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**Datasheet for the decision  
of 2 May 2018**

**Case Number:** T 2398/12 - 3.5.03

**Application Number:** 04016162.2

**Publication Number:** 1615096

**IPC:** G05G9/047

**Language of the proceedings:** EN

**Title of invention:**  
Computer input device

**Patent Proprietor:**  
Gylling Invest AB

**Opponent:**  
Chateau d'Or LLC

**Headword:**  
Computer input device/GYLLING INVEST

**Relevant legal provisions:**  
EPC Art. 100(a), 54, 56  
RPBA Art. 13(1)

**Keyword:**

Public prior use D1 - inventive step - main request (no)  
Admissibility - second and third auxiliary requests (yes)  
Inventive step starting out from D1 - second auxiliary request  
(no) - third auxiliary request (yes)

**Decisions cited:**

G 0003/14, T 2565/11

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 2398/12 - 3.5.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.03**  
**of 2 May 2018**

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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 18 September  
2012 rejecting the opposition filed against  
European patent No. 1615096 pursuant to Article  
101(2) EPC.**

**Composition of the Board:**

**Chairman** F. van der Voort  
**Members:** T. Snell  
P. Guntz  
A. Madenach  
O. Loizou

## **Summary of Facts and Submissions**

- I. This case concerns the appeal of the opponent (henceforth, appellant) against the decision of the opposition division rejecting its opposition against the European patent No. 1 615 096.

The patent proprietor is respondent.

- II. The patent had been opposed on the ground for opposition pursuant to Article 100(a) EPC (lack of novelty and lack of inventive step). In the impugned decision, the opposition division held, inter alia, that the subject-matter of claim 1 was new and involved an inventive step with respect to an alleged prior use at the CeBIT trade fair 2001 referred to as D1. Evidence for the prior use was provided inter alia by a model inspected at the oral proceedings before the opposition division and a video, referred to as D14, of a television program covering the trade fair. The opposition division accepted that the model was the computer mouse shown in D14.

The opposition division also held that the subject-matter of claim 1 involved an inventive step with respect to the combination of the prior use D1 with either D6 (= WO 01/79954 A1) or D7 (= US 4733214 A).

- III. In the statement of grounds of appeal, the appellant requested that the impugned decision be set aside and that the patent be revoked in its entirety. It argued that the subject-matter of claim 1 was not new with respect to prior use D1 and that the subject-matter of claim 1 did not involve an inventive step with respect to the combination of D1 with either common general knowledge or either one of documents D6 and D7.

With respect to the prior use D1, the appellant offered to provide the board with the model which had been inspected by the opposition division, the original brochure and the original packaging box. Photographs of the packaging box (D1-1.1) and extracts of the brochure (D1-1.2 to D1-1.6) had already been submitted as evidence during the opposition procedure and the appellant requested that these items be accepted as "valid prior art".

- IV. In a reply to the statement of grounds of appeal, the respondent contested the appellant's arguments. It stated that it would wait to file any request to amend the patent in suit until it knew the position of the board.
- V. The board subsequently requested that it be provided with the model and the other items referred to by the appellant (cf. Article 12(2)(b) RPBA). EPO records from the post room show that a package did arrive by post at the EPO, including a letter from the appellant listing the items said to be enclosed. However, neither the model nor the other items ever arrived within the Boards of Appeal Unit, a separate department located in another building.
- VI. In a communication accompanying a summons to attend oral proceedings, the board drew attention to the missing items, which, despite an internal investigation, had not been found at the EPO. The board stated that, as regards the model, the board was limited to the facts established by the opposition division as a result of their taking of evidence (cf. the minutes of the oral proceedings before the opposition division) and any observations by the board

which could be unequivocally deduced from the video showing the model (i.e. D14).

The board gave a preliminary opinion, *inter alia*, that the subject-matter of claim 1 did not appear to involve an inventive step with respect to the prior use D1 in combination with common general knowledge.

VII. In response to the board's communication, the appellant offered to bring a second model to the oral proceedings for visual inspection and requested that it be admitted to the proceedings. It also submitted an affidavit by Mr Ullman and offered him as a witness at the oral proceedings in order to support the case for admitting the second model.

VIII. In a subsequent letter, the respondent requested that the board refuse the request for inspection of the second model. It also submitted claims of first to sixth auxiliary requests.

IX. Oral proceedings were held on 2 May 2018. The appellant withdrew its offer that Mr Ullman be heard as a witness regarding the second model of the "Ullman Mouse".

The Chairman established the final requests to be as follows:

The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked in its entirety.

The respondent (patent proprietor) requested that the appeal be dismissed or, in the alternative, that the patent be maintained in amended form on the basis of the claims of one of second to sixth auxiliary requests

as filed with the letter dated 2 March 2018. The first auxiliary request was withdrawn.

At the end of the oral proceedings, the chairman announced the board's decision.

- X. Claim 1 of the main request (i.e. claim 1 as granted) reads as follows:

"A computer input device including a base element (1) having a housing and being *[sic]* arranged for resting on a surface, detecting means for detecting movement of the base element relative to the surface, communication means for communicating information about the movement to a computer, a grip element (2) being connected to the base element (1) in the direction of a connection axis, wherein the movement of the base element (1) over the surface is controllable by the grip element (2), the housing of the base element is provided with a recess (8), which recess has a circumferential support portion, the grip element (1 *[sic]*) extends into the recess (8), where it is pivotably arranged relative to the base element (1) and where it is prevented from rotating relative to the base element (1) round its connection axis, and wherein the circumferential support portion is designed such that, when the grip element (2) in an end position abuts against the support portion, the inclination *[sic]* grip element (2) relative *[sic]* the surface is limited, such that, in the end position, the grip element (1) is always readily at hand."

XI. Claim 1 of the 2nd auxiliary request is the same as claim 1 of the main request except that in the first paragraph "bering" is replaced by "being" and in that in the last paragraph the wording

"and wherein  
the circumferential support portion is designed such that, when the grip element (2) in an end position abuts against the support portion, the inclination [sic] grip element (2) relative [sic] the surface is limited, such that, in the end position, the grip element (1) is always readily at hand"

is replaced by:

"wherein  
the circumferential support portion is designed such that, when the grip element (2) in an end position abuts against the support portion, the inclination of the grip element (2) relative [sic] the surface is limited, such that, in the end position, the grip element (1) is always readily at hand, wherein the grip element is pivotably arranged by a joint which is provided in the recess, and wherein the joint is an essentially frictionless joint".

XII. Claim 1 of the 3rd auxiliary request is the same as claim 1 of the 2nd auxiliary request except that the following wording is added to the end of the claim:

", and wherein the housing is integral with the recess walls and one part of the joint",

and in that the word "and" is deleted before the wording "wherein the joint is an essentially frictionless joint".



XIII. In view of the board's decision, there is no need to reproduce the wording of the remaining auxiliary requests.

### **Reasons for the Decision**

1. *Main request - claim 1 - novelty with respect to prior use D1*

1.1 The present patent concerns a computer input device such as a computer mouse which, for ergonomic reasons, has an elongated grip element shaped like a pen (although claim 1 is not limited by the shape of the grip element). The grip element is pivotably attached to a base element which comprises means for detecting movement relative to a surface in the usual manner.

1.2 Claim 1 as granted reads as follows (with the annotations used in the impugned decision; cf. point 19 of the decision):

- a. A computer input device including
- b. a base element (1) having
  - b.1. a housing and
  - b.2. being *[sic]* arranged for resting on a surface,
- c. detecting means for detecting movement of the base element relative to the surface,
- d. communication means for communicating information about the movement to a computer,
- e. a grip element (2)
  - e.1. being connected to the base element (1) in the direction of a connection axis, wherein
  - e.2. the movement of the base element (1) over the surface is controllable by the grip element (2),

g. the housing of the base element is provided with a recess (8),  
h. which recess has a circumferential support portion,  
i. the grip element (1 [sic]) extends into the recess (8),  
i.1. where it is pivotably arranged relative to the base element (1) and  
j. where it is prevented from rotating relative to the base element (1) round its connection axis, and wherein  
k. the circumferential support portion is designed such that, when the grip element (2) in an end position abuts against the support portion, the inclination [sic] grip element (2) relative [sic] the surface is limited, such that, in the end position, the grip element (1) is always readily at hand.

1.3 The board interprets feature b.2 as reading "being arranged for resting on a surface". The board also interprets feature k as reading "... the inclination of the grip element (2) relative to the surface ...". The respondent agreed with these interpretations.

1.4 It was accepted by the opposition division that the prototype of a computer mouse which the appellant presented at the oral proceedings before the opposition division (to be referred to as "the model") corresponded to the one exhibited at the CeBIT trade fair 2001, as shown in the video D14. The allegation of a public prior use referred to as D1 and assessed by the opposition division is essentially based on this model. The model however is not available for assessment by the board (see points V and VI above).

1.5 Although this is obviously highly regrettable, not least in respect of the examination of the appeal, the board considers that what actually happened to the

missing items is primarily a matter between the appellant and the EPO departments which handle the incoming mail rather than the board. The board's task is to decide on the merits of the appeal on the basis of the requests, facts, evidence and arguments available to it.

- 1.6 As regards the prior use D1, the board is limited to taking into account the facts and conclusions established by the opposition division as a result of the "taking of evidence" (cf. the minutes of the oral proceedings before the opposition division) and any observations by the board which can be unequivocally deduced from the video showing the model (i.e. D14).
  
- 1.7 The appellant requested to be able to introduce into the proceedings a second model alleged to conform in all essential aspects to the first model. However, the board found this to be not necessary. On the one hand it would be difficult to be convinced that the second model were structurally and functionally identical to the model exhibited at the CeBIT 2001 and shown in the video D14 in all aspects relevant to the decision, especially as far as the interplay between the grip element, the bellows, and the recess were concerned. On the other hand, the board notes that the opposition division has already performed a visual and tactile inspection (cf. minutes of the oral proceedings, point 8.1) of the model and came to the conclusion, inter alia, that the bellows cover made it impossible to determine whether the grip element extended into the recess or not (feature i) and that it was not possible to determine whether the centre of the pivot was inside the recess (feature i.1). A full review of the evaluation of the evidence undertaken by the opposition division does not have to be undertaken unless the

evaluation shows apparent flaws such as errors of logic and the like (see e.g. T 2565/11, point 1.2.1 of the reasons). Although the appellant has alleged that the opposition division did not base its decision on a tactile examination in addition to a visual examination, which might be considered as an error, the board finds this to be rather implausible, especially as the minutes explicitly state that a tactile examination was performed. Consequently, the board has no reason to doubt the conclusions of opposition division derived from the inspection of the model (see also point 1.12.1 ff. below).

- 1.8 As regards the missing packaging box said to have been sent with the model, in the view of the opposition division, the image on the front cover of the packaging box (D1-1.1) did not correspond to the model in the video D14 (cf. point 20.5 of the reasons of the impugned decision). The appellant has not contested this either in the statement of grounds of appeal or subsequently. Consequently, the packaging box, even if available, would not be relevant to the prior use D1.
- 1.9 With respect to the brochure documents D1-1.2 to D1-1.6, similar considerations apply. It appears from the witness testimony that brochures were handed out. However, no-one has testified that these brochures were the same as the brochure comprising the images D1-1.2 to D1-1.6, which, in the view of the opposition division, in any case did not correspond to the exhibited model (*idem*). Consequently, the images D1-1.2 to D1-1.6 are considered not relevant to the prior use D1 either.
- 1.10 It was common ground that the model comprises features a to f and j (cf. the taking of evidence section of the

minutes and point 20.7 of the decision - the respondent confirmed that this was the case at the oral proceedings before the board). The discussion with respect to novelty therefore concerns features i, i.1, g, h and k.

1.11 Re feature g:

The opposition division determined that a recess (feature g) was present in the housing of the base element of the model (cf. the taking of evidence part of the minutes and point 20.7 of the decision), albeit that the proprietor apparently at that time did not agree (cf. point 8.2 of the minutes). The proprietor has however not challenged this finding in the appeal proceedings, and in fact conceded at the oral proceedings before the board that a recess must be present.

1.12 Re features i and i.1:

1.12.1 The opposition division stated that it was not possible to determine from visual inspection whether the grip element extended into the recess and whether the centre of the pivot was inside the recess (cf. point 20.8 of the reasons). The appellant has disputed these findings, arguing that not only a visual inspection but a tactile feeling would have led the skilled person to infer the presence of features i and i.1.

1.12.2 The board notes that in order to support an objection of lack of novelty, all features of the claim must be directly and unambiguously disclosed, noting however that determining whether a feature is directly and unambiguously disclosed by a piece of prior art is not a matter of fact but the result of a legal assessment.

1.12.3 As noted above, the opposition division's legal assessment was that it could not be determined that the pivot was inside the recess. As stated above, the board would only question the validity of this assessment if it were clearly based on wrong legal principles or obviously faulty logic, which the board does not consider to be the case here, in particular because the video D14 supports the findings of the opposition division. In this respect, the close up image of the mouse about 40 seconds into the short video of D14 (which corresponds to the screenshot submitted at the oral proceedings before the board) and the motion observable in the video rather give the impression that the pivot is somewhere near the level of the surface of the housing, but it cannot be determined or inferred whether or not it is in the unseen recess. Hence, the board concludes that features i and i.1 are new with respect to the prior use D1.

1.13 Re features h and k:

1.13.1 In the board's view, these features are to be interpreted broadly. In this respect, the board takes the view that the bellows, being above the recess, can be regarded as a "circumferential support portion" within the meaning of claim 1, provided that it performs a supporting function (see below, next paragraph). Further, the term "end position" in the board's view embraces both the maximum displacement in a particular direction when the grip element is moved by hand as well as the position at which the grip element comes to rest when let go. If the bellows structure, due to its stiffness, supported the grip element when let go such that its inclination were limited, e.g. in a vertical position, this would fall

within the scope of feature k, since the grip element abuts against the bellows at all times and, as regards the feature "such that, in the end position, the grip element is always readily at hand", a more or less vertically inclined grip element at rest or held in the hand is always readily at hand.

1.13.2 As to whether the bellows performs a supporting function in the end position, the respondent at the oral proceedings stated that it assumed that the bellows provided a restoring force, but this could not be said with certainty. Hence, the respondent concluded that there was no direct and unambiguous disclosure of a support means. The board accepts this argument. The board concludes that features h and k are novel with respect to the prior use D1.

1.13.3 The respondent argued at the oral proceedings that there were further differences between features h and k and prior use D1, namely: (i) the bellows of D1 were not part of the recess but external to it, which meant that D1 did not disclose the feature "which recess has a circumferential support portion" because the skilled person would understand the circumferential support portion as being the walls of the recess; (ii) the feature "the grip element is always readily at hand" applied both when the grip element was let go and (not or) when held in the hand, which was not the case in D1.

The board found these arguments unconvincing.

Re (i): The expression "which recess has a circumferential support portion" does not exclude that the circumferential support portion is external to the recess, in the same way as it would be possible to

define a feature "which recess has a cover" in which the cover was external to the recess.

Re (ii): Feature k defines a single end position, which embraces a near-vertical position. In order to be always readily at hand, it makes no difference whether the grip element is held in this position in the hand or arrives at this position by being let go.

1.14 On the basis of points 1.12 and 1.13.1 and 2 above, the board concludes that features h, i, i1 and k are novel features with respect to the prior use D1.

2. *Claim 1 - inventive step starting out from prior use D1*

2.1 Re features h and k: Even if not a direct and unambiguous disclosure, the respondent was of the opinion that the bellows were probably intended to provide a restoring force so that when the grip element was let go, it would return to an approximately vertical position. When arguing its case in favour of inventive step, the respondent even assumed this to be the case. It follows that giving the bellows a supporting function such that the grip element is restored to a vertical or near-vertical end position does not contribute to inventive step. Consequently, features h and k do not contribute to inventive step.

2.2 Re features i and i1: In the view of the board, the problem to be solved starting out from the prior art D1 can be seen as how to design means to connect the grip element to the base element such as to enable the grip element to pivot about a point approximately in the same position as that deducible from the prior use D1, and not rotate about its own axis; in other words, to provide a connection between the grip element and the



base element which emulates as far as possible the appearance and degree of motion observable in the video D14.

2.3 The respondent disagreed with this formulation of the problem as the model of D1 had already solved this problem. The board notes however that although D1 had solved the problem, the skilled person did not know how it had been solved. Thus, the problem to be solved boils down to implementing the said connection within a computer input device of the type as known from the video D14.

2.4 In order to solve this problem, the board considers that the skilled person on the basis of common general knowledge would consider various known universal joints which provide such motion, such as a ball and socket joint, or the type of well-known universal joints shown in Figs. 13a to 13c of the patent. On the basis of the model, from which only an approximate location of the pivot can be determined, the skilled person would look to locate the joint somewhere near the level of the top surface of the base element where the recess is located. This would embrace a small range of pivot locations extending from slightly above the recess to slightly inside the recess, bearing in mind the possible variations in the size and construction of the universal joint. The board cannot see that it makes any difference at least with respect to the supporting function whether the bottom of the grip element were located slightly above the recess or marginally inside the recess. The skilled person would thereby arrive in an obvious way at a computer input device as claimed in claim 1.

- 2.5 The respondent argued that there was a non-obvious technical benefit of making the grip element extend into the recess in that the user had more precision the closer the point of connection was to the support surface on which the device is placed. Even a small distance achieved an improvement. Inventiveness lay not in a specific distance but in moving the pivot any distance closer to the support surface.
- 2.6 However, the board points out that even if for the sake of argument the user would notice an improved precision if the pivot were located only very slightly inside the recess as compared with just outside the recess, this argument is not relevant because locating the joint just inside the recess in any case falls within the small range of options to be obviously considered by the skilled person when solving the technical problem (see point 2.4 above).
- 2.7 The respondent also suggested that the skilled person would be aware of another application D3 (= WO 01/01233 A1) of the inventor of the patent in suit and would be led by it to design the pivot as a protrusion, i.e. as an external pivot. The skilled person would therefore not arrive at a solution in which the grip element extends into the recess.
- 2.8 The board notes that D3 is relevant in that it suggests the combination of a universal joint and a bellows used to maintain the position of the grip element (cf. page 9, lines 1 to 3), although no detailed example is shown of this embodiment, so that the exact shape and size of the joint in relation to the housing is not clear. However, even assuming that this joint was intended to be mounted on a protrusion which sits on top the housing in D3 (cf. Figs. 1 to 4), the objective problem

starting out from D1 is to design a connection which as far as possible emulates the pivotal motion observed in the prior use D1, noting that D1 is accepted as having a recess under the bellows and has an approximate location of the pivot close to the surface of the housing. If the skilled person were to try to base a solution on D3, the protrusion would plausibly have to be located in the recess in order that the pivot point would be located close to the surface of the housing as required by D14. Consequently, the respondent's argument is not convincing.

- 2.8.1 Consequently, the board concludes that the subject-matter of claim 1 does not involve an inventive step (Articles 52(1) and 56 EPC).

3. *Second and third auxiliary requests - admissibility*

- 3.1 The appellant requested in the letter dated 3 April 2018 that these requests be not admitted pursuant to Articles 12(4) and 13 RPBA, as the requests could have been presented during the first instance proceedings and there was no reason for filing the requests so shortly before the oral proceedings.
- 3.2 The board notes that the requests were submitted two months before the oral proceedings and claim 1 of the requests are respectively based on a straightforward combination of claims as granted (second auxiliary request: claims 1, 5 and 6 ; third auxiliary request: claims 1, 5, 6 and 9). All claims were attacked by the opponent in the notice of opposition. Consequently, no fresh case has arisen. Furthermore, having regard to the preliminary view of the opposition division set out in the communication accompanying the summons to oral proceedings in favour of rejecting the opposition, it

is understandable that the proprietor did not file precautionary auxiliary requests during the opposition procedure.

3.3 Given that the board expressed a preliminary opinion taking a view which differed from that of the opposition division, the board finds it a reasonable reaction to the development of the opposition appeal proceedings that the respondent be allowed to file auxiliary requests based directly on claims as granted, especially as the requests were filed in good time before the oral proceedings.

3.4 The board therefore exercised its discretionary power under Article 13(1) RPBA by admitting the second and third auxiliary requests.

4. *Second auxiliary request - claim 1 - inventive step*

4.1 Claim 1 of the second auxiliary request differs from claim 1 of the main request in that the latter includes the features "wherein the grip element is pivotably arranged by a joint which is provided in the recess, and wherein the joint is an essentially frictionless joint".

4.2 In the discussion with respect to claim 1 of the main request the board already concluded that it would be obvious to provide a joint in the recess to carry out the pivotal motion observed in the prior use D1.

4.3 With respect to the "essentially frictionless joint", the respondent argued that the bellows provided a restraining force so that the joint in D1 was not frictionless.

- 4.4 The question to be answered here is whether the "joint" in the prior use D1 is to be regarded as the combination of the bellows and whatever connecting arrangement is present providing the pivotal motion, or whether only the latter is to be regarded as the joint.
- 4.5 In this respect, when reading the features of D1 onto the features of claim 1, the board notes that the bellows are considered to be the circumferential support portion and are not "in the recess". Therefore, it is consistent with that interpretation to consider as the joint only the pivotal mechanism in the recess without the bellows.
- 4.6 As the board already concluded that it would be obvious to provide a pivotal joint in the recess, the only further point to consider is whether this pivotal joint would be "essentially frictionless". In fact, the respondent did not deny that this would be obvious, in particular as it would aid the effect of the bellows in restoring the grip element to a near vertical position.
- 4.7 Consequently, the board concludes that the subject-matter of claim 1 of the second auxiliary request does not involve an inventive step (Articles 52(1) and 56 EPC).
5. *Third auxiliary request - claim 1 - inventive step starting out from D1*
- 5.1 Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request in that the former includes the additional feature "and wherein the housing is integral with the recess walls and one part of the joint".

- 5.2 This feature in the board's view has clarity issues, since the "recess walls" do not have an antecedent basis and the meaning of the term "integral" is not clear in this context. However, in accordance with G 3/14, no objection on the ground of lack of clarity under Article 84 EPC is possible. The board interprets this feature in the light of the description as follows.
- 5.3 In paragraph [0050] of the patent, it is stated that "The upper surface 7 is integral with a front recess wall 12 protruding from the top surface 7 into the recess". Therefore, it is clear that the recess wall is not merely to be understood as the inner surface of the rim having the thickness of the top surface of the housing, but is to be understood as an extra surface protruding below the top surface. Further, the wall of the recess is not merely the inner surface of the outer casing of the housing, since it would make no sense to define such a wall of the housing as being integral with the housing.
- 5.4 As to the meaning of the term "integral", the respondent argued that this meant "one piece". The appellant argued that integral did not necessarily mean either one piece or one material. For example, an object composed of different components out of different materials could be produced as one item by means of injection moulding.
- 5.5 The board notes that in accordance with Fig. 3, the front recess wall 12 is solidly joined to the top surface of the housing 1, and in accordance with Fig. 1, a part of the joint 15 is solidly joined to the bottom surface of the housing. Nothing more can be derived from either the description or drawings. The

board therefore interprets "integral" in the present context to mean "solidly joined to form a whole with the housing".

- 5.6 The respondent argued that these features made the device easier to manufacture and more robust.
- 5.7 Starting out from D1 the skilled person has no teaching in the prior art or common general knowledge which would teach how the putative universal joint would be mounted within the recess, all the more so as the grip element of D1 is also able to move in a vertical direction with a restoring force such as to make a "click" action with the mouse. It is therefore not obvious that the joint, even if designed as universal joint providing a pivot motion and no rotation, would have a part integral with the housing.
- 5.8 The appellant argued at the oral proceedings that the addition of these features, especially given the broad meaning to be given to the term "integral", was obvious. With regard to the click motion, it was further obvious that this functionality could be provided using buttons on the grip element in order to simplify the construction. The appellant further argued in the statement of grounds of appeal that these features were known from D7.
- 5.9 The board however does not agree. Starting out from D1 the skilled person has already made a number of steps (locating the pivot point, choosing a suitable joint, making it frictionless). The skilled person would now have to take three further steps (providing recess walls and making the recess walls and part of the joint integral with the housing). Given the large number of steps and in consideration of the reasons given above

in point 5.7, the board considers that the skilled person would not arrive at the claimed solution without the benefit of hindsight. As regards D7, this device is of a very different type to D1 and therefore not obviously compatible with it. Furthermore, the skilled person would not combine D1 and D7 to solve the objective problem because D7 does not provide a grip element which is constrained from rotating about its own axis, as will be explained in more detail below. The board therefore finds the appellant's arguments unconvincing.

5.10 The board concludes that the subject-matter of claim 1 starting out from D1 involves an inventive step (Articles 52(1) and 56 EPC).

6. *Third auxiliary request - claim 1 - inventive step starting out from D7*

6.1 The appellant further argued at the oral proceedings that claim 1 of the third auxiliary request did not involve an inventive step when starting out from document D7.

6.2 Considering firstly claim 1 as granted in the light of D7, the board notes that although D7 describes a very different type of computer input device as compared with the embodiments disclosed in the present patent, due to the broad wording of claim 1 all features with the exception of feature j appear to read onto the disclosure of D7 (although the respondent further argued that feature k was also not disclosed, but that is not relevant to the board's decision), feature j being the feature:



"where [i.e. in the recess] it [i.e. the grip element] is prevented from rotating relative to the base element round its connection axis".

6.3 The appellant argued that feature j was disclosed in D7, col. 4, lines 24-34. However, the board agrees with the respondent that this passage is concerned with the prevention of the rotation of magnet 20 about the carrier. This concerns an entirely different aspect and is not relevant to feature j, which is related to the rotation of the "manipulator" 57 about the axis of the shaft 58 (cf. D7, Fig. 5).

6.4 In D7, the "manipulator" is designed to move either forward-and-back or side-to-side (cf. col. 6, lines 30-52). As stated in col. 6, lines 46-52: "It is evident, from the radial symmetry of the hemispherical edge portion of the magnet 59, that the differential saturation of the pairs of cores 60 independently senses the forward-and-back, and side-to-side, displacement of the manipulator 56 regardless of any rotation of the carrier 51 about the axis of the shaft 58." (Board's underlining).

6.5 Thus, in D7, the shaft can rotate about its axis. With regard to inventive step, the question to be answered is whether or not it would be obvious to prevent rotation around the axis of the shaft 58.

6.6 The board considers that this would not be obvious since the skilled person would have no motivation to prevent rotation. This would not improve the functioning of the device in any way but merely add complexity. Furthermore, it is not evident to the board how rotation about the axis of the shaft of D7 could easily be prevented. At the oral proceedings, the

appellant could not suggest how this could easily be done either.

6.7 It follows that starting out from D7, the skilled person would not arrive in an obvious way at the subject-matter of claim 1 of the main request. This reasoning applies, *mutatis mutandis*, to claim 1 of the third auxiliary request. The board concludes that the subject-matter of the third auxiliary request involves an inventive step when starting out from D7.

7. *Conclusion*

The ground for opposition pursuant to Article 100(a) EPC does not prejudice the maintenance of the patent as regards claim 1 in accordance with the third auxiliary request. However, the board has not examined whether the dependent claims comply with the EPC in view of the amendments to claim 1, nor considered whether the description and/or drawings require adaptation. In consequence, the case is to be remitted to the opposition division for further prosecution.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 11 of the third auxiliary request filed with the letter dated 2 March 2018.

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated