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**Datasheet for the decision  
of 28 June 2021**

**Case Number:** T 1347/18 - 3.2.08

**Application Number:** 08730130.5

**Publication Number:** 2118517

**IPC:** F16F15/32, G01M1/32

**Language of the proceedings:** EN

**Title of invention:**

APPARATUS AND METHOD FOR DISPENSING VEHICLE BALLASTING WEIGHTS

**Patent Proprietor:**

3M Innovative Properties Company

**Opponent:**

Wegmann automotive GmbH & Co. KG

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2), 123(3)

RPBA 2020 Art. 13(2)

**Keyword:**

Amendments - main request - extension beyond the content of  
the application as filed (yes) - auxiliary request 2 -  
broadening of claim (yes)  
Amendment after summons - exceptional circumstances (no)

**Decisions cited:**

G 0001/93, G 0002/10

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 1347/18 - 3.2.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.08**  
**of 28 June 2021**

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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
28 March 2018 concerning maintenance of the  
European Patent No. 2118517 in amended form.**

**Composition of the Board:**

**Chairman** C. Herberhold  
**Members:** M. Foulger  
C. Schmidt

## **Summary of Facts and Submissions**

- I. With the decision posted on 28 March 2018, the opposition division decided that the patent and the invention to which it related, in the version according to auxiliary request V-1 met the requirements of the EPC.
- II. The patent proprietor and opponent filed appeals against this decision.
- III. Oral proceedings took place by means of video conference before the Board on 28 June 2021.
- IV. At the end of the oral proceedings the parties' requests were as follows:

The appellant (patent proprietor) requested that the decision under appeal be set aside and the opposition be rejected (main request), or, in the alternative, that the patent be maintained in amended form according to one of auxiliary requests 0, II, III, III-1, IV, IV-1, V or V-1.

- V. The appellant (opponent) requested that the decision under appeal be set aside and the patent revoked.
- VI. i) Main request - patent as granted:

Claim 1 reads (additions over claim 1 as originally filed underlined, deletions struck through):

"A method of dispensing a vehicle ballasting weight having a mass suitable for balancing a portion of a vehicle, said method comprising:

sandwiching a length of a vehicle ballasting weight material, which is longer than it is either wide or thick, between opposing movable surfaces that are movable in the same direction such that each movable surface makes contact with an opposite surface of the weight material;

moving a leading end of the length of vehicle ballasting weight material (12) an incremental distance past a severing position by moving the opposing movable surfaces in a direction toward the severing position while the weight material (12) is sandwiched therebetween; and

severing the vehicle ballasting weight material (12) at the severing position, during or after said moving, to form an incremental length of the weight material (12) that corresponds ~~, within a high degree of accuracy,~~ to an exact mass of the vehicle ballasting weight that is suitable for balancing a portion of a vehicle, wherein said method is **characterized by** the vehicle ballasting weight material (12) comprises a flexible polymeric matrix material filled with a high density particulate material and the opposing movable surfaces defined by a first belt (38) and a second belt (38) being spaced apart a distance that is automatically adjustable to accommodate the thickness of the vehicle ballasting weight material."

Independent claim 8 reads (additions over claim 20 as originally filed underlined, deletions struck through):

"An apparatus for ~~performing the method according to any one of claims 1 to 14,~~ moving and incrementally severing a length of vehicle ballasting weight material, said apparatus being **characterized by** comprising:

a movable belt mounting element (26) and a stationary

belt mounting element (28), said movable element (26) being disposed within an opening (30) in said stationary element (28);

at least two parallel links (24a, 24b), each of said links (24a, 24b) having one end pivotally mounted to said movable belt mounting element (26) and another end pivotally mounted to said stationary belt mounting element, with said opening (30) being dimensioned to allow pivotal movement of said movable element (26) within said opening (30) and about said links (24a, 24b);

a belt pressure actuating assembly (32) having one end mounted to said stationary belt mounting element (28), and another end mounted to said movable belt mounting element (26) and between said links (24a, 24b), such that said belt pressure actuating assembly (32) has a longitudinal axis positioned at an obtuse or acute angle to a longitudinal axis of said movable element (26);

a first drive belt assembly (34) mounted to said stationary belt mounting element (28) and, spaced therefrom, an opposing second drive belt assembly (36) mounted to said movable belt mounting element (26), with said first drive belt assembly (34) comprising a first drive belt (38) defining one opposing movable surface, said second drive belt assembly (36) comprising a second drive belt (38) defining another opposing movable surface, said second drive belt being spaced from said first drive belt so as to form a gap (46) therebetween through which a length of vehicle ballasting weight is moved, each said drive belt being disposed over a plurality of pulleys (40, 41) so as to rotate as said pulleys (40, 41) rotate, said first drive belt assembly (34) further comprising a drive gear, said second drive belt assembly (36) further comprising a driven gear, at least one pulley from the

corresponding plurality of pulleys (40, 41) being mounted so as to rotate with said drive gear, at least one pulley from the other plurality of pulleys (40, 41) being mounted so as to rotate with said driven gear, and said drive gear and said driven gear being mounted such that the rotation of said drive gear drives the rotation of said driven gear, said first drive belt and said second drive belt; and  
a severing device mounted downstream from said drive belts for severing an incremental length of vehicle ballasting weight material (12) from a length of vehicle ballasting weight material (12) being moved downstream through said gap (46)."

ii) Auxiliary request 0

The following features are added to claim 1 as granted:

"... wherein the movable belt mounting element (26) is disposed within an opening (30) in the stationary belt mounting element (28), wherein at least two parallel links (24a, 24b) are provided and wherein each of the parallel links (24a, 24b) has one end pivotally mounted to the movable belt mounting element (26) and another end pivotally mounted to the movable belt mounting element (28) and wherein the opening (30) is dimensioned to allow pivotal movement of the movable belt mounting element (26) within the opening (30) and about the least two parallel links (24a, 24b) such that the two parallel links (24a, 24b) enable the drive gear (42) and the driven gear (44) to remain meshed when the vehicle ballasting weight material being dispensed changes thickness."

Claim 8 is amended as follows:

"An apparatus for ~~moving and incrementally severing a length of vehicle ballasting weight material~~ performing a method according to one of claims 1 to 5, ..."

iii) Auxiliary request II

With respect to claim 1 of the main request, the phrase "defined by a first belt (38) and a second belt (38)" has been deleted.

Claim 8 is as per auxiliary request 0.

iv) Auxiliary request III

The following feature has been added to claim 1 of the main request:

"... wherein the second drive belt (38) is spaced from the first drive belt (38) by the distance so as to form a gap (46) therebetween through which a length of the vehicle ballasting weight (12) is moved and wherein each drive belt (38) is disposed over a plurality of pulleys (40) so as to rotate as the pulleys (40) rotate."

Claim 8 is as per auxiliary request 0

v) Auxiliary request III-1

The following feature is inserted in claim 1 of auxiliary request III (between the text of claim 1 as granted and the features added for auxiliary request III):



"... wherein a first drive belt assembly (36) comprises the first drive belt (38) defining one of the opposable movable surface, and the second drive belt assembly (34) comprises the second drive belt (34) defining another opposing movable surface, ..."

vi) Auxiliary request IV

The following feature is added at the end of claim 1 of auxiliary request III:

"... wherein at least one pulley (40) is mounted so as to rotate with a drive gear (42) and at least one other pulley (40) is mounted so as to rotate with a driven gear (44) and wherein the drive gear (42) and the driven gear (44) are mounted such that the rotation of the drive gear (42) drives the rotation of the driven gear (44), the first drive belt (38) and the second drive belt (38)."

Claim 8 is as per auxiliary request 0.

vii) Auxiliary request IV-1

The following feature is added to claim 1 of auxiliary request IV (between the text of claim 1 as granted and the features added for auxiliary request IV):

"... wherein a first belt assembly (36) comprises the first drive belt (38) defining one of the opposing movable surfaces, and a second drive belt assembly (34) comprises the second drive belt (38) defining another opposing movable surface, wherein the first drive belt assembly (36) is mounted to a stationary belt mounting element (28) and, spaced therefrom, the opposing second drive belt assembly (34)

is mounted to a movable belt mounting element (26), ..."

Claim 8 is as per auxiliary request 0

viii) Auxiliary request V

The following features are added to claim of main request:

"... without having to make adjustments to how a first belt assembly (34) and a second belt assembly (36) are mounted,  
wherein the second drive belt (38) is spaced from the first drive belt (38) by the distance so as to form a gap (46) therebetween through which a length of the vehicle ballasting weight (12) is moved and wherein each drive belt (38) is disposed over a plurality of pulleys (40) so as to rotate as the pulleys (40) rotate,  
wherein at least one pulley (40) is mounted so as to rotate with a drive gear (42) and at least one other pulley (40) is mounted so as to rotate with a driven gear (44) and wherein the drive gear (42) and the driven gear (44) are mounted such that the rotation of the drive gear (42) drives the rotation of the driven gear (44), the first drive belt (38) and the second drive belt (38),  
wherein the drive gear (42) can drive the rotation of the belts (38) simultaneous."

Claim 8 is as per auxiliary request 0.

ix) Auxiliary request V-1

The following features are added to claim 1 of

auxiliary request V:

"... wherein a first drive belt assembly (36) comprises the first drive belt (38) defining one of the opposing movable surfaces, and the second drive belt assembly (34) comprises the second drive belt (38) defining another opposing movable surface, wherein the first drive belt assembly (36) is mounted to a stationary belt mounting element (28) and, spaced therefrom, the opposing second drive belt assembly (34) is mounted to a movable belt mounting element (26), ..."

Claim 8 is as per auxiliary request 0

VII. The appellant (proprietor) argued essentially as follows:

a) Main request

Claim 1:

The inclusion of the first and second belts was mainly supported by two passages in the originally filed description:

- i) page 7, line 27
- ii) page 4, second paragraph, in particular lines 11 - 13.

In these passages the belts were presented independently from the parallel links and any other item of the described apparatus in relation to the claimed method. It was further stated on p. 3, lines 25, 26 that the parallel links "**can**" enable the drive gear and the driven gear to remain meshed, which indicated that the links were only optional. This was also derivable from claim 20 and Figure 3 as filed, in

which the links and the drive belts were presented as separate, independent functional units. Thus, the feature was not disclosed in combination with other features and the overall disclosure justified the generalising isolation of the first and second belts and their introduction into the claim.

Moreover, the device feature of the belts only better defined the movable surfaces in the method claim in a clarifying way, without making a technical contribution. Indeed, the inclusion of these structural features into a method claim did not actually affect the scope of the method steps and it certainly did not result in any new embodiments falling under the claimed subject-matter thereby improving the proprietor's position in an unjustified way. In view of a fair balance of the interests of the proprietor on the one hand and of competitors and third parties on the other hand, see G1/93, r. 8, 15 and the headnote, point 2, the feature was thus not to be seen as unallowably extending the subject-matter beyond that of the original disclosure.

Furthermore, according to the original disclosure page 6, last paragraph, other movable and stationary mounting elements were possible. It had also to be born in mind that the claim - while not defining the links in particular - still required the distance between the first and second belt to be automatically adjustable to accommodate the thickness of the vehicle ballasting material.

Hence, it was permissible to add just the first and second belts to the claim without requiring that any other elements, in particular the parallel links be

included.

Claim 8:

The term "for" used in original claim 20 (from which granted claim 8 is derived) was used for illustration purposes and not for restricting the apparatus to this specific purpose. Moreover, the apparatus was disclosed on pages 6 and 7 without the allegedly limiting suitability.

The requirements of Article 123(2) EPC were therefore met.

b) Auxiliary request 0 - admittance

This request was filed in response to the course of proceedings in which surprisingly the omission of the links - which up to then had only been objected to in a very general way - became a prominent issue. Furthermore, there had been no indication in the Board's communication that none of the auxiliary requests comprised the links. The newly filed request was thus an immediate response to the surprising course of the proceedings. It did not raise any new issues which would delay the proceedings and should thus be admitted.

c) Auxiliary request II

As argued in the written proceedings, the deletion of the term "defined by a first belt (38) and a second belt (38)" did not extend the protection conferred. This term - being a device feature in a method claim was merely of a clarifying, non-limiting nature and thus could - as discussed in G 1/93 - be deleted

without infringing Article 123(3) EPC.

c) Auxiliary requests III, III-1, IV, IV-1, V, V-1

The above comments regarding added subject-matter (see main request) also applied to these requests.

VIII. The appellant (opponent) argued essentially as follows:

a) Main request - Added subject-matter - Article 100(c) EPC

Claim 1

The subject-matter of claim 1 extended beyond that of the application as originally filed. In particular, the clearly limiting feature of the first and second belts had been extracted from its originally disclosed functional and structural context. Such an extraction was only allowable if the feature was not disclosed in combination with other features and the overall disclosure justified the generalising isolation of the feature and its introduction into the claim. This was not the case here because the belts were only disclosed in functional combination with the parallel links.

Claim 8

The omission of the back reference to the method of claim 1 in present apparatus claim 8 meant that the once required suitability for the method, in particular for dispensing an exact mass was no longer present. Moreover, even the passage on pages 6 and 7 to which the proprietor referred required such suitability - see page 6, lines 28,29 - and if it were to be seen as a possible basis, comprised many further technical

features, which were also not part of the claimed subject-matter.

Thus, the subject-matter of claims 1 and 8 extended beyond that of the application as originally filed.

b) Auxiliary request 0 - admittance

The unallowable intermediate generalization resulting from the omission of the links had been objected to already in opposition proceedings. The objection had been repeated in the statement setting out the grounds of appeal, see page 8, point 1.1, stating that the "parallel links 24a and 24b to automatically adjust the gap 46" were part of the mechanics for adjusting the distance between the first and second belt and thus needed to be included in the claim. The importance of the issue had also been highlighted in the Board's communication, see page 2, last paragraph. The proprietor thus could and should have reacted to said objection earlier. Without any justifying exceptional circumstances being identifiable, auxiliary request 0 was not to be admitted into the proceedings.

c) Auxiliary request II

The deletion of the term "defined by a first belt (38) and a second belt (38)" did extend the protection conferred. Whereas the scope of claim 1 as granted was limited to methods in which the length of vehicle ballasting weight material was sandwiched between first and second belts, the scope of claim 1 of auxiliary request II was not so limited and comprised sandwiching by whatever surface, e.g. by pulleys. This was an unallowable extension of the protection conferred.

d) Auxiliary requests III, III-1, IV, IV-1, V, V-1

The above comments regarding added subject-matter (see main request) also applied to these requests.

## **Reasons for the Decision**

1. Main request - Added subject-matter

1.1 Claim 1

During examination proceedings the feature "defined by a first belt (38) and a second belt (38)" was added to claim 1.

In such a case, it is established case law that the amendment may only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed (see Case Law of the Boards of Appeal, 9th edition, 2019, II.E.1.3.1. and G 2/10, OJ 2012, 376).

The appellant (patent proprietor) argues that this feature was disclosed at (i) p. 4, 2nd paragraph, in particular lines 11 - 13, and at (ii) p. 7, l. 27 of the application as originally filed.

It is correct that the cited passages disclose the first and second belts. However, these passages must be read in context. The first passage (i) is part of a longer passage which relates to the statement of invention of the apparatus. Indeed this passage starts



on p. 3, l. 28 with "an apparatus is provided for performing the above method..." and continues in the next sentence with "[t]he apparatus comprises...". The features of the independent apparatus claim 20 are then recited. Amongst these are the parallel links, it is first on p. 4, l. 25, i.e. after the parallel links are mentioned, where the optional features are introduced with "can". Thus, passage (i) does not disclose the belts separately from the links and cannot provide a basis for the present combination as recited in claim 1.

The passage (ii) cited by the appellant (proprietor) is a section of text in brackets which is part of a sentence which starts "[t]he parallel links allow the gap between the opposing belt surfaces...". Hence, also in this passage, the parallel links are presented as being related inextricably with the belts.

Passage (ii) explicitly states that the parallel links 24a and 24b allow the gap between the opposing belt surfaces, i.e. the opposing movable surfaces of the belts, to automatically adjust to the thickness of the vehicle ballasting weight assembly. The same functionality is disclosed on page 4, lines 1-4 and thus in context with passage (i), where the pivotal movement of the movable belt relative to the stationary belt mounting element is disclosed to be a result of pivotal movement of the movable element about the links. The parallel links and the first and second belts are thus structurally and functionally linked in order to automatically adjust the distance between the belts to accommodate the thickness of the vehicle ballasting weight material.

Whether the further function of the links of allowing the drive gear and the driven gear to remain meshed is referred to in this context as optional ("can" in page 3, lines 25, 26 and dependent claim 21 as originally filed) is a different issue and does not change the above identified functional and structural link between the parallel links and the first and second belt.

While it is true that claim 1 as granted defines the automatic adjustment, it does so without defining the link elements which together with the first and second belt are disclosed to provide said function. Such an intermediate generalization is justified only in the absence of any clearly recognisable functional or structural relationship among the features of the specific combination (see Case Law of the Boards of Appeal, 9th edition 2019, II.E.1), which criterion is - as shown above - in the present case not fulfilled.

To put it differently, the amendment presents the skilled person with the new technical information that the belts may be used in the method without the parallel links. Providing the skilled person with such new information is in violation of Article 123(2) EPC as established in G2/10 (see Case Law of the Boards of Appeal, supra).

As the features provide a technical contribution, the exception identified in G1/93, Headnote 2 does not apply.

Claim 20 and Figure 3 do not give rise to a different interpretation. To the contrary, both define / show the links and the belts, with the links allowing the pivotal movement of said movable belts, which is exactly what is needed for the claimed automatic

adjustment of the distance between the first and second belt in order to accommodate the thickness of the vehicle ballasting material.

It is also not relevant that according to page 6, last paragraph other movable and stationary mounting elements are possible, as the proprietor had chosen to restrict claim 1 as granted to those elements being first and second belts.

Lastly, the features of a device with which a particular method is put into practice make a technical contribution and limit the claim accordingly. Sandwiching a length of material between belts is a method different from one sandwiching the material between wheels for example.

Consequently, following G 1/93, headnote I, as the European patent as granted contains subject-matter which extends beyond the content of the application as filed in the sense of Article 123(2) EPC and which also limits the scope of protection conferred by the patent, such patent cannot be maintained in opposition proceedings unamended, because the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent.

## 1.2 Claim 8

The back-reference to claim 1 which was present in the originally filed application has been deleted from the granted claim. Claim 20 as originally filed, on which present claim 8 is based, reads "[a]n apparatus for performing the method according to one of claims 1 to 14..." Claim 1 provides a method of dispensing a vehicle ballasting weight. The incremental length

corresponds to an exact mass of the vehicle ballasting weight (claim 1 as filed, final phrase). Thus, claim 20 as originally filed required that the apparatus be suitable for dispensing an exact mass. The same suitability is disclosed with respect to the disclosure on pages 6 and 7 of the description as filed, see page 6, lines 28, 29. This requirement is no longer present in claim 8. An apparatus that is not suitable for this is not disclosed in the application as originally filed.

The subject-matter of the patent thus extends beyond that of the application as originally filed.

2. Auxiliary request 0 - Admissibility

This request was filed during the oral proceedings. The appellant (proprietor) did not identify any exceptional circumstances to justify such a late filing.

The Board notes that the Article 123(2) EPC problem discussed above was addressed by the appellant (opponent) in their statement setting out the grounds of appeal (page 8, point 1.1), stating that the "parallel links 24a and 24b to automatically adjust the gap 46" were part of the mechanics for adjusting the distance between the first and second belt and thus needed to be included in the claim. It was further mentioned as an important point for discussion by the Board in the communication pursuant to Article 15(1) RPBA (page 2, last paragraph).

Therefore, the appellant (proprietor) should, at the latest after receiving the Board's communication, have realised that this was an important issue to be addressed and in consequence have filed appropriate

auxiliary requests. That none of the auxiliary requests comprised the parallel links was something known to the proprietor - who had actually drafted said requests - without any need or even requirement for highlighting this fact by the Board.

Hence, there are no exceptional circumstances apparent to justify the late filing of auxiliary request 0. Therefore, the Board did not admit the request into the proceedings (Article 13(2) RPBA 2020).

3. Auxiliary request II

In this request the feature whereby the surfaces are "defined by a first belt (38) and a second belt (38)" has been deleted.

Such a deletion enlarges the scope of protection compared with the granted patent because exercising the method with an apparatus not comprising first and second belts would now fall under the scope of protection (see also point 1.1 above).

The argument that this feature was merely of clarificatory nature and did not affect the scope of protection is not persuasive. The feature requires that the surfaces are defined by belts, i.e. that belts are present and used when exercising the claimed method. The belts are, moreover, tangible items the use of which makes a technical contribution. Thus, this feature is more than of a clarificatory nature and without this feature, the method is not limited by the requirement of comprising the use of such belts.

With respect to the appellant proprietor's reference to G 1/93 it is noted that the second sentence of the

headnote applies to situations in which the added feature does not provide a technical contribution to the subject-matter of the claimed invention, which is, as discussed above, not the case.

Hence, auxiliary request II infringes Article 123(3) EPC.

4. Auxiliary requests III, III-1, IV, IV-1, V, V-1

Claim 1 of all these requests includes the first and second belts as discussed for the main request. Moreover, in method claim 1 of all of these requests the parallel links are not included. Thus, the reasoning regarding claim 1 of the main request in respect of added subject-matter is equally applicable to these requests.

Consequently, these requests are likewise not allowable (Article 123(2) EPC).

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



D. Magliano

C. Herberhold

Decision electronically authenticated