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**Datasheet for the decision
of 19 November 2013**

Case Number: T 0990/12 - 3.2.08

Application Number: 03008924.7

Publication Number: 1355084

IPC: F16F15/32

Language of the proceedings: EN

Title of invention:

Wheel balance weight and process for manufacturing the same

Patent Proprietor:

HONDA GIKEN KOGYO KABUSHIKI KAISHA
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Opponent:

Wegmann automotive GmbH & Co. KG

Headword:

Relevant legal provisions:

EPC Art. 100(c)
RPBA Art. 13(1)

Keyword:

Grounds for opposition - added subject-matter (yes)
Late-filed auxiliary requests - admitted (no)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 0990/12 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 19 November 2013

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 17 February 2012 rejecting the opposition filed against European patent No. 1355084 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman: I. Beckedorf
Members: M. Alvazzi Delfrate
P. Acton

Summary of Facts and Submissions

- I. By its decision posted on 17 February 2012 the opposition division rejected the opposition against European patent No. 1 355 084.
- II. The appellant (opponent), to which the decision was notified on 29 February 2012, lodged an appeal against it on 26 April 2012, paying the appeal fee on the same day. The statement of grounds of appeal was filed on 29 June 2012.
- III. Oral proceedings before the board of appeal took place on 19 November 2013. The discussion with the parties concerned in particular the requirements of Article 123(2) EPC in respect of claim 1 as granted (main request) and the admission into the proceedings of auxiliary requests 1 to 11.
- IV. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed or alternatively that in setting aside the decision under appeal the patent be maintained on the basis of one of the sets of claims filed as auxiliary requests 1 to 11 with letter of 30 July 2013.

- V. Claim 1 of the main request reads as follows:

"A wheel balance weight (1), comprising:

a weight (2) being composed of at least one member selected from the group consisting of zinc and a zinc-based alloy, being formed as a substantially strip

shape having opposite surfaces and at least a groove (21), the groove (21) being formed in at least one of the opposite surfaces of the weight (2) and crossing in the width-wise direction thereof; and

installation means (3) for installing the weight (2) to a rim in a wheel;
characterized in that

the weight (2) has a substantially uniform thickness,
and

the opposite surfaces comprise a series of surfaces curved in length-wise direction and oriented alike, wherein a curved surface of each opposite surface lies between the position of two grooves (21)."

Claim 1 of **auxiliary request 1** reads as follows
(differences from the main request emphasised):

"A wheel balance weight (1), comprising:
a weight (2) being composed of at least one member selected from the group consisting of zinc and a zinc-based alloy, being formed as a substantially strip shape having opposite surfaces and at least two grooves (21), the grooves (21) being formed in at least one of the opposite surfaces of the weight (2) and crossing in the width-wise direction thereof; and installation means (3) for installing the weight (2) to a rim in a wheel, wherein the weight (2) has a substantially uniform thickness except for the grooves (21), and the opposite surfaces comprise a series of surfaces curved in length-wise direction and oriented alike, wherein a curved surface of each opposite surface lies between the position of two grooves (21)."

Claim 1 of **auxiliary request 2** reads as follows
(differences from the main request emphasised):

"A wheel balance weight (1), comprising:
a weight (2) being composed of at least one member
selected from the group consisting of zinc and a zinc-
based alloy, being formed as a substantially strip
shape having opposite surfaces and at least a groove
(21), the groove (21) being formed in at least one of
the opposite surfaces of the weight (2) and crossing in
the width-wise direction thereof; and installation
means (3) for installing the weight (2) to a rim in a
wheel;
characterized in that the weight (2) has a
substantially uniform thickness, and the opposite
surfaces each comprise a series of surfaces curved in
length-wise direction and oriented alike, wherein a
curved surface of each opposite surface lies between
the position of two grooves (21)."

Claim 1 of **auxiliary request 3** reads as follows
(differences from the main request emphasised):

"A wheel balance weight (1), comprising:
a weight (2) being composed of at least one member
selected from the group consisting of zinc and a zinc-
based alloy, being formed as a substantially strip
shape having opposite surfaces and at least a groove
(21), the groove (21) being formed in at least one of
the opposite surfaces of the weight (2) and crossing in
the width-wise direction thereof; and installation
means (3) for installing the weight (2) to a rim in a
wheel;
characterized in that the weight (2) has a
substantially uniform thickness, and the opposite
surfaces each consist of a series of surfaces curved in

length-wise direction and oriented alike, wherein a curved surface of each opposite surface lies between the position of two grooves (21)."

Claim 1 of **auxiliary request 4** reads as follows
(differences from the main request emphasised):

"A wheel balance weight (1), comprising:
a weight (2) being composed of at least one member selected from the group consisting of zinc and a zinc-based alloy, being formed as a substantially strip shape having opposite surfaces and at least two grooves (21), the grooves (21) being formed in at least one of the opposite surfaces of the weight (2) and crossing in the width-wise direction thereof; and installation means (3) for installing the weight (2) to a rim in a wheel, wherein the weight (2) has a substantially uniform thickness except for the grooves (21), and the opposite surfaces each consist of a series of surfaces curved in length-wise direction and oriented alike, wherein a curved surface of each opposite surface lies between the position of two grooves (21)."

Claim 1 of **auxiliary request 5** reads as follows
(differences from auxiliary request 4 emphasised):

"A wheel balance weight (1), comprising:
a weight (2) being composed of at least one member selected from the group consisting of zinc and a zinc-based alloy, being formed as a substantially strip shape having opposite surfaces and at least two grooves (21), the grooves (21) being formed in at least one of the opposite surfaces of the weight (2) and crossing in the width-wise direction thereof; and installation means (3) for installing the weight (2) to a rim in a wheel, wherein the weight (2) has a uniform thickness

except for the grooves (21), and the opposite surfaces each consist of a series of surfaces curved in length-wise direction and oriented alike, wherein the weight (2) is curved at portions in which no groove (21) is formed and a curved surface of each opposite surface lies between the position of two grooves (21)."

Claim 1 of **auxiliary request 6** reads as follows (differences from auxiliary request 4 emphasised):

"A wheel balance weight (1), comprising:
a weight (2) being composed of at least one member selected from the group consisting of zinc and a zinc-based alloy, being formed as a substantially strip shape having opposite surfaces and at least two grooves (21), the grooves (21) being formed in at least one of the opposite surfaces of the weight (2) and crossing in the width-wise direction thereof; and installation means (3) for installing the weight (2) to a rim in a wheel, wherein the weight (2) has a uniform thickness except for the grooves (21), and the opposite surfaces each consist of a series of surfaces curved in length-wise direction and oriented alike, wherein the weight (2) has a predetermined length obtained by cutting the weight (2) at a groove and a curved surface of each opposite surface lies between the position of two grooves (21)."

Claim 1 of **auxiliary request 7** reads as follows (differences from the main request emphasised):

"A wheel balance weight (1), comprising:
a weight (2) being composed of at least one member selected from the group consisting of zinc and a zinc-based alloy having a zinc content of 39.5% by weight or more when the entirety is taken as 100% by weight,

being formed as a substantially strip shape having opposite surfaces and at least a groove (21), the groove (21) being formed in at least one of the opposite surfaces of the weight (2) and crossing in the width-wise direction thereof; and installation means (3) for installing the weight (2) to a rim in a wheel; characterized in that the weight (2) has a substantial uniform thickness, and the opposite surfaces comprise a series of surfaces curved in length-wise direction and oriented alike, wherein a curved surface of each opposite surface lies between the position of two grooves (21)."

Claim 1 of **auxiliary request 8** reads as follows
(differences from auxiliary request 4 emphasised):

"A wheel balance weight (1), comprising:
a weight (2) being composed of at least one member selected from the group consisting of zinc and a zinc-based alloy having a zinc content of 39.5% by weight or more when the entirety is taken as 100% by weight, being formed as a substantially strip shape having opposite surfaces and at least two grooves (21), the grooves (21) being formed in at least one of the opposite surfaces of the weight (2) and crossing in the width-wise direction thereof; and installation means (3) for installing the weight (2) to a rim in a wheel, wherein the weight (2) has a uniform thickness except for the grooves (21), and the opposite surfaces each consist of a series of surfaces curved in length-wise direction and oriented alike, wherein a curved surface of each opposite surface lies between the position of two grooves (21)."

Claim 1 of **auxiliary request 9** reads as follows
(differences from auxiliary request 4 emphasised):

"A wheel balance weight (1), comprising:
a weight (2) being composed of at least one member selected from the group consisting of zinc and a zinc-based alloy having a zinc content of 45% by weight or more when the entirety is taken as 100% by weight, being formed as a substantially strip shape having opposite surfaces and at least two grooves (21), the grooves (21) being formed in at least one of the opposite surfaces of the weight (2) and crossing in the width-wise direction thereof; and installation means (3) for installing the weight (2) to a rim in a wheel, wherein the weight (2) has a uniform thickness except for the grooves (21), and the opposite surfaces each consist of a series of surfaces curved in length-wise direction and oriented alike, wherein a curved surface of each opposite surface lies between the position of two grooves (21)."

Claim 1 of **auxiliary request 10** reads as follows
(differences from auxiliary request 4 emphasised):

"A wheel balance weight (1), comprising:
a weight (2) being composed of at least one member selected from the group consisting of zinc and a zinc-based alloy having a zinc content of 50% by weight or more when the entirety is taken as 100% by weight, being formed as a substantially strip shape having opposite surfaces and at least two grooves (21), the grooves (21) being formed in at least one of the opposite surfaces of the weight (2) and crossing in the width-wise direction thereof; and installation means (3) for installing the weight (2) to a rim in a wheel, wherein the weight (2) has a uniform thickness except for the grooves (21), and the opposite surfaces each consist of a series of surfaces curved in length-wise

direction and oriented alike, wherein a curved surface of each opposite surface lies between the position of two grooves (21)."

Claim 1 of **auxiliary request 11** reads as follows (differences from auxiliary request 4 emphasised):

"A wheel balance weight (1), comprising:
a weight (2) being composed of at least one member selected from the group consisting of zinc and a zinc-based alloy having a zinc content of 90% by weight or more when the entirety is taken as 100% by weight, being formed as a substantially strip shape having opposite surfaces and at least two grooves (21), the grooves (21) being formed in at least one of the opposite surfaces of the weight (2) and crossing in the width-wise direction thereof; and installation means (3) for installing the weight (2) to a rim in a wheel, wherein the weight (2) has a uniform thickness except for the grooves (21), and the opposite surfaces each consist of a series of surfaces curved in length-wise direction and oriented alike, wherein a curved surface of each opposite surface lies between the position of two grooves (21)."

VI. The appellant's arguments can be summarised as follows:

Main request - Article 100(c) EPC

According to claim 1 the opposite surfaces of the weight comprise a series of surfaces curved in length-wise direction and oriented alike, wherein a curved surface of each opposite surface lies between the position of two grooves. This wording could not be found in the application as originally filed.

The term "oriented alike" could be seen as referring to the orientation of the curved surfaces on merely one of the opposite surfaces. In other words, it could stipulate merely that the curved surfaces on one of the opposite surfaces are all concave or all convex, without defining the orientation of the curved surfaces on the other opposite surface. Hence, since the thickness of the weight had to be merely "substantially" uniform, claim 1 also covered weights in which each of the opposite surfaces comprised a series of concave surfaces, as in example 1 submitted with letter of 13 September 2013.

A weight in which each of the opposed surfaces comprised a series of convex surfaces, as in example 3 submitted with the same letter, also fell within the scope of claim 1.

Accordingly, example 4 of that letter, which was a combination of examples 1 and 3, was also covered by claim 1.

Example 2 filed with the same submission was also covered by claim 1, since it had a tape on the convex surfaces, which could function as installation means allowing its installation on the outer peripheral surface of a rim of a wheel.

Moreover, a weight in which only one of the opposite surfaces comprised curved surfaces, as depicted in example 5 of the letter of 13 September 2013, also fell within the claimed scope, since according to claim 1 the opposite surfaces comprised a series of curved surfaces.

Finally, since the claim referred merely to the surfaces lying between the position of two grooves, a weight as in example 6 of the same letter, in which the opposite surfaces of the section situated between one groove and the end of the weight were both straight, was also covered by claim 1.

Accordingly, the wording of claim 1 covered a broad range of possible shapes of the weight.

However, the application as originally filed did not disclose these possibilities. In particular, examples 3 and 4 of the application as filed, which were indicated as a possible basis for the amendment of claim 1, related to very specific shapes of the weight. These shapes were shown in Figures 7 and 8 and comprised three grooves on one of the opposite surfaces, a series of four convex surfaces on the opposite surface on which the installation means were arranged and a series of four concave surfaces on the other opposite surface. No basis could be found for generalising these shapes to the more general geometry covered by present claim 1.

Therefore, claim 1 of the main request comprised subject-matter which extended beyond the content of the application as originally filed.

Admissibility of the auxiliary requests

The auxiliary requests were late filed and in a number which was not justified by the case. Moreover, none of these requests *prima facie* overcame all the objections under Article 100(c) EPC. Accordingly, they should not be admitted into the proceedings.

VII. The respondent's arguments can be summarised as follows:

Main request - Article 100(c) EPC

It was true that the application as originally filed did not disclose *expressis verbis* that the opposite surfaces comprised a series of surfaces curved in length-wise direction and oriented alike, wherein a curved surface of each opposite surface lay between the position of two grooves.

Nonetheless, its examples 3 and 4, together with Figures 7 and 8 and paragraphs [0021], [0024], [0043], [0044] and [0063], provided a basis for the introduction of this feature in claim 1. Example 3 described the production of a weight with curved surfaces between the grooves on each of the opposite surfaces, as shown in Figure 7. The curved surfaces were provided on both surfaces and oriented alike, i.e. one of the opposite surfaces exhibited convex surfaces and the other concave surfaces, as required by present claim 1. Moreover, the grooves could be formed on either of the opposite surfaces, be it the one with the concave or the one with convex surfaces, as apparent from example 4, Figure 8 and paragraph [0021].

Although Figures 7 and 8 depicted a weight with four grooves, it was clear to the person skilled in the art that the application as originally filed was not restricted to a particular number of grooves, which depended on the length to which the weight was cut.

It was true that in the weights depicted in Figures 7 and 8 all the portions of the opposite surfaces except for the grooves were curved, while claim 1 allowed some

of them, for instance those between one groove and the end of the weight, to be straight. However, the application as originally filed disclosed in paragraph [0063] that before cutting the weight to its length the portions disposed between the grooves were curved, without mentioning what happened to the end portions. Therefore, if the cutting step was dispensed with, as disclosed in paragraphs [0043] and [0044], a weight with straight portions at its ends was obtained.

Therefore, the application as originally filed disclosed a weight as stipulated by claim 1.

As to examples 1 and 3 to 6 of the appellant's letter of 13 September 2013, they did not fall within the scope of claim 1. This claim required the weight to have a substantially uniform thickness. In case of doubt this feature had to be interpreted with the help of the description, which disclosed in paragraph [0024] that the thicknesses of the weight portions were uniform. Moreover, the description also disclosed, in examples 3 and 4, that the curved surfaces were obtained by pressing with a punch, which resulted in the curved surfaces with the same orientation on the two opposite surfaces. Hence weights in which the orientations on the two opposite surfaces were different, as shown in said examples 1, 3 and 4, or in which only one of the opposite surfaces had curved surfaces, as in said examples 5 and 6, did not fall within the scope of claim 1.

Therefore, claim 1 did not comprise subject-matter extending beyond the content of the application as originally filed.

Admissibility of the auxiliary requests

The auxiliary requests were filed in response to the preliminary opinion of the board of appeal. Their number was due to the fact that it was difficult to foresee which objection under Article 100(c) EPC could justify revocation of the patent in the board's view. Therefore, they should be admitted into the proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. Main request - Article 100(c) EPC
 - 2.1 During the examination proceedings claim 1 was amended by introducing the wording according to which "the opposite surfaces comprise a series of surfaces curved in length-wise direction and oriented alike, wherein a curved surface of each opposite surface lies between the position of two grooves". It is undisputed that this wording cannot be found in the application as originally filed.

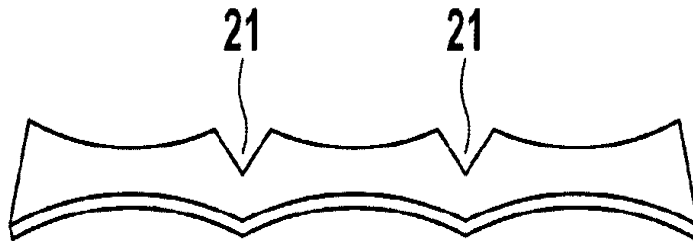
In order to establish whether this amendment introduces subject-matter which extends beyond the content of the application as filed it must be established

- which features are defined by this wording and

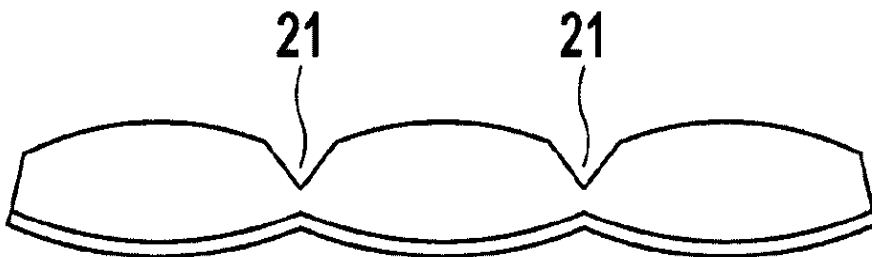
- whether these features were disclosed in the application as originally filed.

2.2 Contrary to the appellant's opinion the claim requires that curved surfaces are provided on both the opposite surfaces of the weight, since according to its wording a curved surface of each opposite surface lies between the position of two grooves.

2.3 However, the claim stipulates that the curved surfaces of a series of these curved surfaces must be "oriented alike", without specifying what is meant by this wording. Therefore, it may refer for instance to a weight in which all the surfaces are concave or all the surfaces convex, as shown in examples 1 and 3 submitted in the appellant's letter of 13 September 2013 and depicted below.



Beispiel 1



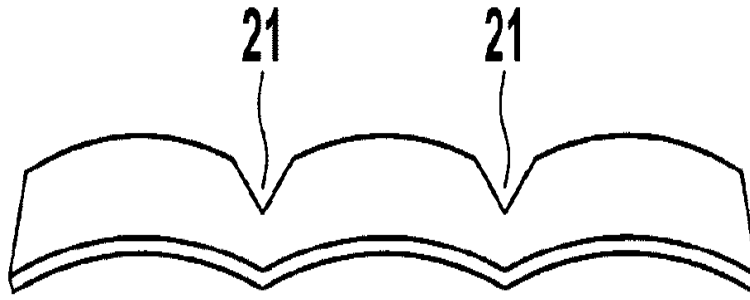
Beispiel 3

The respondent submitted that the shapes of these examples were not in accordance with claim 1, because they did not have a substantially uniform thickness and could not be obtained by pressing with a punch. However, the claim does not define how uniform a "substantially" uniform thickness has to be. Hence, the shapes depicted above, which do not exhibit perfectly uniform thickness but rather allow for a certain variation, can also be considered to be in accordance with the wording of claim 1.

Considering paragraph [0024] to interpret the claim, as invoked by the respondent, would not lead to a different result. This passage merely requires that the thickness of the portions free from a groove is substantially uniform. In the case of the shapes depicted above each of these portions has approximately the same geometry, i.e. inter alia the same thickness. Therefore it can be considered that their thickness is substantially uniform.

As to the alleged impossibility of obtaining the shapes of examples 1 and 3 by pressing with a punch, this argument is of no relevance since claim 1 does not require that the weight is obtained by such a process.

2.4 Additionally, claim 1 does not specify which surfaces are convex or concave. Hence it also covers a weight as shown in example 2 of the appellant's letter of 13 September 2013 (depicted below) in which concave surfaces are provided on the side to be installed on the rim of a wheel.



Beispiel 2

2.5 To sum up, claim 1 stipulates a series of curved surfaces "oriented alike" on each of the opposite surfaces of the weight, also comprising a case in which all the surfaces are convex or concave (see examples 1 and 3 above) or a case in which the side to be installed on the rim of the wheel comprises concave surfaces (see example 2 above).

2.6 By contrast the shape disclosed in the application as originally filed is more specific. Examples 3 and 4 and Figures 7 and 8 disclose a weight with a series of convex surfaces on the side to be applied on the rim of the wheel and a series of concave surfaces on the opposite surface. The rest of the application, in particular paragraphs [0021], [0024], [0043, [0044] and [0063], does not provide any indication that this disclosure may be generalised to also cover shapes as shown in examples 1, 2 and 3 depicted above.

2.7 Therefore claim 1 comprises subject-matter which extends beyond the content of the application as originally filed.

3. Auxiliary requests 1 to 11

Auxiliary requests 1 to 11 were submitted with letter of 30 July 2013.

According to Article 13(1) of the Rules of Procedure of the Boards of Appeal, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion. That discretion is to be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

In the present case claim 1 of each of the auxiliary requests *prima facie* also covers a weight as shown in example 2 of the letter of 13 September 2013. Accordingly, these auxiliary requests are all *prima facie* not allowable.

As a consequence, the submission of such claims could not be conducive to an efficient procedure. Under these circumstances, the board decided not to admit auxiliary requests 1 to 11 into the proceedings.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The patent is revoked.

The Registrar:

The Chairman:



V. Commare

I. Beckedorf

Decision electronically authenticated