** 06075380.3

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**IPC:** B27C5/10, B25F5/02, B25H3/00,  
B27C5/02

**Language of the proceedings:** EN

**Title of invention:**  
Router

**Patent Proprietor:**  
MILWAUKEE ELECTRIC TOOL CORPORATION

**Opponent:**  
Black & Decker Inc.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 108, 76(1), 56  
EPC R. 101(1), 99(2)  
RPBA Art. 13(3), 13(1)

**Keyword:**

Admissibility of appeal - (yes)  
Inventive step - main request (no)  
Late-filed new first and fourth auxiliary requests -  
admitted (no)  
Late-filed new fifth and new sixth auxiliary requests -  
admitted (yes)  
Amendments - new fifth auxiliary request -  
extension beyond the content of the earlier application as  
originally filed (yes)  
Inventive step - new sixth auxiliary request (no)

**Decisions cited:**

T 1188/08, T 0095/10, T 0349/09, T 0220/83

**Catchword:**



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Case Number: T 0720/12 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 13 August 2015**

**Appellant:** Black & Decker Inc.  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
20 February 2012 concerning maintenance of the  
European Patent No. 1661675 in amended form.**

**Composition of the Board:**

**Chairman** H. Meinders  
**Members:** G. Patton  
I. Beckedorf

## **Summary of Facts and Submissions**

- I. The appellant (opponent) lodged an appeal against the decision to maintain the European patent No. 1 661 675 in amended form, requesting that the decision under appeal be set aside and the patent be revoked.

Opposition had been filed against the patent as a whole and was based on the grounds according to Article 100(a) EPC (novelty and inventive step), Article 100(b) EPC (sufficiency of disclosure) and Article 100(c) EPC (extension beyond the content as originally filed).

The contested patent was granted on a divisional application of the earlier application 01 306 860.6.

- II. With its reply, the patent proprietor (respondent) requested that the appeal be rejected as inadmissible or be dismissed.
- III. The following document of the opposition proceedings is relevant for the present decision:

D1: US-A-5 139 061, cited in the contested patent, paragraph [0001]

- IV. The Board provided the parties with its preliminary non-binding opinion annexed to the summons for oral proceedings that the appeal would appear admissible, claim 19 would appear to extend beyond the content of the earlier application as originally filed, novelty of the subject-matter of independent claim 1 vis-à-vis D1 as well as inventive step of the subject-matter of independent claims 9, 19 and 25 in view of D1 and the

skilled person's common general knowledge would appear at stake.

With the letter of 13 July 2015, the respondent filed first to seventh auxiliary requests, together with a mention of further potential auxiliary requests consisting in the deletion of claims 8 and 19-24 from the main request and second to fourth auxiliary requests and the deletion of claims 8 and 18-23 from the first and fifth to seventh auxiliary requests.

V. Oral proceedings took place on 13 August 2015 during which the followings aspects, *inter alia*, were discussed:

- admissibility of the appeal in terms of sufficiency of the statement of grounds of appeal;

- novelty of the subject-matter of claim 1 of the patent as maintained by the opposition division (main request) over the disclosure of document D1;

- inventive step of the subject-matter of claim 1 according to the main request in respect of the teaching of document D1 taking into account the general technical knowledge and practice of the person skilled in the art;

- admission into the proceedings of the fourth auxiliary request filed with the letter dated 13 July 2015 and of the new first, the new fifth and the new sixth auxiliary requests filed during the oral proceedings;

- requirements of Article 76(1) EPC in combination with Article 100(c) EPC in respect of the subject-matter of claim 1 according to the new fifth auxiliary request;

- inventive step of the subject-matter of claim 1 according to the new sixth auxiliary request in respect of the teaching of document D1 taking into account the general technical knowledge and practice of the person skilled in the art.

The respondent withdrew the first to third and fifth to seventh auxiliary requests, including its further potential auxiliary requests, all as filed with the letter dated 13 July 2015.

VI. At the end of the oral proceedings, before announcing the present decision, the requests were as follows:

The appellant requests that the decision under appeal be set aside and that the European patent No. 1 661 675 be revoked.

The respondent requests that the appeal be rejected as inadmissible, or that the appeal be dismissed, or, in setting aside the decision under appeal, the patent be maintained in amended form on the basis of one of the sets of claims filed as new first auxiliary request during the oral proceedings, as fourth auxiliary request with letter of 13 July 2015 and as new fifth and new sixth auxiliary requests during the oral proceedings.

VII. Claim 1 of the **main request** reads as follows (same as claim 1 of the patent as granted):

"A router supportable by a support member (280), the support member (280) having a top surface on which a workpiece is supportable, the router being supportable below the support member (280) on an underside of the support member (280), the router comprising:

a base engageable with the support member below the support member and having a base aperture defined therethrough;

a motor housing (28) movably supported by the base (24);

a motor (30) supported by the motor housing (28) and operable to drive a tool element (290); and

an adjustment mechanism supported by at least one of the base (24) and the motor housing (28) for adjusting a position of the motor housing (28) relative to the base (24) and for adjusting a depth of cut of the tool element (290), the adjustment mechanism having a first shaft (228) connected to one of the base (24) and the motor housing (28) and rotatable about an axis, **characterized by** the first shaft (228) having a first portion (232) engageable by an operator to rotate the shaft (228) and a second portion (238) aligned with the base aperture and positioned above the first portion (232) when the router is supported below the support member (280); and, the adjustment mechanism having a second shaft (292) having an actuator portion (294) engageable by an operator and an engaging portion (296) engageable with the second portion (238) of the first shaft (228), the engaging portion (298) being

insertable through the base aperture from above the underside of the support member (280) to engage the second portion (238) of the first shaft (228)."

Claim 1 of the **new first auxiliary request** reads as follows (in bold the amendments with respect to claim 1 of the main request; emphasis added by the Board):

"A router supportable by a support member (280), the support member (280) having a top surface on which a workpiece is supportable, the router being supportable below the support member (280) on an underside of the support member (280), the router comprising:

a base engageable with the support member below the support member and having a base aperture defined therethrough;

a motor housing (28) movably supported by the base (24);

a motor (30) supported by the motor housing (28) and operable to drive a tool element (290); and

an adjustment mechanism supported by at least one of the base (24) and the motor housing (28) for adjusting a position of the motor housing (28) relative to the base (24) and for adjusting a depth of cut of the tool element (290), the adjustment mechanism having a first shaft (228) connected to one of the base (24) and the motor housing (28) and rotatable about an axis, characterized by

the first shaft (228) having a first portion (232), **and an actuator (236) being attached to the first portion of the first shaft (228), the actuator (236) being**



engageable by an operator, **and rotateable relative to the housing (28)**, to **manually** rotate the shaft (228), and **the first shaft (228) having** a second portion (238) aligned with the base aperture and positioned above the first portion (232) when the router is supported below the support member (280); and,

the adjustment mechanism having a second shaft (292) having an actuator portion (294) engageable by an operator and an engaging portion (296) engageable with the second portion (238) of the first shaft (228), the engaging portion (298) being insertable through the base aperture from above the underside of the support member (280) to engage the second portion (238) of the first shaft (228)."

Claim 1 of the **fourth auxiliary request** reads as follows (in bold the amendments with respect to claim 1 of the main request; emphasis added by the Board):

"A router supportable by a support member (280), the support member (280) having a top surface on which a workpiece is supportable, the router being supportable below the support member (280) on an underside of the support member (280), the router comprising:

a base engageable with the support member below the support member and having a base aperture defined therethrough;

a motor housing (28) movably supported by the base (24);

a motor (30) supported by the motor housing (28) and operable to drive a tool element (290); and

an adjustment mechanism supported by at least one of the base (24) and the motor housing (28) for adjusting a position of the motor housing (28) relative to the base (24) and for adjusting a depth of cut of the tool element (290), the adjustment mechanism having a first shaft (228) connected to one of the base (24) and the motor housing (28) and rotatable about an axis, characterized by

the first shaft (228) having a first portion (232) engageable by an operator to rotate the shaft (228) and a second portion (238) aligned with the base aperture and positioned above the first portion (232) when the router is supported below the support member (280), **the adjustment mechanism including a lock mechanism (252) fixed to the base (24) having a thread-engaging lug (276) movable between a thread-engaging position, in which the thread-engaging lug (276) is engaged with a threaded portion of the first shaft (228), and a disengaged position, in which the thread-engaging lug (276) does not engage the threaded portion of the first shaft (228); and,**

the adjustment mechanism having a second shaft (292) having an actuator portion (294) engageable by an operator and an engaging portion (296) engageable with the second portion (238) of the first shaft (228), the engaging portion (298) being insertable through the base aperture from above the underside of the support member (280) to engage the second portion (238) of the first shaft (228), **the first shaft (228) being rotatable in response to rotation of the second shaft (292) to adjust the position of the motor housing (28) relative to the base (24) when the thread-engaging lug (276) is in the thread-engaging position."**

Claim 1 of the **new fifth auxiliary request** reads as follows (same as claim 19 of the patent as granted):

"A method of manufacturing a router, the method comprising the acts of:

providing a base (24) defining a base aperture therethrough;

providing a motor housing (28);

providing a motor (30) operable to drive a tool element (290); and

providing an adjustment mechanism for adjusting the position of the motor housing (28) relative to the base (24) and for adjusting the depth of cut of the tool element (290), the adjustment mechanism including a first shaft (228) and a second shaft (292), the first shaft (228) being rotatable about an axis and aligned with the base aperture, characterized by

the first shaft (292) having a first portion (232) engageable by an operator to rotate the first shaft (228) and a second portion (238), the adjustment mechanism also having an actuator (236) and a position indication ring (240), the actuator (236) being couplable to the first portion (232) and rotatable relative to the housing (28) to allow an operator to manually rotate the first shaft (228), the position indicating ring (240) being couplable to the first portion (232), surrounding the first shaft (228), and including a plurality of position indicating markings (244) for indicating depth adjustment positions, the second shaft (292) having an actuator portion (294) engageable by an operator and an engaging portion (296)

engageable with the second portion (238) of the first shaft (228);

connecting the motor to the motor (30) housing (28);

connecting the motor housing (28) to the base (24) such that the motor housing (28) is movable relative to the base (24); and

connecting the adjustment mechanism to at least one of the base (24) and the motor housing (28) such that the motor housing (28) is adjustably movable relative to the base (24)."

Claim 1 of the **new sixth auxiliary request** reads as follows (in bold the amendments with respect to claim 25 of the patent as granted; emphasis added by the Board):

"A method of operating a router, the method comprising the acts of:

providing a router including a base (24) defining a base aperture, a motor housing (28) supported by the base (24), a motor (30) supported by the motor housing (28) and operable to drive a tool element (290), and an adjustment mechanism for adjusting the position of the motor housing (28) relative to the base (24) and for adjusting the cutting depth of the tool element (290), the adjustment mechanism including a first shaft (228) connected to one of the base (24) and the motor housing (28), rotatable about an axis, and aligned with the base aperture, the first shaft (228) having a first portion (232) **engageable by an operator** and a second portion (238), the adjustment mechanism including a

second shaft (292) having an actuator portion (294) and an engaging portion (296); **and** characterized by

performing one of a first depth adjusting act and a second depth adjusting act to adjust a cutting depth of the tool element (290), the first depth adjusting act including

rotating the first portion (232) of the first shaft (228) in one of a first direction to increase the cutting depth of the tool element (290) and a second direction to decrease the cutting depth of the tool element (298);

the second adjusting act including the acts of

grasping the actuator portion (294) of the second shaft (292),

inserting the engaging portion (296) of the second shaft (292) into the base aperture,

engaging the second portion (238) of the first shaft (228) with the engaging portion (296) of the second shaft (292), and

rotating the second portion (238) of the first shaft (228) with the second shaft (292) in one of the first direction to increase the cutting depth of the tool element (290) and the second direction to decrease the cutting depth of the tool element (290), the second portion (238) moving vertically relative to the base (24) when the second portion (238) is rotated in both the first direction and the second direction."

VIII. The appellant argued essentially as follows

*Admissibility of the appeal*

The statement setting out the grounds of appeal deals with the main reasons given in the impugned decision. The respondent and the Board do not need further investigations to understand immediately why the decision is alleged to be incorrect and on what facts the arguments are based. Repeating arguments of the opposition proceedings does not necessarily lead to inadmissibility of the appeal. The appeal should therefore be considered admissible.

*Main request*

Novelty should not be acknowledged for the subject-matter of claim 1 since D1 discloses all its features.

In case it would be novel on the basis of the feature of claim 1 of "a base engageable with the support member below the support member" (feature a), the problem to be solved would be to provide an alternative mounting mechanism of the router on the support member to that of D1, since the solution disclosed in D1 achieves the same effects.

The skilled person will immediately think of implementing the claimed solution in the device of D1 and, using his common general knowledge and practice, will then arrive at the claimed subject-matter in an obvious manner.

*New first auxiliary request*

The request is filed late in the procedure so that its admission is subject to the discretion of the Board.

There is no basis in the earlier application as originally filed for the term "actuator" for rotating the first shaft as now included in claim 1 of this request. This represents an inadmissible extension of the term "knob" originally used.

According to the disclosure of the earlier application as originally filed said knob is attached to an upper end of the shaft, i.e. at a very specific location thereof. No basis can be found for the actuator being "attached to" the first portion of the first shaft in the general manner as now claimed, i.e. at any location of the first portion of the shaft.

Therefore, since the late-filed request is not clearly allowable it should not be admitted in the proceedings.

*Fourth auxiliary request*

The request is filed late in the procedure so that its admission is subject to the discretion of the Board.

The features introduced in claim 1 of the fourth auxiliary request have been isolated from a combination of features describing the only lock mechanism disclosed in the earlier application as originally filed. The features of the lock mechanism not taken up into claim 1 are, however, essential for its functioning. This results in an inadmissible intermediate generalisation

Therefore, since the late-filed request is not clearly allowable it should not be admitted in the proceedings

*New fifth auxiliary request*

The following feature of claim 1 of the new fifth auxiliary request (which is claim 19 of the patent as granted):

"the position indicating ring being couplable to the first portion (232), surrounding the first shaft (228)"

is not disclosed in the earlier application as originally filed. There is in particular no basis for a connection that is "couplable", i.e. connectable with an action. Nor is there a disclosure that this "couplability" is with respect to the first portion. The term "couplable" encompasses more, i.e. an active connection, than the term "attached" as used in the earlier application originally filed.

As a result, claim 1 of the new fifth auxiliary request does not fulfil the requirements of Article 76(1) EPC and the ground of Article 100(c) EPC should therefore be regarded as holding against this claim.

*New sixth auxiliary request*

The skilled person, making use of his common general knowledge and practice, will immediately realize that the router of D1 can also be operated in its usual position, inverted back from under the support table. He will not see any technical difficulty in implementing this configuration. By doing so, he will arrive without inventive skills at the alleged distinguishing feature that:



- the first depth adjusting act includes rotating the first portion of the first shaft in one of a first direction to increase the cutting depth of the tool element and a second direction to decrease the cutting depth of the tool element,

since this can simply be done with the handle (60) in D1.

He will also know how to implement the alleged second distinguishing feature that:

- the second portion of the first shaft is moving vertically relative to the base when the second portion is rotated in both the first direction and the second direction.

Hence, the method of claim 1 should be regarded as not fulfilling the requirements of Article 56 EPC.

IX. The respondent argued essentially as follows

*Admissibility of the appeal*

The statement setting out the grounds of appeal does not deal with the impugned decision. It merely repeats the opposition objections against the patent. An analysis of the reasons given in the impugned decision is missing, there is no link established with these reasons. This is contrary to the fact that the appeal proceedings should not provide a mere second go at attacking the patent.

The arguments presented in the statement setting out the grounds of appeal are the same as those already

presented to the opposition division before taking the impugned decision. They do not not address the opposition division's findings.

The respondent and the Board are left to piece the statement and the decision together, implying further investigations on their part.

For these reasons, the appeal should not be regarded admissible.

*Main request*

The following features of claim 1 are not known from D1:

- a) a base of the router engageable with the support member below the support member;
- b) a motor supported by the motor housing and operable to drive a tool element; and
- c) the first shaft having a first portion engageable by an operator to rotate the first shaft.

Novelty of the subject-matter of claim 1 should therefore be acknowledged.

Should novelty be acknowledged in view of feature a) only, the problem to be solved would be to provide a mounting mechanism of the router on the support member, alternative to that of D1, since the same effects are achieved as in D1.

Starting from D1, the skilled person would have no motivation to implement the claimed solution in the system of D1, in particular since he would lose the advantage of a continuous support surface for the

objects to be routed as provided by the solution disclosed in D1.

Inventive step should then be acknowledged for the claimed subject-matter.

*New first auxiliary request*

A support for the amendments can be found on page 7, lines 28-29 and page 9, lines 4-5 and figure 10 of the earlier application as originally filed and claims 8 or 19 of the patent as granted.

The term "actuator" is supported by claim 8 of the patent as granted which has not been objected to with respect to Article 100(c) EPC in the notice of opposition. Further, the term "end" is not an essential feature.

Therefore, new first auxiliary request does not contravene Article 76(1) EPC and, hence, should be admitted in the proceedings.

*Fourth auxiliary request*

A support for the amendments to claim 1 of the fourth auxiliary request can be found on page 8, line 9 to page 9, line 8 of the earlier application as originally filed.

The further features of the lock mechanism as described in the earlier application as originally filed, which have not been introduced into claim 1, relate to non-essential details.

The requirements of Article 76(1) EPC are therefore met and, hence, the fourth auxiliary should be admitted in the proceedings.

*New fifth auxiliary request*

A basis for the features of claim 1 of the new fifth auxiliary request relating to the position indicating ring is given on page 7, line 33 to page 8, line 8 and figure 7 of the earlier application as originally filed.

The term "couplable" used in claim 1 has exactly the same meaning as that of the term "attached" as used in the earlier application as originally filed.

Therefore, the new fifth auxiliary request fulfils the requirements of Article 76(1) EPC.

*New sixth auxiliary request*

The following features of claim 1 of the new sixth auxiliary request are to be regarded as distinguishing features over D1 taken as the closest prior art:

- the first depth adjusting act includes rotating the first portion of the first shaft in one of a first direction to increase the cutting depth of the tool element and a second direction to decrease the cutting depth of the tool element; and
  
- the second portion of the first shaft moving vertically relative to the base when the second portion is rotated in both the first direction and the second direction.

The wording used in claim 1 of "performing **one of** a first depth adjusting act and a second depth adjusting act" is seen as requiring that both adjusting acts are mandatorily performed.

With respect to the first mentioned distinguishing feature, the technical effect is that the depth adjustment of the cutting depth of the tool can be operated via the first portion of the first shaft.

The skilled person would have no reason to operate the adjustment mechanism of D1 via the stop knob and from below the table since he can already do it from above in the router of D1. In any case, the second portion in the router of D1 would not move vertically.

Therefore, an inventive step should be acknowledged for the subject-matter of claim 1.

## **Reasons for the Decision**

1. *Admissibility of the appeal*
  - 1.1 The respondent contests the admissibility of the appeal arguing that the statement setting out the grounds of appeal (hereafter referred to as the statement) fails to indicate the reasons why the decision under appeal is wrong or why it should be set aside, contrary to Article 108, third sentence, EPC and Rule 99(2) EPC.
  - 1.2 For the respondent, the statement does not deal with the impugned decision, does not even refer to it, and merely repeats the earlier objections against the patent. For admissibility, the impugned decision is to be attacked, not the patent, the appeal proceedings being distinct proceedings and not affording to have a

"second go" in opposition. In the present case, there is not even a request to set aside the impugned decision. For an appeal to be regarded admissible, an analysis of the reasons given in the impugned decision is required, which is missing in the present statement (T 1188/08, points 1.1 and 1.4; T 95/10, point 1; T 349/09, points 4-6, 10; none published in OJ EPO; Case Law of the Boards of Appeal, 7th Edition, 2013, IV.E.2.6.3.b).

The respondent further argues that it is inevitable that some of the arguments put forward in the statement will relate to the impugned decision. However, such an implicit link is not enough for rendering an appeal admissible since an explicit analysis of the reasons given in the impugned decision is mandatory (T 349/09, *supra*, points 13 and 14).

The respondent holds the view that the arguments presented in the statement are the same as those already presented to the opposition division before it took the impugned decision. In particular, the arguments in the penultimate paragraph of page 2 and the paragraph linking pages 2 and 3 of the statement were already identically present in the appellant's letter dated 14 September 2011 filed before the oral proceedings in opposition. They further relate only to objections against the patent, they do not present an analysis of the reasons given in the impugned decision, point II.3.4. They do not address the opposition division's findings that there is not "sufficient room" foreseen in the device of D1 to engage the stop knob (43) or that the latter "could [not] be operated" to rotate the shaft (37).

Although it is admitted that it is not required in the EPC or RPBA to bring new arguments in appeal, the present mere repetition of the arguments already presented before the opposition division without analysing the reasons given in the impugned decision cannot lead to an admissible appeal (T 349/09, *supra*, points 6, 21, 22).

The respondent and the Board are left to piece the statement and the decision together, implying further investigations on their part (T 349/09, *supra*, point 8).

- 1.3 The Board cannot follow the respondent's view for the reasons below, as also discussed at the oral proceedings.

An explicit reference to the impugned decision is made in both the appeal and the statement (page 1), with the unambiguous request to set it aside. The arguments provided by the appellant are clearly and concisely presented and enable the Board to understand immediately why the decision is alleged to be incorrect and on what facts the appellant bases its arguments, without first having to make investigations of its own (Case Law of the Boards of Appeal, 7th Edition 2013, IV.E.2.6.3.a; see also T 349/09, *supra*, point 8.a).

It is referred for instance to the lack of novelty objection vis-à-vis D1 under point 3.1 of the statement and, in particular to the last paragraph on page 2 and the one bridging pages 2 and 3, which is unambiguously a response to the reasoning given in the impugned decision, point II.3.4. There is no particular difficulty or further investigation required for relating (or linking) the arguments on novelty of the

subject-matter of claim 1 over D1 put forward in the impugned decision (point II.3.4) to those of the appellant (statement, point 3.1). Contrary to the respondent's view, the above mentioned paragraphs of point 3.1 of the statement intend to demonstrate why the reasons given under point II.3.4 for novelty are wrong, *de facto* explicitly addressing the impugned decision, i.e. not merely raising objections against the patent.

Further, the arguments in the cited paragraphs of point 3.1 of the statement deal with the decision, more importantly had to be repeated because they had not been taken into consideration in the impugned decision. This concerns the point made by the opponent that the portion (38) of the shaft (37) is "exposed" and "can be engaged directly", which is indeed not discussed in the impugned decision, points II.3.2 and II.3.4. This would imply that the impugned decision has insufficiently taken into account the opponent's arguments presented in the first instance proceedings. Such a repetition cannot lead to an inadmissible appeal (T 1188/08, *supra*, point 1.1).

Finally, as also discussed during the oral proceedings, the main reasons in the impugned decision on novelty are covered by the statement, fulfilling also the second condition for admissibility recalled in T 349/09, *supra*, point 8.b.

In view of the above, contrary to the respondent's view, the conclusions of inadmissibility drawn in T 349/09 and T 1188/08, *supra*, do not apply and the requirements set in Rule 99(2) EPC are fulfilled.



Since the other conditions according to Article 108 EPC and Rule 99 EPC are also met, the appeal is admissible (Rule 101(1) EPC).

1.4 In T 220/83, OJ EPO 1986, 249, cited by the respondent, the Board found that merely referring in general terms to passages from the literature showing the state of the art and to the Guidelines for Examination cannot form sufficient statement of grounds of appeal. Since this does not reflect the present case, the conclusion of inadmissibility drawn in T 220/83, *supra*, does not apply either.

2. *Main request*

2.1 Novelty of the subject-matter of claim 1

2.1.1 The appellant raises an objection of lack of novelty of the subject-matter of claim 1 over D1.

2.1.2 D1 discloses a router (6) supportable by a support member (table 1), the support member (1) having a top surface on which a workpiece is supportable, the router being supportable below the support member (1) on an underside of the support member (1), the router comprising:

- a base (plate 11) engageable with the support member (1) and having a base aperture defined therethrough;
  - a housing (6) movably supported by the base (11);
- and
- an adjustment mechanism supported by at least one of the base (11) and the housing (6) for adjusting a position of the housing (6) relative to the base (11) and for adjusting a depth of cut of the tool element (bit 14), the adjustment mechanism having a first shaft

(rod 37) connected to one of the base (11) and the housing (6) and rotatable about an axis.

In the router of D1, the first shaft (37) has a first portion and a second portion (square cross-section coupling 57) aligned with the base aperture and positioned above the first portion when the router is supported below the support member (1); and, the adjustment mechanism having a second shaft (shaft 61 of handle 60) having an actuator portion (knob 71) engageable by an operator and an engaging portion (square cross-section recess 65 of portion 63) engageable with the second portion (57) of the first shaft (37), the engaging portion (63, 65) being insertable through the base aperture from above the underside of the support member (1) to engage the second portion (57) of the first shaft (37) (column 2, line 4 to column 3, lines 10; figures 1, 2, 4).

2.1.3 As argued at the oral proceedings, the respondent considers that the following features of claim 1 are distinguishing features over D1:

a) a base engageable with the support member **below** the support member;

b) a **motor** supported by the motor housing and operable to drive a tool element;

and

c) the first shaft having a first portion **engageable by an operator to rotate the first shaft.**

2.1.4 With respect to above feature c), the Board concurs with the appellant that it is to be interpreted such

that the first portion merely has to be **suitable for** being engaged by an operator, i.e. no means (structural feature) is further specified in the claim. Therefore, any arrangement of the shaft (37) in D1 which allows it to be rotated by an operator, by whatever means, fulfils this requirement.

The use of an intermediate object, i.e. a tool such as a wrench, is therefore not excluded from the wording of claim 1.

Finally, sufficient space between the threaded block (41) and the stop knob (43) can be made for accessing the first portion (38) in the router of D1 by actuating first the handle (60) so as to lift up the threaded block (41) and the housing together (cf. figure 1).

Therefore, disputed feature c) is disclosed by D1.

- 2.1.5 The respondent holds the view that there is no reason for an operator to increase the space (38) of the first shaft (37) available between the threaded block (41) and the stop knob (43) for him to engage the shaft (37) below the table since he can already rotate it from above by actuating the handle (60).

Further, the said space is not suitable for being engaged by an operator since the shaft (37) is too thin for allowing a gripping sufficient for the claimed rotation. Firstly, the required leverage is considerable as it needs to counter the weight of the router together with the force of the springs (25). Secondly, the thread of the shaft (37) will be damaged and the mechanism will no longer work. For these reasons, the first shaft cannot be regarded as being

engageable by an operator for the claimed purpose of its rotation.

The stop knob (43) cannot be used to rotate the first shaft either since it is mounted detachable. D1 is further silent on what would happen when an operator would continue to rotate the stop knob (43) once screwed tight. Since the knob is not conceived for rotating the first shaft and countering the weight of the router (6) together with the force of the springs (25), it would probably break and fall apart. As shown in figure 1, there is no access to the stop knob (43) anyway. In fact, there is no direct and unambiguous disclosure in D1 regarding the stop knob (43) being engageable by an operator to rotate the shaft (37).

- 2.1.6 The Board cannot share the respondent's view for the following reasons, also put forward at the oral proceedings.

The shaft (37) in the router (6) of D1 is conceived in order to support the weight of the router and the force of the springs (25) when lifting the router up or down by actuating the handle (60). It is therefore not to be expected that it will break when used for that purpose.

The required leverage or the damage caused to the thread when gripping the shaft (37) at portion (38) cannot negate the simple fact that the shaft remains "engageable" for its rotation. It would indeed merely depend on the type of wrench and how it is used.

Regarding the stop knob (43) once mounted tight on the shaft (37), the Board is of the opinion that it will enable, at least to some extent, to rotate the shaft (37) in the same direction as when the stop knob was

screwed onto the shaft (38). There is no reason for the stop knob to break or fall apart in such a situation. Finally, contrary to the respondent's allegation, there is an immediate access to it as is apparent from figure 1, i.e. it is neither embedded in a part of the router nor confined in a housing.

2.1.7 With respect to feature b), the Board shares the appellant's view that it is implicit from the disclosure of D1 since the router cannot function without a motor. The respondent's argument that novelty should be acknowledged for the reason that the disputed feature is not explicitly disclosed is not convincing.

Therefore, disputed feature b) is disclosed by D1.

2.1.8 With respect to feature a), the Board shares the respondent's view that the base (11) of the router (6) of D1 is engageable with the support member (1) **above** the support member (1). This appears clearly from the shoulder (5) of the support member (1), with perpendicular walls (3) and (4), in which the base (11) is engaged (column 2, lines 4-12; figure 1).

Therefore, disputed feature a) is the only distinguishing feature of claim 1 over D1.

2.1.9 In view of the above, the subject-matter of claim 1 is novel (Article 54(1) EPC).

2.2 Inventive step of the subject-matter of claim 1

2.2.1 The Board shares the parties' view that D1 is the closest prior art for claim 1. As a matter of fact, like claim 1, D1 aims at providing a router with a depth of cut adjustment mechanism engageable by an

operator from above the support member when mounted below said support member (contested patent, [0004], [0011], [0036] and [0046]; D1, column 1, lines 11-17 and 40-43).

- 2.2.2 As a result of the discussion on novelty, the only distinguishing feature of claim 1 over D1 is that the base is engageable with the support member below the support member (feature a; see point 2.1 above).
- 2.2.3 The technical effects of the distinguishing feature are the same as for the mounting of the router on the support member as in D1: the router is mounted below the support member, the tool bit is pointing upwards.
- 2.2.4 Since the technical effects are the same, the Board shares the respondent's view put forward at the oral proceedings that the problem to be solved is to provide a mounting mechanism of the router on the support member as an alternative to that of D1.
- 2.2.5 The respondent argues that, starting from D1, the skilled person would not consider the claimed solution since he would lose the advantage of having the surface of the base (11) flush with the table (1), as it appears from figure 1 of D1.

He would also lose a further advantage regarding the flexibility in the size of the aperture(s). In the mounting system according to the invention, shown in figure 13, the apertures are small. This would not be the case when mounting the base (11) below the support member (1) in D1. The discontinuity in the table would be very large. The skilled person would have to completely re-engineer the table of D1, i.e. the base and the support member together.

The skilled person would therefore lack the motivation to implement the claimed solution in the system of D1 so that the claimed alternative solution is to be regarded as involving inventive step.

- 2.2.6 As discussed at the oral proceedings, the Board is of the opinion, although contested by the respondent, that the skilled person, faced with the above mentioned technical problem of finding an alternative, does not have any other solution at its disposal than the claimed one. He will therefore immediately think of implementing it in the device of D1. When doing so, he will take care of any necessary adaptations, using his common general knowledge and practice, for a proper guiding of the workpiece on the support member (router table), namely reducing the apertures in the table to only the minimum required size so as to have sufficient support close to the tool bit. As put forward by the appellant, the skilled person will know how to perform such adaptations.

As a consequence, the subject-matter of claim 1 of the main request does not involve inventive step (Article 56 EPC).

### 3. *New first auxiliary request*

- 3.1 The new first auxiliary request was filed at the oral proceedings before the Board. Consequently, its admission in the proceedings is subject to the discretionary power of the Board in accordance with Articles 13(1) and (3) RPBA.

3.2 With respect to claim 1 of the main request, claim 1 of the new first auxiliary request comprises the following further features (see point VII above):

- an actuator being attached to the first portion of the first shaft; and

- the actuator being engageable by an operator, and rotateable relative to the housing, to manually rotate the shaft.

3.3 According to the respondent, support for the amendments can be found on page 7, lines 28-29 and page 9, lines 4-5 and figure 10 of the earlier application as originally filed and claims 8 or 19 of the patent as granted. In fact, at least claim 8 had not been objected to pursuant to Article 100(c) EPC in the opposition.

3.4 The Board cannot consider, however, the claims of the patent as granted, presently claims 8 or 19, as providing a valid support for the amendments, already for the reason that the respondent only selects some features of these claims.

Secondly, instead of claiming, as do claims 8 and 19, that the actuator is "couplable" to the first portion, claim 1 now states that the actuator is "attached". As will be discussed below that is not necessarily the same as "couplable".

For the support of the amendments, the Board will therefore take recourse to the earlier application as originally filed.



3.5 The Board shares the appellant's view that there is no basis in the earlier application as originally filed, for the term "actuator" as now included in claim 1, for rotating the first shaft. As a matter of fact, it is originally always referred to as a "knob". The new term extends now to any kind of actuating system, which was not disclosed nor even foreseen in the original disclosure of the earlier application.

Further, the original disclosure of the earlier application refers to the adjustment knob (236) being "attached", but this is to an upper **end** of the shaft (228), i.e. at a very specific location of the shaft (see page 7, lines 28-29). No basis can be found for the actuator being attached to the first portion of the first shaft in a general manner as now in claim 1, i.e. at any location of the shaft.

3.6 As a consequence, since the new first auxiliary request raises new objections with respect to Article 76(1) EPC to be discussed for the very first time at a late stage in the procedure, namely at the oral proceedings, contrary to the principle of procedural economy, it is not admitted in the procedure (Article 13(1) RPBA). The requirements of late amendments to the claims to be acceptable in terms of procedural economy has been established in the jurisprudence of the Boards of Appeal relating to Article 13(1) RPBA, see Case Law of the Boards of Appeal, 7th Edition 2013, chapter IV.E. 4.2.1.

3.7 The respondent argues that the term "end" is not an essential feature.

3.8 The Board cannot share the respondent's view. Not specifying that the knob is attached at the end of the

first portion of the first shaft covers embodiments in which it could be attached at another location, which is not originally disclosed, nor foreseen in the earlier application as originally filed.

4. *Fourth auxiliary request*

4.1 The fourth auxiliary request was filed with the respondent's letter dated 13 July 2015, i.e. after the summons for oral proceedings has been sent.

Consequently, its admission in the proceedings is subject to the discretion of the Board in accordance with Article 13(1) RPBA or subject to Article 13(3) RPBA.

4.2 With respect to claim 1 of the main request, claim 1 of the fourth auxiliary request further comprises the following features (see point VII above):

- the adjustment mechanism including a lock mechanism fixed to the base having a thread-engaging lug movable between a thread-engaging position, in which the thread-engaging lug is engaged with a threaded portion of the first shaft, and a disengaged position, in which the thread-engaging lug does not engage the threaded portion of the first shaft; and

- the first shaft being rotatable in response to rotation of the second shaft to adjust the position of the motor housing relative to the base when the thread-engaging lug is in the thread-engaging position.

4.3 According to the respondent, the support for the amendments can be found on page 8, line 9 to page 9, line 8 of the earlier application as originally filed.

4.4 As discussed at the oral proceedings, the Board does not see any basis in the earlier application as originally filed for isolating the features now introduced in claim 1 from the combination of features of the only lock mechanism disclosed, page 8, line 9 to page 9, line 20. As a matter of fact, the disclosed lock mechanism further comprises (at least) the following features, which are essential for its functioning (see in particular page 7, lines 7-10; page 8, lines 9-12; page 8, lines 22-23, of the earlier application as originally filed):

- a lock mechanism receptacle (150);
- the lock mechanism being movable in a direction perpendicular to the axis of the depth adjustment column (146); and
- a lock frame (256) biased outwardly to the thread-engaging position by a spring or other biasing member (278).

According to the disclosure of the earlier application as originally filed, the user pushes the lock button (260) of the lock frame (256) inward against the biasing member (278) to release the threaded portion (232) from engagement with the locking lug (276). Hence, the above listed features are unambiguously functionally linked with the features now taken up in an isolated manner (see point 4.2) in claim 1 of the fourth auxiliary request. Their absence in this claim 1 results in an inadmissible intermediate generalisation, contravening Article 76(1) EPC.

4.5 As a consequence, since the fourth auxiliary request raises new objections with respect to Article 76(1) EPC

to be discussed for the very first time at a late stage in the procedure, namely at the oral proceedings, contrarily to the principle of procedural economy, it is also not admitted in the procedure (Article 13(1) RPBA).

4.6 The respondent considers that the above listed features relate to details of the lock mechanism which are not essential for its functioning and, hence, do not need to be introduced in claim 1 in order to meet the requirements of Article 76(1) EPC.

4.7 The Board cannot share the respondent's view. As put forward at the oral proceedings, it is not necessary that the earlier application declares these features to be "essential" so that they must be included in this amendment. What counts for the Board is that a skilled person realises that the above listed features are required for the functioning of the lock mechanism. Otherwise, the isolated features would just be objects "floating" somewhere in the housing of the router, without any clue as to how it should function. By this wording, present claim 1 of the fourth auxiliary request in any case encompasses embodiments, such as different ways of functioning, not originally disclosed nor foreseen in the earlier application as originally filed.

5. *New fifth auxiliary request*

5.1 Admission in the proceedings

5.1.1 The new fifth auxiliary request was filed at the oral proceedings before the Board. Consequently, its admission in the proceedings is subject to the

discretion power of the Board in accordance with Articles 13(1) and (3) RPBA.

- 5.1.2 New fifth auxiliary request comprises only claims 19 to 27 according to the main request, renumbered claims 1 to 9. These claims have, at least briefly, been discussed under the ground of Article 100(c) EPC in the impugned decision, points II.1.1.3 and 1.3.1 and have been present in the appeal proceedings since the very beginning as part of the main request. The appellant (statement, points 3.18 and 4.2) as well as the respondent (response, point 17) have argued in writing on their subject-matter and the Board also provided the parties with a preliminary opinion, see point 8.1 of the annex to the summons for oral proceedings. Both parties, including the Board, were prepared to discuss the claims at the oral proceedings. The appellant has not contested the admissibility of the new fifth auxiliary request.

For these reasons, the Board does not see any reasons not to admit the fifth auxiliary request in the proceedings.

- 5.2 Extension beyond the content of the earlier application as originally filed
- 5.2.1 The respondent refers to page 7, line 33 to page 8, line 8 and figure 7 of the earlier application as originally filed as basis for the position indicating ring of claim 1 of the new fifth auxiliary request.
- 5.2.2 The Board shares, however, the appellant's view that the following feature of claim 1 of the new fifth auxiliary request:

"the position indicating ring being couplable to the first portion (232), surrounding the first shaft (228)"

is not disclosed in the earlier application as originally filed. The disclosure relating to the mounting means of the position indicating ring (240) on the depth adjustment mechanism indeed does not provide support for such a wording of claim 1 (see page 8, lines 1-8).

There is a disclosure of "a plurality of resilient fingers integrally formed with the position indicating ring", so that the position indicating ring is fixed with but rotatable relative to the **housing**. That does not help in disclosing the fixing of the position indicating ring onto the depth adjustment shaft (which is the "first shaft", which has a "first portion").

There is another disclosure, namely: "connected to but rotatable relative to the depth adjustment shaft". Also this cannot be a basis for a fixing of that ring as being **couplable to the first portion**, surrounding the first shaft. "Couplable" means, to the Board, connectable **with an action**.

Also the drawings do not provide basis for a connection that is characterised by the fact that it is "couplable" in this sense. Nor is there a disclosure that this "couplability" is with respect to the first portion (232).

As a result, at least for these reasons, the ground for opposition pursuant to Article 100(c) EPC holds against claim 1.

5.2.3 The respondent contests the above interpretation of the term "couplable", considering that it does not necessarily imply an action. It holds the view that its meaning is the same as that of "attached" used in the earlier application as originally filed, page 7, line 34. Therefore, the conditions of Articles 76(1) EPC should be regarded as fulfilled.

5.2.4 The Board cannot share the respondent's view for the reasons put forward by the appellant. The term "attached" unambiguously refers to the description of a "passive" connection between two parts, contrary to "attachable" or "couplable" which encompasses an "active" mechanism for their connection.

## 6. *New sixth auxiliary request*

### 6.1 Admission in the proceedings

6.1.1 The new sixth auxiliary request was filed at the oral proceedings before the Board. Consequently, its admission in the proceedings is subject to the discretion of the Board in accordance with Articles 13(1) and (3) RPBA.

6.1.2 New sixth auxiliary request comprises claims 1 to 3 corresponding to claims 25 to 27 according to the main request.

Therefore, for essentially the same reasons as those given under point 5.1.2 above for the new fifth auxiliary request, the Board does not see any reasons not to admit the new sixth auxiliary request in the proceedings.

6.2 Novelty and inventive step of the subject-matter of claim 1

6.2.1 Novelty of the subject-matter of claim 1 has not been contested by the appellant and the Board concurs with this view.

6.2.2 Document D1 is regarded as being the closest prior art for claim 1 of the new sixth auxiliary request for the same reasons as those put forward under point 2.2.1 above for the main request.

6.2.3 According to the respondent, the following feature of claim 1 of the new sixth auxiliary request is to be regarded as a distinguishing feature over the arrangement of D1:

- the first depth adjusting act includes rotating the first portion of the first shaft in one of a first direction to increase the cutting depth of the tool element and a second direction to decrease the cutting depth of the tool element.

The respondent considers that the claimed first depth adjustment act is related to the first shaft to be actuated from below the support member when the router is mounted below said support member, whereas it is operated from above the support member in D1 (figure 1). There is no disclosure in D1 relating to a depth adjustment of the cutting tool (14) to be operated from below the support member.

The respondent also holds the view that the following feature is a further distinguishing feature of claim 1 over D1:



- the second portion moving vertically relative to the base when the second portion is rotated in both the first direction and the second direction.

In D1, the shaft (37) is mounted rotatably onto the base (11) via the bushing (95) (column 3, lines 23-52; figure 6). Hence, it is fixed in translation with respect to the base. Consequently, when using the handle (60) to rotate the shaft (37) and to operate according to the claimed second depth adjusting act, the shaft (37) in D1 remains fixed in translation, i.e. does not move vertically.

Finally, the claim requires that both the first and the second depth adjusting acts should be performed.

6.2.4 As discussed at the oral proceedings and contrary to the respondent's view, the Board interprets the method of claim 1 as encompassing the possibility to only perform the first depth adjustment act. The wording used is "performing **one of** a first depth adjusting act and a second depth adjusting act". The claim therefore allows for a reading that includes only the first depth adjusting act. Therefore, the above mentioned further feature relating to the vertical movement of the second portion of the first shaft in the second depth adjusting act, in fact the entire second depth adjusting act, cannot be considered as a distinguishing feature.

Hence, the only distinguishing feature is the above mentioned feature relating to the first depth adjustment act.

6.2.5 As put forward by the respondent, the technical effect obtained by said distinguishing feature is that the

depth adjustment of the cutting tool is operated from below the support member.

The problem to be solved would then be to modify the router of D1 to obtain this effect.

For the respondent, starting from D1, the skilled person would have no reason to operate the adjustment mechanism from below the table since he can already do it from above in the router of D1. Therefore, an inventive step would have to be acknowledged for the subject-matter of claim 1.

- 6.2.6 The Board, however, shares the appellant's view as expressed at the oral proceedings that the skilled person, making use of his common general knowledge and practice, will immediately realize that the router of D1 can also be operated in its normal arrangement, i.e. not supported below the support member, but with its plate (11) resting on the workpiece. He will not see any technical difficulty in implementing this configuration. The result of this approach is that for adjusting the cutting tool depth, he will still be able to use the handle (60) for rotating the shaft (37), thus arriving at the claimed method in an obvious manner (Article 56 EPC).

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



G. Nachtigall

H. Meinders

Decision electronically authenticated