

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 20 July 2017**

Case Number: T 0914/13 - 3.2.06

Application Number: 08254121.0

Publication Number: 2075188

IPC: B62M25/06, B62K23/08,
B62K11/00, B62J17/00,
B62J23/00, B62J25/00

Language of the proceedings: EN

Title of invention:
Straddle-type vehicle

Applicant:
Yamaha Hatsudoki Kabushiki Kaisha

Headword:

Relevant legal provisions:

EPC Art. 84, 111(1)
EPC R. 48(1)(c), 71(3)

Keyword:

Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 0914/13 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 20 July 2017

Appellant: Yamaha Hatsudoki Kabushiki Kaisha
(Applicant) 2500 Shingai
Iwata-shi
Shizuoka-ken 438-8501 (JP)

Representative: Moreland, David
Marks & Clerk LLP
Aurora
120 Bothwell Street
Glasgow G2 7JS (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 30 October 2012
refusing European patent application No.
08254121.0 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman M. Harrison
Members: M. Hannam
W. Ungler

Summary of Facts and Submissions

- I. The appellant (applicant) filed an appeal against the decision of the examining division refusing European patent application No. 08254121.0.
- II. At oral proceedings before the examining division, the pending main request and all auxiliary requests (1, 1a, 1b, 1c and 2 to 6) were found not allowable. A single new auxiliary request was filed to replace all the auxiliary requests on file which was found to meet the requirements of the EPC. In response to the communication under Rule 71(3) EPC, the applicant requested that a patent be granted with claims corresponding to the main request, in the alternative according to auxiliary request 1a, both as on file at the start of the foregoing oral proceedings. The examining division found in its decision that the subject-matter of claim 1 of the main request did not meet the requirement of Article 123(2) EPC; auxiliary request 1a was not admitted into the proceedings under Rule 137(3) EPC.
- III. With its grounds of appeal, the appellant requested that the decision under appeal be set aside and a patent be granted according to a main request, in the alternative that a patent be granted according to one of auxiliary requests 1 to 7.
- IV. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that the subject-matter of claim 1 of the main request appeared not to meet the requirement of Article 123(2) EPC. As regards auxiliary requests 1 to 6, the Board indicated its intent not to admit these as they had been

withdrawn (albeit numbered then as auxiliary requests 1, 1a, 1b, 1c, 2 and 3) during the oral proceedings before the examining division. Claim 2 of auxiliary request 7 was further considered not to meet the requirements of Article 84 EPC. The Board also stated that the question of whether the subject-matter of claim 1 involved an inventive step might need to be discussed.

- V. With letter of 25 May 2017 the appellant filed a replacement main request based on auxiliary request 7 filed with the grounds of appeal. The main request and auxiliary requests 1 to 6 filed with the grounds of appeal were renumbered as auxiliary requests 1 to 7.
- VI. With its communication of 9 June 2017 the Board reiterated its objection to claim 2 of the main request (previously claim 2 of auxiliary request 7), noting that the appellant had not addressed this in any way.
- VII. With letter of 20 June 2017 the appellant filed a new main request based on that previously pending, with claim 2 deleted. The request included replacement description pages 1 to 3, 3a and 3b. The appellant also included arguments concerning inventive step.
- VIII. Oral proceedings were held before the Board on 20 July 2017 in the absence of the appellant.

The appellant requested in writing that the decision under appeal be set aside and a patent be granted on the basis of the main request filed with letter dated 20 June 2017, auxiliarily on the basis of one of auxiliary requests 1 to 7, filed with the statement of grounds of appeal as the main request and as first to

sixth auxiliary requests.

IX. Claim 1 of the main request reads as follows:

"A straddle-type vehicle (1000) comprising:
a body frame (100);
an engine (200);
an operation pedal (250) pivotally extending to a side portion of the engine (200) and comprising a pedal portion (253); and
an under cowl (300) covering the side portion of the engine (200), wherein the under cowl (300) extends between the side portion of the engine and the pedal portion (253); and wherein a region of the under cowl (300) extending between the side portion of the engine (200) and the pedal portion (253) faces a side portion of an oil reservoir (210) of the engine (200); wherein the body frame (100) includes a footrest bracket (132) to which a footrest (131) is attached and a region of the under cowl (300) extending between the side portion of the engine (200) and the pedal portion (253) is fixed to the footrest bracket (132)."

X. The appellant's arguments may be summarised as follows:

Except for claim 2 having been deleted, the claims of the main request corresponded to those on the basis of which the examining division had issued its communication under Rule 71(3) EPC during the examination proceedings.

Reasons for the Decision

Main request

1. *Remittal according to Article 111(1) EPC*

The Board avails itself of its power under Article 111(1) EPC to remit the case back to the examining division for further prosecution.

- 1.1 With respect to the main request, the appellant argued that a Rule 71(3) EPC communication had been previously issued by the examining division on 16 May 2012. Nevertheless the Board is not bound to find the claims allowable merely by the existence of this communication, nor is the examining division. The request has anyway changed from that considered previously.

Further, the appellant has supplied written arguments concerning inventive step.

- 1.2 At least the following matters appear to require consideration by the examining division:

- (a) The dependency of claim 2 reads 'according to any preceding claim'. Whilst this might normally be understandable in the context of the claims alone as meaning the same as 'according to claim 1', page 3, lines 14 and 15 of the description refer to a plurality of both independent and dependent claims which are not present. The resulting inconsistency between the claims and the description appears *prima facie* to result in a lack of clarity and lack

of support by the description (Article 84 EPC).

- (b) The two paragraphs of the description from page 3a, line 12 to page 3b, line 6 are indicated as being 'described herein by way of information only'. These paragraphs, at least *prima facie*, appear to be 'obviously irrelevant' for the invention (Rule 48(1)(c) EPC).

2. For the avoidance of doubt, it should be noted that the Board has not concluded that the subject-matter of claim 1 of the main request involves an inventive step. Since the decision to reject the application only deals with other matters, it appears fitting that the appellant should have a possibility to have its arguments considered at two instances should this be required.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated