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Datasheet for the decision of 9 February 2023

Case Number: T 2649/18 - 3.4.01

Application Number: 11008955.4

Publication Number: 2421091

IPC: H01Q1/32, G01S1/00, B60R25/10, G01S19/16

Language of the proceedings: EN

Title of invention:
Straddle-type vehicle

Applicant:
Yamaha Hatsudoki Kabushiki Kaisha

Headword:
Motorcycle with GPS unit / Yamaha

Relevant legal provisions:
EPC Art. 111(2), 113(1), 52(1), 56, 84
RPBA 2020 Art. 11

Keyword:
Remittal - fundamental deficiency in first-instance proceedings (no)
Inventive step - main request and auxiliary requests 1, 2, 3 (no) - auxiliary request 4b (yes)
Claims - clarity - auxiliary request 4 (no)

Decisions cited:
T 1462/14

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Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 2649/18 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 9 February 2023

Appellant: (Applicant)	Yamaha Hatsudoki Kabushiki Kaisha 2500 Shingai Iwata-shi, Shizuoka 438-8501 (JP)
Representative:	Grünecker Patent- und Rechtsanwälte PartG mbB Leopoldstraße 4 80802 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 3 July 2018 refusing European patent application No. 11008955.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair	P. Scriven
Members:	T. Petelski
	C. Almberg

Summary of Facts and Submissions

I. The appealed decision is the refusal of the patent application for lack of an inventive step over

D1: EP 1 081 035 A2

of the subject-matter of claim 1 of each of a Main Request and Auxiliary Requests 1 to 3. Auxiliary Request 4 had been found allowable, with minor amendments, but the appellant disapproved the proposed grant of a patent in this form.

II. Also subject of the examination proceedings was

D2: EP 1 247 706 A2.

III. With the notice of appeal, the appellant filed claim sets for a Main Request and Auxiliary Requests 1 to 4. They differ from those underlying the appealed decision only in that, in each set, three reference signs are corrected, and one comma is added.

IV. In its statement of grounds, the appellant additionally requested an informal interview, and the case's remittal to the Examining Division on the ground of an alleged procedural violation.

V. In the preliminary opinion accompanying the summons to oral proceedings, the Board took a negative view in respect of all these requests.

VI. At the end of oral proceedings, the appellant confirmed its final claim requests to be the Main Request and Auxiliary Requests 1 to 4 filed with the notice of appeal, and Auxiliary Request 4b filed at oral proceedings before the Board.

VII. Claim 1 of the Main Request and of Auxiliary Request 1 reads (reference signs omitted):

Straddle-type vehicle, in particular a motorcycle, comprising:

a frame extending from a front to a back of the straddle-type vehicle;

a seat provided above a rear part of the frame;

a taillight; and

a Global Positioning System (GPS) unit provided above the taillight, wherein the GPS unit comprises at least an antenna provided in a position higher than the frame and behind the seat, characterized in that

a unit attachment member is attached to the frame and is provided between the taillight

and the GPS unit, the GPS unit being attached on the unit attachment member.

VIII. Auxiliary Request 1 differs from the Main Request only in its dependent claims, the wording of which, however, is not relevant for this decision. Claim 1 is identical with claim 1 of the Main Request.

IX. Claim 1 of Auxiliary Request 2 differs from claim 1 of the Main Request in that it adds, at the end of the claim (reference signs omitted)

...,
wherein the GPS unit is stored in a storage member provided above the taillight.

X. Claim 1 of Auxiliary Request 3 differs from claim 1 of Auxiliary Request 2 in that it adds, at the end of the claim (reference signs omitted)

...,
said storage member including an upper plate, a front plate, a rear plate, and a pair of side plates.

XI. Claim 1 of Auxiliary Request 4 differs from claim 1 of Auxiliary Request 3 in that it adds, at the end of the claim (reference signs omitted)

...,

the front plate of the storage member extends obliquely downward to the front of the straddle-type vehicle from the upper plate, and/or a lower end of the front plate is provided under the seat, and is attached to the frame.

XII. Claim 1 of Auxiliary Request 4b differs from claim 1 of Auxiliary Request 4 in that "or", and the last comma, are deleted from the last feature, such that it reads (reference signs omitted)

...,
the front plate of the storage member extends obliquely downward to the front of the straddle type vehicle from the upper plate, and a lower end of the front plate is provided under the seat and is attached to the frame.

Reasons for the Decision

The content of the application

1. The invention concerns an anti-theft system for a straddle-type vehicle, in particular a motorcycle. A GPS unit, installed in the vehicle, acts as a tracking device and is also capable of controlling the vehicle to activate an alarm and stop the engine. To complicate the disabling of the GPS unit, the invention proposes

attaching the GPS unit to the frame of the vehicle in such a way that it is difficult to remove, while placing it towards the top rear ensures a good reception of GPS signals.

Informal interview

2. The appellant's conditional request for an informal interview with the rapporteur applies if the Board "cannot directly follow [the] Main Request". However, there is no right to an informal interview, whether by telephone or otherwise (see the Case Law of the Boards of Appeal, 10th edition, ("Case Law"), III.C.2.1.3).

3. The appellant was informed of the Board's negative view in this respect by the preliminary opinion and had the opportunity of defending its case both in writing and at oral proceedings.

4. The Board did not grant the request for an informal interview.

Procedural violation

5. According to the appellant, the Examining Division applied ex post facto analysis in its inventive step reasoning starting from D1. In particular, it failed to identify a "recognizable pointer" to the solution in the prior art. Further, the Examining Division did not react to the appellant's request to do so, and nor did it indicate any legal basis for judging inventive step in the absence of a recognizable pointer. This was a substantial procedural violation.

6. It is not entirely clear to the Board, which of its fundamental procedural rights the appellant alleges was not respected. It seems to be a violation either of the right to be provided with the (complete) reasons for the decision according to Rule 111(2) EPC (see Case Law, V.A.9.4.4(b) and III.K.3.4.1), or of the right to be heard according to Article 113(1) EPC, which includes due consideration of all relevant comments (Case Law, III.K.3.4.2).

7. Under point 15 of its decision, the Examining Division applied the problem-solution approach starting from D1. D1 disclosed a straddle-type vehicle with a frame, seat, tail light, GPS unit (implicit) and unit attachment member (implicit), to which the GPS unit was attached (implicit). The GPS unit was provided above the tail light and behind the seat.

8. The decision identified, as a difference, that the unit attachment member as defined in claim 1 was attached to the frame and was provided between the tail light and the GPS unit. The technical effect was "the assurance of the GPS unit location". Improving the fixation of the GPS unit to the straddle-type vehicle was seen as the problem to be solved. Since, according to the Examining Division, every component in a motorcycle was, at least implicitly, fixed to the frame, it would have been evident for the skilled person also to fix the GPS unit to the frame. Considering that a good signal reception (of the satellite signals) had to be guaranteed, the skilled person would have disposed the unit attachment member at the bottom of the GPS unit. This would necessarily have placed the unit attachment member between the tail light and the GPS unit.

9. The decision notes the necessity of attaching the GPS unit to the frame of the motorcycle and points to the speeds at which such a vehicle is ridden. It followed that a provision of a GPS device without any fixation would not work. The decision also points to the signal reception, which, for the position of the GPS unit above the tail light, directly led to the unit attachment member being positioned between tail light and GPS unit.

10. An explicit pointer to the solution, as demanded by the appellant, is not generally required. In this case, the Examining Division established a problem that realistically poses itself to the skilled person. Given the nature of patent documents, there is an intrinsic motivation for the skilled person to realize a device described in a prior art patent document and to fill missing teachings using the common technical knowledge. In order to solve the problem identified by the Examining Division, the skilled person would, in the absence of explicit pointers, resort to its common technical knowledge. If there are well-known solutions to the problem, then choosing one of these well-known options is likely to be obvious, if there are no reasons pointing away from it.

11. In this case, there are well-known ways of attaching objects to one another, one of them being to use the underside of the GPS unit for attachment using common means such as a screw or glue. Also, there is no reason not to use the underside in D1. The skilled person did not have to draw on the knowledge of the invention to realize this attachment.

12. The decision, therefore, provides a complete reasoning of lack of an inventive step that follows the problem-

solution approach, irrespective of whether one agrees to its conclusion or not. The reasoning implicitly counters the appellant's objections, which means that the right to be heard is also respected.

13. Hence, the Board cannot identify any procedural deficiency, let alone a fundamental one, and sees no other special reason for remitting the case. (cf. Article 11 RPBA 2020).

14. As a result, the Board did not remit the case to the Examining Division.

Main Request - Inventive step in view of D1

15. D1 discloses a motorcycle with a frame, a seat, a tail light, and a Global Positioning System (GPS) unit that is used for navigation. In one embodiment ([0020]; Figure 2), the GPS unit is positioned under the rear upper cover of the motorcycle at an upper "rear end portion" of the motorcycle. According to Figure 2, the GPS unit is located roughly behind the seat, and at a higher level than the tail light. It is implicit that the GPS unit must be fixed in some way to the motorcycle, and, thereby, eventually, to the frame. D1 is silent on how this is done. To this extent, the teaching of D1 is undisputed.

16. What is disputed by the appellant, however, is the implicit presence of a unit attachment member in D1. According to the appellant, the GPS unit could well have been attached to the motorcycle of D1 by separate attachments of its individual parts, instead of being attached in its entirety to a single unit attachment member. Components of the GPS sensor could also be

integrated with parts of the vehicle without an attachment member. Further, it was clear from claim 1 that the attachment member extended from the frame to between the tail light and the GPS member and could, therefore, not merely consist of a patch of sticky tape.

17. This argument is not convincing. D1 describes one GPS sensor 110a that receives radio waves and outputs measurement position data ([0020] and [0024]). The GPS sensor is mounted at a position such as "a position of a rear end portion of the vehicle body, which is not hidden by the driver such as, for example, a rear upper cover" ([0020]). This implies the presence of a GPS sensor module similar to those commonly used and commercially available, and not a mere collection of single components that need to be fixed independently. Like all other parts of the motorcycle, such a module cannot be left loose within or outside the cover but must be fixed to the frame, directly or indirectly, in a detachable or non-detachable manner. As soon as there is attachment, there is an attachment member, which could be, for example, a screw, a patch of sticky tape or glue, or a clamping or non-clamping receptacle. Even a small attachment member can, at least indirectly and through another element, be positioned between the tail light and the GPS sensor and attach the sensor to the frame. Therefore, D1 implicitly comprises a unit attachment member that attaches the GPS unit to the frame.

18. The positioning of the GPS unit "above" the tail light was also contested by the appellant. In its view, in D1, the GPS unit is positioned higher than the tail light, but not directly above it.

19. Figure 2 of D1 is not clear in its teaching, because it is a side view and does not contain information about the lateral geometry. Tail light 48 appears to have a U-shape. The tail light has a depth that extends into the motorbike for a certain distance to accommodate the light source and potential light shaping elements. Depending on the width of the rear part of the motorbike, the depth of the tail light, and the lateral position of the GPS unit, the GPS unit might, or might not, be positioned directly above at least a part of the tail light, in this particular embodiment. D1, however, is not restricted to the exemplarily illustrated motorcycle of Figure 2, and the invention is "advantageous for a motorcycle which is small in size, and which has a vehicle body exposed to the outside elements" ([0050]). For all motorcycles, in which the tail light does not protrude further to the rear than the upper "rear end portion of the vehicle body", which applies to a variety of common motorcycles, the GPS unit will be above the tail light.

20. The arrangement of the GPS unit either directly above the tail light, as in claim 1, or merely higher than the tail light but still at the rear end of the vehicle, as in D1, does not involve any technical considerations and is a mere question of design of the rear end of the motorbike. Due to the lack of technical character, this feature cannot contribute to an inventive step, and the question of whether it is implicitly disclosed by D1 or not can be left unanswered.

21. Hence, disregarding the design feature of the exact placing of the GPS unit in relation to the tail light, the subject-matter of claim 1 differs from D1 in that

the unit attachment member is attached to the frame and is provided between the tail light and the GPS unit.

22. According to the appellant, this difference has a twofold technical effect. First, the position of the attachment member below the GPS unit guaranteed a good signal sensitivity. Second, it provided a better theft protection for the GPS unit. Should a thief remove the tail light, the direct access to the GPS unit from below would be impeded by the attachment member because of its location between the tail light and the GPS unit and because of its fixation to the frame. It formed a physical obstacle to any attempted removal. In order to remove the GPS unit, the attachment member would first have to be removed from the frame.

23. However, these effects cannot be justified when properly considering the subject-matter of claim 1 and the disclosure of D1.

24. Claim 1 neither defines the nature and shape of the unit attachment member, nor the way in which it is attached to the GPS unit. Without any restriction in this regard, the alleged technical effect of impeded access does not apply over the whole width of the claim. There is a number of shapes for the attachment member, and ways of attaching it, that do not impede the access to the GPS unit. To give examples: the unit attachment member might feature a removable attachment to the frame, for example by clamping, such that it could easily be removed together with the GPS unit. Or the unit attachment member might be a narrow rod that allows an easy lateral removal of the GPS unit. If the GPS unit is attached to the attachment member by a screw, the position below the GPS unit might even facilitate the access to the screw and, thereby, the

removal of the GPS unit, compared to an attachment above the GPS unit.

25. The alleged effect of a good signal sensitivity, on the other hand, is already present in D1 and can, therefore, not be caused by the difference between claim 1 and D1. D1 suggests mounting the GPS unit "at such a position of a rear end portion of the vehicle body which is not hidden by a driver" ([0020]; see reference sign 110a in Figure 2). It was apparent to the skilled person that this position was chosen to guarantee an unimpeded reception of radio waves.

26. It follows that the technical effect of the difference between the subject-matter of claim 1 and D1 merely lies in a particular way of attaching the GPS device to the vehicle. The objective technical problem, therefore, is how to realize the necessary attachment of the GPS unit to the motorcycle of D1.

27. This problem is realistic, because it would have been recognized by the skilled person, who would have wished to solve it as soon as she formed the intention of realizing the motorcycle disclosed in D1.

28. Following the problem-solution approach, it has to be assessed whether the skilled person, in view of the above identified objective technical problem, could and would have attached the (implicitly disclosed) unit attachment member to the frame between the tail light and the GPS unit in the motorcycle of D1.

29. The appellant denies that and refers to the case law on "ex-post facto analysis" and the "could-would approach", arguing that the prior art did not provide a pointer to the solution alleged in the decision. The

short disclosure in paragraph [0020] of D1 did not deliver any information on the attachment and the exact position of the GPS unit and could not, therefore, motivate the skilled person to provide the very particular and elegant attachment of the GPS device featured by the invention. The assumption that the skilled person would have provided an attachment member as defined in the claim was pure speculation and reflected only the personal opinions of the Board's members. The knowledge of the skilled person would have to be proven by reference to prior art, because a member of the Board, or of the Examining Division, could not serve as the skilled person, as was established in T 1462/14.If anything, the skilled person trying to realize the attachment of the GPS device in D1 would have either fixed the GPS unit to the rear upper cover or resorted to D2 and installed the GPS device in the helmet compartment of the motorcycle, beneath the seat.

30. It is a prerequisite consideration for the exclusive rights sought, and therefore in the nature of a patent application, to include information on how to reproduce the invention. Hence, there is an intrinsic motivation for the skilled person to realize the motorcycle disclosed by D1. In D1, the exact design and way of attaching the unit attachment means is left open, and the skilled person would have resorted to her technical knowledge to fill this gap.

31. The assessment of inventive step under the EPC inevitably involves questions of hypotheticals. What matters is what would have been obvious to a hypothetical skilled person at a particular time in the past. It was to handle this as objectively as possible that the problem-solution approach was developed. As

the appellant correctly observed, and as restated under point 15 of T1462/14, the skilled person of the EPC is no real person (see also Case Law, I.D.8.1). By necessity, it is mostly up to real people to judge what this skilled person could and would have done. In this particular case, the members of the Board are persuaded that it was within the abilities of the skilled person, who might have been a mechanical engineer skilled in the field of motorcycle construction, to solve the problem using her mechanical skills alone. As was set out above (see point 10.), there is no need for an explicit pointer in the prior art for means of attaching a GPS device to a motorcycle.

32. The skilled person, confronted with the problem of realizing the attachment of the GPS unit in D1, would have had only a limited number of surfaces of the GPS unit available for use. Choosing the lower surface would have been an arbitrary option amongst this small number of options. In those cases, in which the attachment member would have involved materials that interfered with the signal, the selection of the underside of the GPS unit would no longer have been arbitrary but preferred. The skilled person would have been perfectly capable of attaching the GPS device in D1, without having any reason to resort to D2.

33. In D2, the GPS sensor is not for navigation, but is an anti-theft tracker that is installed in the motorcycle retroactively. For this reason, it is not installed beneath the cover of the motorcycle during fabrication. Instead, the lockable helmet compartment is chosen as a location that is accessible by the driver, protected from the elements, but difficult to access by a thief. Irrespective of D1 not showing a helmet compartment, the necessity of finding such a spot does not arise in

D1, in which the GPS sensor is within the cover of the motorcycle. Also, the GPS sensor in D1 is used for navigation and a high reception quality while the driver is on the seat is important. Accordingly, D1 explicitly excludes locations with lower signal reception quality ([0020]: "not hidden by a driver"). Hence, even if the skilled person would have considered D2, she would not have put the GPS sensor of D1 in a helmet compartment.

34. These considerations do not involve an ex post facto analysis, as alleged by the appellant, because the solution (unit attachment member between GPS sensor and tail light) merely applies the technical knowledge of the skilled person on attachment means and signal distortion, when trying to solve the objective technical problem (i.e., realize the attachment of the GPS unit to the motorcycle). This solution does not draw on any knowledge of the invention.

35. Hence, the Main Request is not allowable for lack of inventive step (Articles 52(1) and 56 EPC).

Auxiliary Request 1

36. Claim 1 is identical to claim 1 of the Main Request and, consequently, is not allowable for the same reasons.

Auxiliary request 2

37. Claim 1 of Auxiliary Request 2 adds, to claim 1 of the Main Request, that the GPS unit is stored in a storage member provided above the tail light.

38. Claim 1 does not define any technical features of the storage member, or of its attachment. Due to its broad definition, the storage member can be understood in two different ways: either as a casing of the GPS unit, the casing being a "storage member" because it stores the components of the GPS unit, or as an entity separate from the GPS unit and its possible casing. Both understandings are valid interpretations of the claim.

39. D1 is silent on the configuration of the GPS sensor. It belonged, however, to the skilled person's common technical knowledge that GPS sensors, in particular those that were commercially available, were typically enclosed in a casing, not least for holding together and protecting its constituent elements. It would have been an exceptional choice for the skilled person to select a GPS sensor without a casing for use in D1.

40. Provided the skilled person had made the obvious choice of selecting a GPS sensor with a casing, then the provision of the unit attachment member below the GPS sensor meant that the unit attachment member was attached, through the underside of the casing, to the GPS unit, and, through some part of the motorcycle, to the frame. The understanding of the attachments as indirect attachments (through other members) lies within the subject-matter of the claim because the application itself uses the term "attachment" in the same, broad way. This is evident, for example, from the embodiment illustrated in Figures 7 - 10. Here, the attachment member 20 is attached indirectly to the frame 10B through the support members 19A and through beam 19B, and to the GPS unit 2 through the elastic band 40.

41. Hence, with the understanding that the usual casing of a GPS unit is a storage member, this storage member cannot contribute to an inventive step of the subject-matter of claim 1.

42. The appellant did not contest that a GPS unit typically had a casing. Rather, in addition to the arguments brought forward with regard to the Main Request, the appellant argued that such casing would not be understood as a storage member. It was clear from the claim that the storage member was a separate entity that covered the GPS unit on five sides and, thereby, further contributed to making the GPS unit difficult to remove. A potential thief, who tried to remove the GPS unit, for example by removing the tail light for accessing the GPS unit from below, would not only have been hindered by the unit attachment member, but also by the limited space the storage member left for grabbing and removing the GPS unit from the sides or from above. In D1, in contrast, the skilled person would have had no motivation to make the removal of the GPS unit more difficult, because the unit was not used as a tracking device and there was no motivation, for a thief, to remove it. Also, the skilled person would have refrained from adding additional elements to the motorcycle for weight reasons.

43. These arguments are not persuasive. First, because there is nothing in claim 1 that speaks against the storage element being understood as a casing of the GPS unit. Second, even if the storage member were understood as a separate element, it would not have any technical effect. As the appellant rightly observes, the GPS unit in D1 is located under the cover of the motorcycle. Hence, the technical effect of the storage member cannot lie in the protection of the GPS unit

against the elements. Claim 1 does not define any details of the storage member, of the space it leaves around the GPS unit, or of its attachment. Hence, even if some embodiments of the storage member might have a technical effect, this does not apply to the storage member in the generality in which it is claimed. The technical effect alleged by the appellant does not apply, for example, if the storage member was a thin element that was attached to the GPS unit as an additional layer of protection. In that case the GPS unit could be removed together with the storage member, without any additional difficulty, compared to the situation without the storage member. Also, the storage member could be fixed to the cover of the motorcycle. In that case, when removing the cover, the storage unit would also be removed, and the GPS unit could have been removed without further difficulty. Consequently, the storage member, even if understood as an entity different from the case of the GPS unit, is not defined in sufficient detail to contribute to an inventive step.

44. For this reason, and for the reasons identified with regard to the Main Request, the subject-matter of claim 1 does not involve an inventive step (Articles 52(1) and 56). This applies to each of the two interpretations of the storage member. Hence, Auxiliary Request 2 is not allowable.

Auxiliary Request 3

45. Claim 1 of Auxiliary Request 3 adds, to claim 1 of Auxiliary Request 2, that the storage member has an upper, a front, and a rear plate, and a pair of side plates.

46. The appellant argues that this additional feature, at the latest, made it clear that the storage member was a different entity from any casing of the GPS unit. It was an additional protective element with a particular shape, which formed part of the motorcycle and was attached to the latter, and not to the GPS unit. The plates protected the GPS unit from five sides, the sixth, lower side already being protected against removal by the attachment member. All arguments set out with regard to Auxiliary Request 2 applied in an even stronger manner to Auxiliary Request 3.

47. The Board, however, does not agree. The storage member can still be understood as a casing because casings are commonly assembled from plates. It would, therefore, have been an obvious configuration for the GPS sensor in D1 to have such a casing. Even with the understanding that the storage member is a different entity from the casing of the GPS unit, the storage member still does not have a technical effect, irrespective of the plates.

48. Hence, the above findings regarding Auxiliary Request 2 still apply, and the subject-matter of claim 1 does not involve an inventive step for the same reasons (Articles 52(1) and 56 EPC), which is why Auxiliary Request 3 is also not allowable.

Auxiliary request 4

49. Auxiliary Request 4 was considered allowable, by the Examining Division.

50. The Board, however, sees clarity problems in the last integer of claim 1, which defines that

the front plate of the storage member extends obliquely downward to the front of the straddle-type vehicle from the upper plate, and/or a lower end of the front plate is provided under the seat, and is attached to the frame.

51. Due to the "and/or" combination, this feature comprises the following three alternatives:

(a) The front plate extends obliquely downward, but the lower end of the front plate is not under the seat.

(b) The lower end of the front plate is under the seat, but the front plate does not extend obliquely downward.

(c) The front plate extends obliquely downward, and its lower end is under the seat.

52. Option (b) is not clear. The skilled person does not understand what the front plate could look like if it is not oblique but (only) its lower end is under the seat.

53. According to the appellant, the front plate, in this case, extended downward from the front edge of the upper plate in a right angle, before making an approximately 90° bend to further extend towards the front of the vehicle and under the seat.

54. Such a shape is, however, not clear from the claim. Even if claimed appropriately, the Board sees no basis for it in the application as filed.

55. It is also not clear, to which of the three alternatives "..., and is attached to the frame" refers. It could refer to the "front plate" of alternative (a), to the "lower end of the front plate" of alternative (b), or to either of them. Due to the comma before the "and is attached", the reference is also unclear in alternative (c), which contains both the front plate and the lower end of the front plate.

56. The appellant did not comment on this clarity objection.

57. It follows that Auxiliary Request 4 is not allowable, because claim 1 is not clear (Article 84 EPC).

Auxiliary Request 4b

58. The claims of Auxiliary Request 4b correspond to claims 1 to 6, 10 and 11 of Auxiliary Request 4, with the exceptions that claim 1 is restricted to option (c) of the three options of the "and/or" combination listed under point 51., and that the comma before the "and is attached to the frame" is deleted. Hence, the clarity objections raised against claim 1 of Auxiliary Request 4 are overcome, and the claims are clear (Article 84 EPC).

59. Claim 1 of Auxiliary Request 4b is a combination of originally filed claims 1, 3, and 4, wherein the formerly optional features are no longer optional. Dependent claims 2 to 8 correspond to original claims 2, 5 to 8, 12 and 13. Hence, there is a validly derivable basis for the claims in the application as filed (Article 123(2) EPC).

60. Auxiliary Request 4 had been found allowable by the Examining Division and had been proposed for grant. Hence, there are also not objections from the Examining Division standing against the claims of Auxiliary Request 4b.

61. Unlike claim 1 of Auxiliary Requests 1 to 3, claim 1 of Auxiliary Request 4b defines an attachment of the lower part of the front plate of the storage member to the frame. The skilled person understands that this attachment of the storage member to the frame is separate from the attachment of the GPS unit to the frame through the unit attachment member. Taking this into account, an interpretation of the (implicit) casing of the GPS unit in D1 as a storage member, as is possible in Auxiliary Requests 1 to 3, is no longer a technically meaningful understanding. Therefore, the casing of the GPS unit and the storage member must be understood as two separate entities.

62. With this understanding, the subject-matter of claim 1 differs from D1, in addition to the features identified with regard to the Main Request, in the feature that

> *the GPS unit is stored in a storage member provided above the taillight, said storage member including an upper plate, a front plate, a rear plate, and a pair of side plates, the front plate of the storage member extends obliquely downward to the front of the straddle-type vehicle from the upper plate, and a lower end of the front plate is provided under the seat and is attached to the frame.*

63. The surrounding of the GPS unit on at least five sides by plates of a storage member that is attached to the frame has the technical effect of obstructing the access to the GPS device and complicating its removal.

64. The objective technical problem, therefore, is to make the access to, and thereby the removal of the GPS unit more difficult.

65. In the application, there are good reasons for solving this problem, because the GPS unit acts as a tracker and is able to trigger an alarm and to stop the engine if the motorcycle is stolen. A thief, therefore, would have an evident interest in removing the GPS unit, and the manufacturer of the motorcycle has a corresponding reason to address this problem (see paragraph [0084]).

66. However, the situation is different in D1, in which the GPS unit is only used for navigation. It is not a tracker and does not trigger an alarm, and a thief of the motorcycle has no cause to remove it. A thief might still consider steeling a GPS unit from a motorcycle for its own value. However, the GPS unit of D1 is arranged within the outer cover of the motorbike and is, thereby, already protected against theft. Hence, the skilled person would have had no motivation to solve the problem of making the access to the GPS device yet more difficult. Typically, it is a general desire in the manufacture of (not only) motorbikes to arrange its internal components such they can be easily repaired and exchanged. Also, it is a generally desirable to keep the number of components low, in order to ensure a low weight. These are additional reasons that would have prevented the skilled person from trying to make the GPS unit yet less accessible.

67. Even if, despite the above, the skilled person would have considered rendering the access to, and the removal of the GPS unit more difficult, she would have considered measures that would not add weight and complexity. For example, by using a strong attachment of the GPS unit to other parts of the motorcycle like the frame, or by hiding the GPS unit from the view, once the cover is removed.

68. It follows that the skilled person, starting from D1, would not have foreseen a storage member for the GPS unit that is attached to the frame of the motorcycle in the manner claimed. Hence the subject-matter of claim 1 involves an inventive step (Articles 52(1) and 56 EPC).

69. Since the Board also sees no other objections to the claims of Auxiliary Request 4b, they are allowable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the examining division with the order to grant a patent on the basis of the claims of auxiliary request 4b filed at oral proceedings before the Board, and to adapt the description and drawings, as necessary.

The Registrar: The Chair:

D. Meyfarth P. Scriven

Decision electronically authenticated