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**Datasheet for the decision
of 9 February 2022**

Case Number: T 2178/17 - 3.2.07

Application Number: 08830658.4

Publication Number: 2199033

IPC: B25F5/02, B25F5/00, H01M2/10

Language of the proceedings: EN

Title of invention:
HAND-HELD ELECTRIC TOOL

Patent Proprietor:
Makita Corporation

Opponents:
Metabowerke GmbH
Minim Law Limited

Headword:

Relevant legal provisions:
RPBA Art. 12(4)
RPBA 2020 Art. 13(2), 11
EPC Art. 83, 84, 123(2), 111(1)
EPC R. 103(4)(a)

Keyword:

Late-filed request - amendment to the patent proprietor's appeal case (no) - request could have been filed in first instance proceedings (no) - admitted (yes)
Amendment after summons - new objections - cogent reasons (no) - new objections - exceptional circumstances (no) - new objections - taken into account (no)
Claims - clarity (yes)
Sufficiency of disclosure - (yes)
Amendments - allowable (yes)
Description brought in conformity with an allowable set of claims - submitted after summons - amendment to a party's case (no)
Reimbursement of appeal fee paid by the patent proprietor - withdrawal of appeal

Decisions cited:

G 0003/14, T 0182/89, T 0019/90

Catchword:



Beschwerdekammern
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Case Number: T 2178/17 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 9 February 2022

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
27 July 2017 concerning maintenance of the
European Patent No. 2199033 in amended form.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Cano Palmero
 S. Watson

Summary of Facts and Submissions

- I. Opponents 1 and 2 (appellants 1 and 2) both lodged appeals within the prescribed period and in the prescribed form against the decision of the opposition division to maintain European patent No. 2 199 033 in amended form on the basis of the then first auxiliary request.
- II. Two oppositions were filed, which were directed against the patent in its entirety and based on all grounds for opposition pursuant to Article 100 EPC.
- III. The patent proprietor, who had also lodged an appeal against the decision, withdrew the appeal during the oral proceedings before the Board on 9 February 2022, thereby remaining as respondent in the present case. Pursuant to Rule 103(4)(a) EPC, the appeal fee paid by the patent proprietor is reimbursed at 25%.
- IV. In preparation for oral proceedings, scheduled upon the parties' requests, the Board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA 2020. The Board indicated that the then pending appeal of the patent proprietor was likely to be dismissed, whereas the opponents' appeals were likely to be allowed.
- V. In response to the communication under Article 15(1) RPBA 2020, the patent proprietor submitted arguments and auxiliary requests I to IV with letter dated 7 September 2020. Opponent 2 responded substantively with letter of 27 July 2021.

VI. Oral proceedings before the Board took place on 9 February 2022.

At the conclusion of the proceedings the decision was announced. Further details of the proceedings can be found in the minutes thereof.

VII. The final requests of the parties are as follows,

for opponents 1 and 2

that the decision under appeal be set aside and that the patent be revoked;

for the patent proprietor

that when setting aside the decision under appeal, the patent be maintained on the basis of the claim according to auxiliary request IV filed with letter of 7 September 2020, corresponding to auxiliary request III filed with the reply to the opponents' statements of grounds of appeal on 13 April 2018 (dated 23 April 2018);
with the description paragraphs 1 to 13, 15 to 33 of the patent specification and paragraph 14 submitted during oral proceedings on 9 February 2022 as auxiliary request V, and figures 1 to 4 of the patent specification.

VIII. The lines of argument of the parties relevant for the present decision are dealt with in detail in the reasons for the decision and address the following issues:

- admittance into the proceedings of the single claim according to auxiliary request IV;

- admittance into the proceedings of the objections under Articles 56, 83, 84 and 123(2) EPC against the claim according to auxiliary request IV;
- allowability of the amendments made to the claim according to auxiliary request IV in view of the admissibly raised objections;
- clarity and sufficiency of disclosure of the claim according to auxiliary request IV in view of the admissibly raised objections;
- admittance into the proceedings of the amended description paragraph according to auxiliary request V;
- objections of lack of clarity occasioned by the amended description paragraph according to auxiliary request V.

IX. The single claim according to auxiliary request IV reads as follows:

"A hand-held electric tool (1) comprising:
an electric motor (4);
a tool main body (2) of a generally columnar configuration having the electric motor (4) disposed therein;
a handle portion (10) protruding from a side portion of the tool main body (2);
a chuck (3) provided at a forward end of the tool main body (2);
wherein:
 a tool body main housing (6) of the tool main body (2) and a handle housing (11) of the handle portion (10) are formed integrally with each other;
 the handle portion (10) has a base portion and a leading end portion,
 the handle portion (10) has a thickness and a sectional configuration suited to be grasped by a user with one hand;

a trigger switch lever (5) arranged on a front side of the base portion of the handle portion (10), the electric motor (4) being started by pulling the trigger switch lever (5) by a finger; and

a rechargeable type battery pack (20) loaded in the handle portion (10) and attached to the leading end portion of the handle portion (10), wherein:

the battery pack (20) has a battery case (24) and three battery cells (21, 22, 23) disposed therein; and

the battery cells (21, 22, 23) are arranged in a triangular fashion,

characterized in that

the battery cells (21, 22, 23) are arranged in a triangular fashion in which one battery cell (23) of the three battery cells is arranged on a front side and the other two battery cells (21, 22) are arranged on a rear side of the one battery cell (23) while being arranged laterally side by side, and wherein the apex portion (11a) of the triangle is situated on a front side and the base (11b) of the triangle is situated on a rear side with respect to the tool main body (2),

the battery pack has a triangular cross-sectional configuration corresponding to the triangular arrangement of the battery cells, wherein the apex portion (11a) of the triangle is situated on the front side and the base (11b) of the triangle is situated on the rear side with respect to the tool main body (2),

and

the handle portion (10) has a triangular cross-sectional configuration corresponding to the triangular cross-sectional configuration of the battery pack, wherein the apex portion (11a) of the triangle is situated on the front side and the base (11b) of the triangle is situated on the rear side with respect to the tool main body (2),

wherein the battery pack has a battery case (24) containing the three battery cells (21, 22, 23), a cover portion (24a) at the lower end portion of the battery case (24), which cover portion (24a) serves as a cover covering an interior battery accommodation space of the handle housing (11) of the handle portion (10), and a pair of right and left fixation claw portions (24b; 31, 32) provided on right-hand and left-hand side portions of the cover portion for engagement with the handle housing (11) of the handle portion (10) to maintain the battery pack (20) in an attached state."

Reasons for the Decision

1. *Revised Rules of Procedure of the Boards of Appeal (RPBA 2020) - Transitional provisions*

The present proceedings are governed by the revised version of the Rules of Procedure which came into force on 1 January 2020 (Articles 24 and 25(1) RPBA 2020), except for Articles 12(4) to (6) RPBA 2020 instead of which Article 12(4) RPBA 2007 remains applicable (Article 25(2) RPBA 2020).

2. *Admittance of the single claim according to auxiliary request IV - Article 13(2) RPBA 2020 and Article 12(4) RPBA 2007*

- 2.1 Both opponents requested that auxiliary request IV not be admitted into the appeal proceedings. This request was filed by the patent proprietor with letter of 7 September 2020, *i.e.* after notification of the summons before the Board and therefore amounted to an amendment to the patent proprietor's case. In the

absence of cogent reasons that could justify exceptional circumstances for its admittance, auxiliary request IV should not be admitted under Article 13(2) RPBA 2020.

2.2 In addition, both opponents argued that the patent proprietor was aware of the objections as regards Article 123(2) EPC against claim 1 of the patent as granted from the very beginning of the opposition proceedings, namely with the notice of opposition filed by opponent 2 on 11 August 2015. In point 1.1.1.1 of that notice of opposition, opponent 2 argued that *"in general terms ... any omission of features of the embodiment (of paragraphs [0007] to [0010]) extends the subject-matter beyond the content of the application as filed"*. It followed that the patent proprietor could and should have filed auxiliary request IV overcoming this objection already during opposition proceedings, so that the Board should exercise its discretion under Article 12(4) RPBA 2007 not to admit auxiliary request IV into the proceedings.

2.3 The Board disagrees for the following reasons.

2.3.1 Firstly, the Board notices that the claim according to auxiliary request IV had already been filed as the sole claim of auxiliary request III with the patent proprietor's reply to the opponents' statements of grounds of appeal. The Board is convinced that, in consequence, auxiliary request IV cannot be treated as an amendment to the patent proprietor's case made after notification of a summons to oral proceedings, so that Article 13(2) RPBA 2020 does not apply for the question of its admittance into the proceedings.

2.3.2 Secondly, the Board finds that the patent proprietor could not have filed auxiliary request IV during opposition proceedings. While it is true that a general objection as regards Article 123(2) EPC was made with the notice of opposition of opponent 2, this objection was subsequently substantiated only for a limited list of missing features (see page 4, paragraphs 2 to 5, of the notice of opposition of opponent 2), to which the patent proprietor reacted in a timely manner by filing auxiliary requests with letter dated 22 May 2017.

As confirmed by opponent 2 during oral proceedings before the Board, further missing features, such as the omission of the feature "rechargeable type battery pack attached to the leading end portion of the handle portion" were specifically indicated for the first time during oral proceedings before the opposition division.

Since the opposition division decided at that point of time that the relevant objections were overcome by a higher-ranking request (the then modified auxiliary request 1), the Board is convinced that the patent proprietor was not in a position to file a request, such as auxiliary request IV, including all alleged omitted features objected to for the first time at the oral proceedings before the opposition division. It follows that the patent proprietor could not submit the claim of auxiliary request IV during opposition proceedings, and filed it at the earliest possible opportunity, namely as auxiliary request III with its reply to the opponents' statements of grounds of appeal.

Consequently, the Board, exercising its discretion under Article 12(4) RPBA 2007, admits auxiliary request IV into the proceedings.

3. *Admittance of objections under Articles 56, 83, 84 and 123(2) EPC against claim 1 of auxiliary request IV - Article 13(2) RPBA 2020*
- 3.1 Both opponents argued that the single claim of auxiliary request IV did not meet the requirements of Articles 56, 83, 84 and 123(2) EPC.
- 3.2 The Board notes that some of the objections which were relied upon by the opponents against auxiliary request IV were already raised with the opponents' statements of grounds of appeal against the patent as maintained by the opposition division or with their replies to the patent proprietor's appeal against the patent as granted.
- 3.3 The Board however also notes that other objections ("new objections") were only raised for the first time in appeal proceedings by the opponents after notification of the summons to oral proceedings before the Board (*i.e.* after 9 April 2020), either with letter of opponent 2 dated 27 July 2021 or at the oral proceedings before the Board.
- 3.4 These objections constitute amendments of the appeal cases of both opponents and their admittance is subject to Article 13(2) RPBA 2020, which states that such amendments shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the parties concerned.
- 3.5 The opponents argued that these "new objections" had been raised orally and in writing as a direct response to auxiliary request IV. Additionally, the opponents

indicated that since the preliminary opinion expressed by the Board with the communication according to Article 15(1) RPBA 2020 was that auxiliary request III filed with the patent proprietor's reply to the statements of grounds of appeal of the opponents was likely not to be admitted, there was no need to provide substantive arguments against the claim according to auxiliary request III.

3.6 The Board is not persuaded by the arguments of the opponents for the following reasons. The Board notes in particular that the claim according to auxiliary request IV was made available to the opponents as auxiliary request III filed with the patent proprietor's reply of 13 April 2018. The Board is convinced that as almost two years passed between that date and the date of notification of the summons to oral proceedings before the Board (9 April 2020), the opponents had sufficient time to react and to raise the "new objections" as a direct response to the then auxiliary request III. It follows that the reasons provided by the opponents are not cogent reasons that justify exceptional circumstances.

3.7 The Board thus concludes that the objections against claim 1 of auxiliary request IV under Articles 56, 83, 84 and 123(2) EPC are not admitted into the proceedings pursuant to Article 13(2) RPBA 2020 insofar as they do not relate to objections raised in the opponents' statements of grounds of appeal against the patent in its maintained version or in their replies to the patent proprietor's statement of grounds of appeal against the patent as granted.

3.8 For completeness, the "new objections" that did not form part of the opponents' appeal cases and which are

not admitted into the proceedings under Article 13(2) RPBA 2020 include the following objections:

- all objections under Article 56 EPC raised by both opponents either with letter of opponent 2 dated 27 July 2021 (in point 38.b.) or orally at the oral proceedings before the Board;
- objections under Articles 84 and 83 EPC raised by opponent 2 in points 40 to 42 of its letter dated 27 July 2021;
- objections made by opponent 1 for the first time during the oral proceedings before the Board under Article 123(2) EPC:
 - due to the omission in claim 1 of the feature "the battery case has a general triangular configuration";
 - due to the omission of the feature "the rear batteries being in contact with each other";
 - due to the omission of features relating to the grasping of the hand-held tool.

4. *Claim 1 of auxiliary request IV - Amendments, Article 123(2) EPC*

4.1 The opponents argued in their statement of grounds of appeal (page 7, third paragraph of the statement of grounds of appeal of opponent 1 and points 21 to 31 of the statement of grounds of appeal of opponent 2) that the omission of the features of original claim 5 in granted claim 2 or in claim 3 as maintained by the opposition division resulted in an unallowable intermediate generalisation. According to the opponents, this objection also applied to the single claim of auxiliary request IV which does not include the features that

"the fixation claw portions are equipped with finger-rest portions inclined in such directions that they approach to each other toward the apex portion, and the engagement with the handle portion is canceled by pressing the finger-rest portions with fingertips in such directions that they approach to each other; and wherein the battery pack is configured such that the finger-rest portions are provided with anti-slip portions for preventing the fingertips from slipping toward the apex portion."

In the opponents' view these features were not only disclosed in original claim 5 in combination with the other features now present in the claim, but also in the original disclosure, in particular in original paragraph [0011], in combination with each other and with synergistic effects resulting therefrom.

Even if the design with anti-slip portions were to be seen as an additional feature that is not directly and inseparably connected with the other features, it is clear at least from the wording of original claim 5 that the specific design of the fixation claw portions with finger-rest portions inclined in the manner described is necessary in order to disengage the handle portion.

- 4.1.1 The Board disagrees. As correctly reasoned by the opposition division in the first paragraph on page 10 of the decision under appeal with respect to claim 3 as maintained, original paragraph [0011] presents an example according which the embodiment and the disengagement of the battery pack can be carried out, and how "in some cases" anti-slip portions can be provided on the finger-rest portions. The Board is convinced that the skilled person understands from the overall

original disclosure and from original dependent claim 5 that the way of disengaging the battery pack and the anti-slip portions are presented as facultative, non-mandatory features that can be provided to the fixation claw portions and that they are not inextricably linked to the engagement function of the fixation claw portions, so that their omission in the claim according to auxiliary request IV does not contravene Article 123(2) EPC.

- 4.2 Opponent 1 also argued in page 4 of its reply to the patent proprietor's statement of grounds of appeal that the feature that the cross-sectional configuration of handle portion having a generally triangular shape is an essential feature that should be included in the independent claim as maintained by the opposition division.

Further, opponent 1 stated that the omission of the features listed as a. to h. in pages 2 and 3 of the statement of grounds of appeal of opponent 2 resulted in an unallowable intermediate generalisation.

- 4.2.1 The Board however notes that all these features have been included in the claim according to auxiliary request IV, so that these objections have been overcome by the amendments carried out.

- 4.3 It follows that the opponents have not submitted admissible and convincing objections under Article 123(2) EPC that could prejudice the maintenance of the patent based on the claim according to auxiliary request IV.

5. *Claim 1 of auxiliary request IV - Clarity and sufficiency of disclosure, Articles 83 and 84 EPC*

5.1 Both opponents argued (see statement of grounds of appeal of opponent 1, point 4.2) and statement of grounds of appeal of opponent 2, point 33) that claim 1 of the patent as granted and according to auxiliary request IV was not sufficiently disclosed, since the feature that

"the battery cells (21, 22, 23) are arranged in a triangular fashion in which one battery cell (23) of the three battery cells is arranged on a front side and the two other battery cells (21, 22) are arranged on a rear side of the one battery cell (23) while being arranged laterally side by side"

cannot be carried out by the skilled person, so that the requirements of Article 83 are not met. In particular, the opponents were of the view that it cannot be understood how a battery cell can be arranged on a front side of itself, so that the skilled person is left in doubt about how the three-battery arrangement can be reproduced, especially when taking into account that the claim makes no restriction on the particular cross-sections of the batteries.

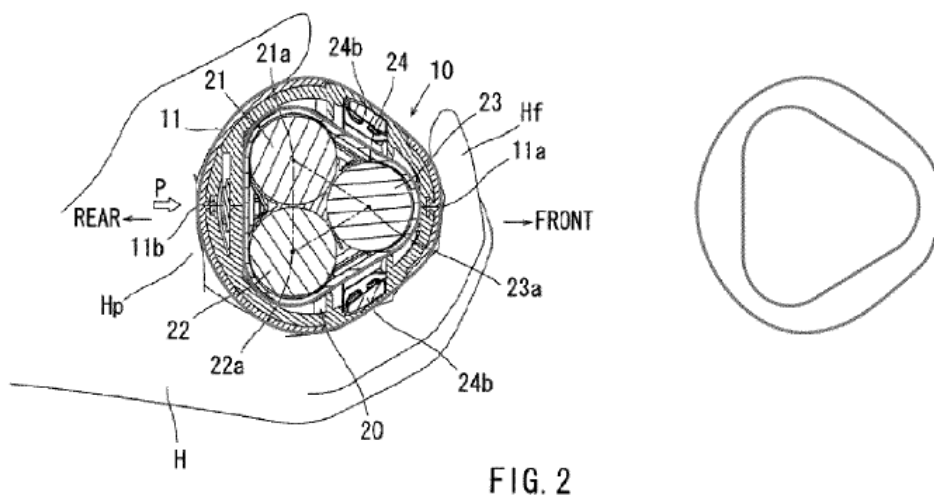
5.1.1 The Board disagrees. As correctly found by the opposition division in point 3.4.4 of the reasons for the decision under appeal, the Board is convinced that the skilled person finds at least in figures 1 and 2 of the patent at least one way of carrying out the invention, namely by interpreting the "front side" as the front side of the entire tool. The Board is further convinced that such a triangular arrangement could also be carried out with batteries having a cross-section

different from the circular cross-section depicted in the embodiment of figures 1 and 2.

5.2 Both opponents further argued in point 4.1) of the statement of grounds of appeal of opponent 1 and in point 34 of the statement of grounds of appeal of opponent 2, that there is no example in the patent regarding how to carry out **feature (a)**:

"a handle portion having a triangular cross-sectional configuration corresponding to the triangular cross-sectional configuration of the battery pack",

as required by the claim according to auxiliary request IV. The opponents relied in their argumentation on the figure included in point 34 of the statement of grounds of appeal of opponent 2, in which the cross-sectional shapes of the battery pack and of the handle portion have been extracted:



5.2.1 According to the opponents, in the example shown in figure 2, which is the only embodiment described in the patent, the cross-sections of the battery pack and of

the handle portion cannot be considered as being "corresponding", independently of the question whether the cross-sections of both elements can even be considered as presenting a generally triangular cross-sectional configuration at all. Since the patent does not teach how to carry out this feature, the requirements of Article 83 EPC are not met.

5.2.2 The Board is not persuaded by the arguments of the opponents for the following reasons.

According to the jurisprudence of the Boards of Appeal, an objection of lack of disclosure presupposes that there are serious doubts substantiated by verifiable facts. **The burden of proof is upon the opponents** to establish on the balance of probabilities that a person skilled in the art, using his common general knowledge, would be unable to carry out the invention (see the Case Law of the Boards of Appeal [CLB], 9th Edition, 2019, II.C.9, first two paragraphs, in particular in relation to T 19/90 and T 182/89).

In the present case, the Board is of the view that even under any interpretation of the features "triangular" and "corresponding", the opponents have not provided facts of any kind that could substantiate serious doubts, that the skilled person would not be able to provide a handle portion with a triangular cross-sectional configuration "corresponding" to a given triangular cross-sectional configuration of the battery pack.

5.3 Opponent 2, referring to points 36 to 49 of its statement of grounds of appeal, argued that with feature (a), the claim covered a multiplicity of **non-working embodiments** that did not achieve the advantage

as promised in the application, namely to enhance the operability/usability of an electric tool by improving the grasping feel of a handle portion. There is thus a lack of disclosure as to how to carry out the invention over the whole scope of the claim, including these non-working embodiments, thereby infringing Article 83 EPC. In point 50 of its statement of grounds of appeal, opponent 2 also argued that the presence of these non-working embodiments in the claim rendered its subject-matter unclear in the sense of Article 84 EPC.

- 5.3.1 The Board disagrees and is of the view that this objection amounts to neither a lack of sufficiency of disclosure nor to a lack of clarity for the following reasons.

It is established case law that the skilled person, when considering a claim, should rule out interpretations which are illogical or which do not make technical sense (see CLB, *supra*, II.A.6.1), so that, considering that the wording of feature (a) is *per se* clear, the fact that alleged non-working embodiments might be covered under an academic, non-technical reading of the claim does not render its subject-matter unclear in the sense of Article 84 EPC.

The feature also does not cause the claimed subject-matter to contravene Article 83 EPC. As found by the opposition division in the decision under appeal (last paragraph of point 3.4.4 of the reasons), the skilled person would immediately rule out the alleged non-working embodiments. In addition, even if the skilled person did consider that such "illogical" embodiments formed part of the scope of the claim, the opponents have not raised serious doubts, substantiated by

verifiable facts showing that such embodiments could not be carried out.

5.4 Both opponents were also of the view that feature (a) introduced a lack of clarity into the claim according to Article 84 EPC (see statement of grounds of appeal of opponent 1, point 3.2) and statement of grounds of appeal of opponent 2 points 53 and 54), since the embodiment of figure 2 does not show a handle portion having a triangular cross-sectional configuration at all, let alone a cross-section that corresponds to the cross-section of the battery pack. The skilled person is therefore left in doubt about how the terms "triangular cross-sectional configuration" and "corresponding" are to be interpreted.

5.4.1 The Board is not persuaded by the views of the opponents for the following reasons.

With respect to the term "triangular" or "triangle", the Board notes that paragraph [0009] of the patent as granted gives an indication as to how this term is to be interpreted, namely that the term "*is not restricted to a mathematically exact triangle but may include one having sides curved to generally form a circular configuration but having in its periphery three portions that may be regarded as apex portions (corner portions of an arcuate sectional configuration) due to their increased curvature (reciprocal of the radius of curvature) and allows it to be regarded generally as a triangle*". Considering this definition, the Board is convinced that the skilled person has no doubt how a triangular cross-sectional configuration in accordance with the claim is to be interpreted.

Furthermore, in paragraph [0024] of the patent, which belongs to the description of the embodiment of figure 2, it is stated that "*[t]he handle housing 11 is also of a generally triangular cross-sectional configuration in correspondence with the battery case 24, in which the three battery cells 21 through 23 are arranged in a triangular fashion and which, consequently, has a triangular cross-sectional configuration, and eventually, in correspondence with the battery pack 20*". In view of this paragraph, the Board cannot agree with the opponents that the skilled person should not interpret the embodiment of figure 2 as containing feature (a).

It follows that the skilled person understands that figure 2 shows a handle portion having a triangular cross-sectional configuration (despite presenting a curved side), **corresponding** to the triangular cross-sectional configuration of the battery pack (despite having different shapes) in the sense of the claim, so that the Board cannot agree with the opponents' argument that the subject-matter of the claim according to auxiliary request IV lacks clarity because figure 2 does not show feature (a).

- 5.5 Opponent 2, making reference to point 52 of its statement of grounds of appeal, further argued that by the introduction of feature (a), the claim now encompassed a plurality of handle portions having a triangular cross-sectional configuration. However, the features necessary to solve the problem of improved grasping feel of the handle portion over the entire scope of the claim are missing. This results in a lack of essential features in an independent claim in contravention of Article 84 EPC.

5.5.1 The Board is however of the view that an examination of the lack of essential features according to Article 84 EPC is not open to examination in accordance with G 3/14. The Board is aware that feature (a) does not originate from the claims as granted. Nevertheless, the Board also notes that the only requirement set in the granted claims to the handle portion was that it protruded from a side portion of the main body, *i.e.* the granted claims did not restrict the cross-sectional shape of the handle portion of the hand-held tool in any way. It follows that if there is an alleged lack of essential features in the claim of auxiliary request IV, this alleged lack of essential features was also present in the independent claim as granted, which covered not only handles with a triangular cross-sectional configuration, but also with any other shape. Consequently, the amendment did not introduce the alleged non-compliance with Article 84 EPC, so that no examination can be carried out.

5.6 Opponent 1, referring to point 3.1) of its statement of grounds of appeal, argued that the feature "base portion of the handle portion" introduced a lack of clarity in the claim of auxiliary request V. This term does not have an unambiguous technical meaning for the skilled person, who is left in doubt where the "base portion" begins and where it ends. Further, neither the patent specification nor the associated application documents provide any information on this point.

5.6.1 The Board is not convinced by the arguments of opponent 1. Even if the term "base portion" were to be regarded as ambiguous, such ambiguity does not automatically result in a lack of clarity. In such cases, it is established case law that the claims may be interpreted in the light of the description and the drawings to

establish whether they are clear in the sense of Article 84 EPC (see CLB, *supra*, II.A.6.3.5).

As correctly argued by the patent proprietor, it is clear from at least figure 1 and paragraph [0018] that the trigger switch lever (5) is arranged at the front side of the handle portion (10) and in the range just before the intersection between the handle portion and main body (2), which contains the electrical motor. It follows that the skilled person, when interpreting the term "base portion of the handle portion" in the light of the description and the drawings unambiguously understands where this "base portion" is located, and therefore where the trigger switch lever is arranged.

- 5.7 In summary, it follows that the opponents have not submitted admissible and convincing objections under Articles 83 and 84 EPC that could prejudice the maintenance of the patent based on the claim of auxiliary request IV.
6. *Admittance of amended description paragraph according to auxiliary request V - Article 13(2) RPBA 2020*
- 6.1 During the oral proceedings before the Board, the patent proprietor submitted an amended description paragraph [0014] in order to bring the description into conformity with the claim according to auxiliary request IV. In particular, the references to the no longer existing claims 2 and 3 were deleted.
- 6.2 Both opponents objected to the admittance of the amended paragraph, which they considered to be an amendment of the patent proprietor's appeal case. In the absence of any exceptional circumstances justified by cogent reasons, the opponents argued that the Board

should not admit the amendment under Article 13(2) RPBA 2020.

6.3 The Board disagrees for the following reasons.

6.3.1 It is rather common practice, if not specifically ordered otherwise, that a patent proprietor or applicant postpones the submission of an adapted description until one of its requests, in the form of a set of claims defining the matter for which protection is sought, is found admissible and allowable by the competent administrative department or by the Board of Appeal. Only when an allowable set of claims is available, is the adaptation of the description and its examination on the requirements of the EPC carried out in a subsequent final stage. Although this final step is far from being a formal matter and may give rise to various objections, it is always conditional upon the existence of an allowable set of claims.

6.3.2 In addition, it is not only permissible under Article 111(1) EPC, but under certain circumstances even necessary, that a Board exercises its discretion to remit the case to the correspondent department with the order to adapt the description to an allowable set of claims (see CLB, *supra*, V.A.7.8 and document CA/3/19, explanatory remarks on Article 11 RPBA 2020). In view of this, the Board finds that it would be rather illogical and contradictory that the filing of a description adapted to an allowable set of claims could amount to an amendment of an applicant's or patent proprietor's appeal case, when at the same time it is permissible to provide such an adapted description after appeal proceedings have terminated and the case has been remitted to the administrative department.

6.3.3 The Board concludes that the filing of a description adapted to a set of claims found by a Board of Appeal to meet the requirements of the EPC does not generally constitute an amendment to a party's appeal case, let alone when, as in the case at hand, such an amended description consists solely of the deletion of the references to no longer existing claims.

6.3.4 In the present case, the adapted description paragraph [0014] according to auxiliary request V is not considered to be an amendment of the patent proprietor's appeal case, and therefore its admittance into the proceedings is not subject to Article 13(2) RPBA 2020. Consequently, the opponents' requests to not admit this amended description paragraph under Article 13(2) RPBA 2020 cannot be allowed and the amended description paragraph according to auxiliary request V is admitted into the proceedings.

7. *Lack of clarity of claim 1 according to auxiliary request IV occasioned by the amended description paragraph according to auxiliary request V*

7.1 Amended description paragraph [0014] according to auxiliary request V reads as follows (amendments with respect to paragraph [0014] as granted are highlighted by the Board):

"With the battery pack ~~as defined in claim 2~~, the fixation claw portion releasing operation can be performed reliably and easily. In the case in which the right and left finger rest portions are inclined in such directions that they approach to each other toward the apex portion side, when both finger-rest portions are pushed by fingertips, the fingertips are likely to slip toward the apex portion side, thus making it

rather hard to perform the releasing operation. In this respect, with the battery pack ~~as defined in claim 3~~, anti-slip portions are provided on the finger rest portions so that the fingertips may not slip toward the apex portion side, whereby it is possible to reliably perform pushing operation on both finger-rest portions and, by extension, it is possible to quickly perform the operation of releasing the right and left fixation claw portions, thus facilitating the detachment of the battery pack."

7.2 Opponent 2, supported by opponent 1, argued that the description paragraph as amended by the patent proprietor during oral proceedings according to auxiliary request V amounted to a lack of clarity in the sense of Article 84 EPC, because paragraph [0014] described subject-matter which did not support the claim of auxiliary request IV. Furthermore, the wording of the amended paragraph was inconsistent since reference was made to "the" fixation claw portion releasing operation although no claw portion had previously been defined, so that it remained unclear whether the claw portions pertained to the battery pack or not.

7.3 The Board disagrees.

7.3.1 Regarding the alleged linguistic inconsistencies of the amended description paragraph, the Board notes that the only requirement imposed by Article 84 on the description is that it has to support the claims, so that even if a linguistic inconsistency was present in amended paragraph [0014] according to auxiliary request V, this would not automatically amount to a lack of clarity in the sense of Article 84 EPC, as long as the claim is supported by the description.

7.3.2 In this respect, the Board notes that the battery pack described in paragraph [0014] as granted made reference to the embodiments of granted claims 2 and 3, which are no longer present in auxiliary request IV. It can be agreed that the battery packs described in paragraph [0014] contain features that are not present in the hand-held tool with a battery pack according to the claim of auxiliary request IV. However, these features present in paragraph [0014] are compatible with and not in contradiction to the claimed hand-held tool comprising a battery pack according to auxiliary request IV. The Board is convinced that the skilled reader would not understand the claim of auxiliary request IV differently nor would they be confronted with new doubts on the matter for which protection is sought in light of the content of paragraph [0014] according to auxiliary request V.

Therefore, it cannot be agreed with opponent 2 that the claim is not supported by the description.

7.4 It follows that opponent 2 has not convincingly demonstrated that the amended description paragraph [0014] according to auxiliary request V results in a lack of clarity of the claim according to auxiliary request IV.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent as amended in the following version:

Claim

1 filed as auxiliary request IV with letter of 7 September 2020, corresponding to auxiliary request III filed with letter of 13 April 2018 (dated 23 April 2018);

Description, paragraphs

1 to 13, 15 to 33 of the patent specification;
14 received during oral proceedings of 9 February 2022 as auxiliary request V;

Drawings

1 to 4 of the patent specification.

3. The appeal fee paid by the patent proprietor is reimbursed at 25%.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated