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**Datasheet for the decision
of 19 January 2017**

Case Number: T 2283/14 - 3.2.03

Application Number: 08780030.6

Publication Number: 2179111

IPC: E04H12/32, E02D5/80, E04H12/22,
A63C19/06

Language of the proceedings: EN

Title of invention:

DELINEATING POLE HAVING AN ANCHORING BASE AND SPRING CARTRIDGE
FOR SNOW BASED APPLICATIONS

Patent Proprietor:

MBW Technologies, LLC

Opponent:

B-Stedt of Sweden AB

Headword:

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Amendments - added subject-matter (no)

Decisions cited:

Catchword:



Beschwerdekammern
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Case Number: T 2283/14 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 19 January 2017

Appellant: B-Stedt of Sweden AB
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 9 October 2014 rejecting the opposition filed against European patent No. 2179111 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman G. Ashley
Members: C. Donnelly
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division rejecting the opposition against European Patent No. EP-B-2 179 111.

Grant of the patent was opposed only on the basis of Article 100 (c) EPC. In its decision the opposition division held that the omission of the word "subsequent" from claim 1 as granted in the expression "upon subsequent rotation of said anchoring base, said plurality of mechanical members bend or reconfigure" used in claim 1 of the original application did not lead to an infringement of Article 123(2) EPC. In its view the word "subsequent" was superfluous since no interpretation other than "subsequent rotation" was possible in the context of the claim.

- II. The opponent (hereinafter: the appellant) filed an appeal against this decision in due form and time. It requested that the decision be set aside and that the patent be revoked.

The proprietor (hereinafter: the respondent) requested that the appeal be dismissed.

Only the respondent requested oral proceedings.

- III. Claim 1 as granted reads:

"Anchoring base (30, 82) for a delineator pole for snow based applications comprising an insertion rod (36, 90) having a longitudinal axis, characterized by said insertion rod (36, 90) including a plurality of resilient mechanical members (38, 88) extending

outwards relative to said insertion rod longitudinal axis, said plurality of resilient mechanical members (38, 88) comprising a plurality of bristles or bristle tufts, said plurality of resilient mechanical members (38,88) bending or configuring upon insertion of said anchoring base (30, 82), into a first position or configuration that facilitates insertion while impeding and resisting axial extraction forces, and upon rotation of said anchoring base (30,82), said plurality of mechanical members (38, 88) bending or reconfiguring into a second position or configuration reducing said anchoring base extraction resistance force."

Claim 1 as originally filed reads:

"Anchoring base for a delineator pole for snow based applications comprising an insertion rod having a longitudinal axis, said insertion rod including a plurality of resilient mechanical members extending outwards relative to said insertion rod longitudinal axis, said plurality of resilient mechanical members bending or configuring upon insertion of said anchoring base into a first position or configuration that facilitates insertion while impeding and resisting axial extraction forces, and upon **subsequent** rotation of said anchoring base, said plurality of mechanical members bending or reconfiguring into a second position or configuration reducing said anchoring base extraction resistance force."

IV. The arguments of the parties can be summarised as follows

(a) *Appellant*

Claim 1 of the application as filed specified that "upon subsequent rotation of said anchoring base, said plurality of mechanical members bend or reconfigure", in claim 1 as granted the word "subsequent" has been deleted leading to an infringement of Article 123(2) EPC since it is essential to the invention that rotation of the anchoring base "subsequent" to its insertion in the snow pack takes place in order to allow its removal.

The text of the application as filed refers to subsequent rotation of the anchoring base, but never to only "rotation of the anchoring base" see for example the WO publication page 4, line 27 or page 5, line 15.

In principle, a limitation may be deleted from a claim if the deletion satisfies three criteria namely that:

- 1) The deleted feature has not been explained as essential in the disclosure;
- 2) That the feature is not indispensable for the invention in light of the technical problem the invention serves to solve; and
- 3) The replacement or removal of the feature requires no real modification of other features to compensate for the change.

In the present case, the removal of the word "subsequent" is inadmissible since the deletion fails to satisfy any of the criteria above.

It is clear from the description (see the WO publication on page 7, lines 19 to 27 in combination with 10, lines 14 to 25) that the resilient mechanical

members (38, 88) will bend or reconfigure when the anchoring base is first inserted into the snow and that subsequent rotation of the anchoring base is required (see page 10, line 20) to cause the resilient mechanical members to reconfigure once again such that the base extraction resistance is reduced.

It is evident from page 10, lines 18 to 20 that subsequent rotation is essential, since the expression "required" states that there is no alternative "to extract a slalom pole having a base 82 of the present invention", but by use of rotation, which rotation must be performed subsequently.

Paragraph 2.4.1 of the decision indicates that the opposition division drew the same conclusion, i.e. that subsequent rotation is essential. However, the opposition division then reasoned that the term "subsequent" was superfluous, seemingly because it considered that no alternate interpretation but "subsequent rotation" was possible, also without the word "subsequent".

However, without the word "subsequent" it is possible to construe claim 1 to cover embodiments where no actual rotation is performed, e. g. also to cover poles using the principle ("push in/pull out") shown in DE 8518438U, wherein no rotation is needed to extract the pole, because amended claim 1 in its broadest sense may be read to encompass also the above known poles, if rotation (hypothetically) would reduce extraction resistance.

Accordingly, the term "subsequent" cannot be seen as superfluous. This is also confirmed by the fact that the applicant has requested its deletion. If the word

"subsequent" was really superfluous and did not affect the scope of claim 1 at all, the Board of Appeal may wish to consider why the patent proprietor objects to re-introducing this word into claim 1. It would have been possible for the patent proprietor to terminate the opposition proceedings at a very early stage by simply putting the word "subsequent" back into claim 1, thereby saving efforts and costs.

For a pole according to the invention to work, it is necessary that the resilient members first reconfigure when the anchoring base is inserted and that a subsequent rotation is performed to reduce the extraction resistance to extract the pole. Without a subsequent rotation, the invention would not work at all and substantial modification of other parts would be required. Hence, the deletion also does not satisfy criteria 3.

In conclusion, claim 1 as granted contravenes Article 123 (2) EPC.

(b) Respondent

The application as filed refers at several places to only "rotation of the anchoring base". In particular, see page 5, lines 26, 27 of the published application "by rotating the anchoring base"; page 10, lines 18 to 20 "a rotation 84 about the slalom pole's longitudinal axis 86 is required"; page 10, line 27; "in order to facilitate rotation during slalom pole extraction"; page 10, line 31 to page 11, line 2 "In this manner rotation of the slalom pole shaft or spring cartridge"; page 11, lines 29 to 31 "to allow the user to rotate the base in the desired manner"; page 12, lines 15 to 16 and 18 to 21 "one may simply rotate the anchoring

base and pull upwards" and "Or one may rotate the twist the shaft, anchoring base itself.

Original claim 30 (now granted claim 11) states "rotating said anchoring base includes rotating said delineating pole".

Thus, throughout the description the wording "upon rotation of said anchoring base" instead of "upon subsequent rotation of said anchoring base" is clearly and unambiguously disclosed. Even if the word "subsequent" is not explicitly stated, the occurrence of the anchoring base extraction takes place after, or subsequent to the anchoring base being inserted. This is clear from granted claim 1 as well as from the original disclosure.

Thus, the word "subsequent" is dispensable for the function of the invention since already from the original description it is clear that rotation of the anchoring base is to be performed after said anchoring base has been inserted into the snow pack.

The skilled person would clearly and unambiguously understand from claim 1 that, as a first step, the anchoring base is to be inserted into the snow and that, as a second step, said anchoring base is to be rotated such that said anchoring base extraction resistance force is reduced. Thus, it is self-evident that an anchoring base extraction resistance force can only be reduced if, as a first step, said anchoring base has been inserted into the snow pack.

On page 10, lines 18 to 20 of the WO publication in contrast to the statement of the appellant it is only stated that a rotation is required.

Any question how to construe claim 1 to cover embodiments is neither to be answered during the examination procedure nor during an opposition procedure nor during any appeal procedure before the EPO. Such possibilities, if any, are to be taken into account before litigation courts.

Furthermore, the allegation of the appellant that claim 1 may cover embodiments where no actual rotation is performed is not correct.

Reasons for the Decision

1. The appellant has not requested oral proceedings and the respondent's request in this respect was conditional - i.e. only in the event that the Board intended to allow the appeal, however, this is not the case. Consequently, under Article 12(5) of the Rule of Procedure of the Boards of Appeal, the Board is in a position to make its decision on the basis of the parties' written submissions.
2. Claim 1 as granted differs from claim 1 as originally filed in that the word "subsequent" has been deleted from the expression "upon subsequent rotation of said anchoring base" and in that "said plurality of resilient mechanical members" are specified as "comprising a plurality of bristles or bristle tufts".
3. The specification that the plurality of resilient mechanical members comprises a plurality of bristles or bristle tufts is disclosed in original claim 13 of the

application. Therefore, this amendment meets the requirements of Article 123(2) EPC. Hence, the only issue remaining to be addressed is whether the deletion of the word "subsequent" has led to an extension of subject-matter.

4. The board understands "subsequent" to mean "happening or coming after something else" (see for example: <http://www.merriam-webster.com/dictionary/subsequent>).

Although claim 1 is directed at a device, it employs functional features relating to the use of the apparatus to define the essential constructional characteristics. Thus, the plurality of resilient mechanical members are defined as:

(i) bending or configuring upon insertion of said anchoring base (30, 82), into a first position or configuration that facilitates insertion while impeding and resisting axial extraction forces, and

(ii) upon rotation of said anchoring base (30, 82), said plurality of mechanical members (38, 88) bending or reconfiguring into a second position or configuration reducing said anchoring base extraction resistance force.

There can be no doubt that the extraction of the anchoring base can only happen after it has been inserted or, in accordance with the above dictionary definition: extraction is subsequent to insertion. This sequence of events is further reinforced by the claim's reference to a "first position" and a "second position". Therefore, within the context of the present claim language the meaning of the expression "upon subsequent rotation of said anchoring base" is

identical to "upon rotation of said anchoring base" since the word "subsequent" is a tautology.

5. In view of this, there is no need to discuss the appellant's arguments concerning the criteria relating to whether a feature may be deleted from a claim since no feature has in fact been deleted as a result of the amendment. It follows also that there is no need to look for any further basis for the amendment in the description of the application as filed.
6. The appellant has submitted that without the word "subsequent" it is possible to construe claim 1 to cover embodiments where no rotation is required in order to extract the pole, as is disclosed for example in DE8518438U. However, the board has already answered this argument by judging that the deletion of the word "subsequent" does not change the technical meaning of the claimed subject-matter. Determining whether the subject-matter of DE8518438U falls within the scope of the claim is not necessary for the issue of added subject-matter.
7. In conclusion, the board considers that the term "subsequent" is a tautology in the context of claim 1 as filed since the rotation must occur after (i.e. subsequent to) the insertion of the anchoring base in the snow-pack. Since the word "subsequent" is redundant, its deletion from claim 1 as filed has no effect on the extent of the subject-matter of the claim.

Consequently, claim 1 as granted meets the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Spira

G. Ashley

Decision electronically authenticated