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**Datasheet for the decision
of 22 April 2024**

Case Number: T 0426/22 - 3.2.01

Application Number: 11820805.7

Publication Number: 2655165

IPC: B62D11/16, B60L11/14, B60K6/20,
B60K6/48, B60K6/445, B60K6/365

Language of the proceedings: EN

Title of invention:
SKI SLOPE GROOMER AND RELATIVE CONTROL METHOD

Patent Proprietor:
PRINOTH S.p.A.

Opponent:
Kässbohrer Geländefahrzeug AG

Headword:

Relevant legal provisions:
EPC 1973 Art. 52(1), 54, 56, 84, 123(2), 112(1)(a)
RPBA 2020 Art. 12(3), 12(5)

Keyword:

Referral to the Enlarged Board of Appeal (no)

Amendments - added subject-matter (no)

Novelty - main request (yes)

Inventive step - main request (yes)

Claims - clarity (yes)

Decisions cited:

T 0118/89

Catchword:



Beschwerdekammern

Boards of Appeal

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Case Number: T 0426/22 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 22 April 2024

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted on
16 December 2021 concerning maintenance of the
European Patent No. 2655165 in amended form.**

Composition of the Board:

Chairman G. Pricolo
Members: V. Vinci
S. Fernández de Córdoba

Summary of Facts and Submissions

- I. The appeal filed by the appellant (patent proprietor) is directed against the interlocutory decision of the opposition division maintaining the European patent No. 2 655 165 in amended form.

In its decision the opposition division found that the main request did not comply with the requirements of Article 123(2) EPC and decided to maintain the patent according to the first auxiliary request. In particular, the opposition division came to the conclusion that the subject-matter of independent claims 1 and 15 according to the first auxiliary request underlying the decision under appeal complied with the requirements of Article 123(2) EPC and was novel and not rendered obvious in view of the prior art within the meaning of Articles 52(1), 54 and 56 EPC in view of the following documents:

D1 : WO-A-03/035422 A1
D2 : US-1984830 B2
D3 : DE 29607651 U1
D3': US 2002/0079145 A1 (family member of D3)

- II. With the communication according to Article 15(1) RPBA dated 13 December 2023 the Board informed the parties of its preliminary assessment of the case.

Oral proceedings pursuant to Article 116 EPC were held before the Board on 22 April 2024 by videoconference.

- III. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form with the following

documents:

- Claims 1 to 20 according to the main request filed with the statement of grounds of appeal;
- Description: Paragraphs 3-8, 16-50 of the patent specification and paragraphs 1, 2, 9-15 filed during oral proceedings before the opposition division on 12 October 2021;
- Figures of the patent specification.

The respondent (opponent) requested a referral to the Enlarged Board of Appeal and that the appeal be dismissed.

The question to be referred (as filed by email during the oral proceedings) reads as follows:

"Ob die Beurteilung der Beschwerdekammer in dem oben genannten Verfahren zu den Merkmalen F 1.A, F1.B2 sowie F15.A und F15.B2 der Ansprüche 1 und 15 gemäß Hauptantrag bzgl. Art. 123 (2) EPÜ mit der einheitlichen Rechtsanwendung des EPA zu diesem Art. 123 (2) EPÜ übereinstimmt."

IV. The claims according to the main request in appeal are identical to the claims of the main request underlying the decision under appeal. Independent claim 1 thereof reads as follows (labelling of the features according to the decision):

F1.1' *"A ski slope groomer (1) comprising:*

F1.2 - a first and second track (3, 4) driven 5 by a first and second drive wheel (5, 6) respectively;

F1.A an accessory assembly (11) comprising a tiller (12) and a blade (13), and preferably a winch (14);

F1.3 an internal combustion engine (15); and

F1.4 electric power transmission assembly (17) and

F1.5 a mechanical power transmission assembly (16) for connecting the internal combustion engine (15) to the first and second drive wheel (5, 6);

F1.6 the mechanical power transmission assembly comprising:

a mechanical power connection (22) for transferring energy between the electric power transmission assembly (17) and the mechanical power transmission assembly (16);

F1.7 and at least one mechanical power transmission (26,27) for transferring energy between the electric power transmission assembly (17) and the mechanical power transmission assembly (16); and

F1.8 wherein the electric power transmission assembly (17) extends from the mechanical power connection (22) to the mechanical power transmission (26, 27);

F1.B1 the ski slope groomer comprising a third electric machine (33) connected electrically to an electric transmission line (35), and mechanically to tiller (12) to transfer kinetic energy to tiller (12);

F1.B2 preferably the ski slope groomer (1) comprising a fourth electric machine 5 (34) is connected

electrically to the electric transmission line (35), and mechanically to winch (14) to transfer kinetic energy to winch (14)."

Independent claim 15 according to the main request, reads as follows (labelling of the features according to the decision):

F15.1' *"A method of controlling a ski slope groomer;*

F15.2 *the ski slope groomer comprising:*

a first and second track (3, 4) driven by a first and second drive wheel (5, 6) respectively;

F15.A *an accessory assembly (11) comprising a tiller (12), and a blade (13) and preferably a winch (14);*

F15.3 *an internal combustion engine (15);*

F15.4 *and an electric power transmission assembly (17) and*

F15.5 *a mechanical power transmission assembly (16) for connecting the internal combustion engine (15) to the first and second drive wheel (5, 6);*

F15.6 *the mechanical power transmission assembly comprising a mechanical power connection; and*

F15.7 *at least one mechanical power transmission (26, 27);*

F15.B1 *the ski slope groomer comprising a third electric machine (33) connected electrically to an*

electric transmission line (35), and mechanically to tiller (12) to transfer kinetic energy to tiller (12);

F15.B2 preferably the ski slope groomer (1) comprising a fourth electric machine (34) connected electrically to the electric transmission line (35), and mechanically to winch (14) to transfer kinetic energy to winch (14);

F15.8 the method comprising the steps of transferring energy between the mechanical power transmission assembly (16) and the electric power transmission assembly (17) by means of the mechanical power connection (22); and

F15.9 transferring energy between the electric power transmission assembly (17) and the mechanical power transmission assembly (16) by means of the mechanical power transmission (26, 27)."

Reasons for the Decision

Article 123(2) EPC: Amendments

1. Contrary to the conclusion of the opposition division in the decision under appeal the subject-matter of independent claims 1 and 15 according to the main request meets the requirements of Article 123(2) EPC.
- 1.1 With their appeal, the appellant (patent proprietor) contested the findings of the opposition division that the subject-matter of independent claims 1 and 15 of the main request did not comply with the requirements of Article 123(2) EPC. It was essentially argued that for a skilled reader the fact that independent claims 1

and 15 were amended to recite that the accessory assembly (11) of the claimed ski slope groomer "*preferably*" comprised a winch (14) (feature F1.A) operated by a fourth electric machine (34) associated thereto (feature F1.B2) did not result in an unallowable intermediate generalisation infringing Article 123(2) EPC.

1.2 It is uncontested - as pointed out by the respondent (opponent) - that the originally filed application explicitly discloses a crawler vehicle, in particular a ski slope groomer (see page 4, lines 21-23), comprising an accessory assembly (1) in turn comprising in combination a tiller (12), a blade (13) and a winch (14) (see description, page 5, lines 6-7 as well and Figures 1 and 2). It is also uncontested that the application as originally filed does not contain any explicit indication that the winch (or any other accessory) and the associated electric machine (34) are optional/preferred features.

1.3 Based on the above undisputed facts and in accordance with the reasoning of the opposition division, the respondent (opponent) maintained that the introduction of the term "*preferably*" in features F1.A and F1.B2 of claim 1, which rendered the provision of the winch and of the fourth electric machine associated thereto merely optional, resulted in an undisclosed and hence unallowable intermediate generalisation of the only specific embodiment of the ski slope groomer described in the originally filed application which unambiguously comprised an accessory assembly including a tiller, a blade and a winch in combination. The respondent (opponent) also observed that the wording of the amended claim 1 according to the main request encompassed four possible alternatives, two of them

being fully undisclosed, namely (1) a ski slope groomer with a tiller, a blade, a winch and a third electric machine, and (2) a ski slope groomer with a tiller, a blade and a third and a fourth electric machine. The respondent (opponent) argued that a correct application of the "*gold standard*" could only confirm the conclusion of the opposition division that the amendments to claim 1 introduced information which were not directly and unambiguously derivable for a person skilled in the art reading the originally filed application. With a second reply dated 12 February 2024 the respondent (opponent) maintained the previously raised arguments. In reaction to the preliminary opinion of the Board stating that the term "*accessory assembly*" inherently implied for the skilled reader that the accessory assembly and hence any of its components including the winch had to be considered optional, the respondent (opponent) argued that while this assumption could make some technical sense in the context of claim 1 as filed which was directed to a generic "*crawler vehicle*", it was unfounded when referred to a "*ski slope groomer*" to which claim 1 was restricted. In this respect they put forward that the person skilled in art readily realized that a ski slope groomer, if deprived of the accessories at issue, contrary to a generic crawler vehicle, was not able to carry out its intended and main functionality, namely to prepare and make safe a ski slope for the skiers. In their opinion this result could not be achieved without providing the accessories mentioned on page 5, lines 6-7 of the application as originally filed because in their absence the functionality of the ski slope groomer would be limited to a mere compacting of the snow with concomitant and unavoidable generation dangerous snow lumps caused by the tracks. The respondent (opponent) thus concluded that the person

skilled in the art, reading the application as filed in the light of common general knowledge would not consider the accessory assembly and its three components mentioned always in combination in the originally filed description as optional technical features. The respondent (opponent) thus concluded that reciting the winch and the fourth electric machine associated thereto as optional features of the claimed ski slope groomer resulted in an unallowable intermediate generalisation infringing Article 123(2) EPC as correctly stated by the opposition division.

- 1.4 The Board is not convinced and cannot follow the arguments of the opposition division and the respondent (opponent):

According to established case law of the Boards of Appeal, in order to decide compliance of an amendment with the requirements of Article 123(2) EPC it has to be assessed whether the amendment at issue is directly and unambiguously derivable from the whole application as filed for a person skilled in the art reading it in the light of common general knowledge (so called "*gold standard*"). The Board takes the view that according to common understanding the term "*accessory*" is indeed generally used to qualify an item which might be additionally and optionally provided on a main item as an add-on element. Therefore, the expression "*accessory assembly*" inherently contains the indication that the assembly represents an optional feature of the disclosed sky slope groomer and therefore that any or all of its disclosed components, namely the tiller, the blade and the winch can be omitted. Regarding the argument of the respondent (opponent) that unlike the case of a generic "*crawler vehicle*" the above mentioned interpretation of the term "*accessory*

assembly" did not apply to the technical context of a ski slope groomer, the Board cannot see any reason why, should an "accessory assembly" be always required to carry out the functionality intended for this kind of vehicle, it must mandatorily includes all three accessories presented in combination in the description and in particular a winch. For example a ski slope groomer comprising a tiller and a blade would be perfectly able to carry out at least some of the expected functionalities, i.e. preparing a ski slope even in absence of a winch. The Board thus shares the view of the appellant (patent proprietor) that an expert in the technical field of the design and operation of ski slope groomers reading the application as filed in the light of common general knowledge is aware that the decision of whether the sky slope groomer must be equipped with an accessory assembly and - should this be the case - which specific accessories must be provided, only depends on the expected operation requirements. Further, the Board concurs with the view of the appellant (patent proprietor) that - contrary to the allegation of the respondent (opponent) - the winch and the fourth electric machine associated thereto are not inextricably and functionally linked to any other features of the disclosed sky slope groomer, in particular to the presence of the tiller and/or the blade. In fact the Board has no doubt that these two accessories could indeed be provided and operated (or not) irrespective of the presence of the winch which does not have any decisive relevance when flattening and preparing the sky slope has to be carried out. Contrary to the respondent's (opponent's) allegation, this conclusion is supported by the block diagram in Figure 2 of the application as originally filed which shows that the winch (14) and the associated fourth electric machine (34) (see feature F1.B2) can be

removed from the ski slope groomer without essentially modifying the basic structure and drive of the machine or being detrimental to its capability to operate only with the blade and the tiller installed. Therefore, also regarding feature F1.B2, the Board takes the view that the person skilled in the art directly and unambiguously derives from the diagram in Figure 2, that the provision of a fourth electric machine is only technically linked to the optional presence of the winch and therefore is also not mandatory. The same conclusions apply for the same arguments to the subject-matter of independent method claim 15.

- 1.5 Therefore, contrary to the findings of the opposition division, the Board concludes that the expression "*preferably*" introduced in features F1.A and F1.B2 of claim 1 and in features F15.A and F15.B2 of claim 15 according to the main request does not result in any unallowable intermediate generalisation of the specific embodiment presented in the description, whereby this amendment does not infringe Article 123(2) EPC.

2. No further written submissions were made by the parties in respect of the alleged lack of clarity, lack of novelty, and lack of inventive step, in reaction to the preliminary opinion issued by the Board with the communication according to Article 15(1) RPBA dated 13 December 2023. At the oral proceedings they confirmed that regarding these issues they relied on the arguments presented in writing. Consequently, the Board has no reasons to deviate from the assessment of these objections as presented in its preliminary opinion which is herewith confirmed and reads as follows:

Clarity: Article 84 EPC

3. The subject-matter of independent claims 1 and 15 according to the main request complies with the requirements of Article 84 EPC as correctly assessed by the opposition division.
- 3.1 With their reply to the statement of grounds of appeal of the appellant (patent proprietor), the respondent (opponent) maintained that the subject-matter of independent claims 1 and 15 lacked clarity within the meaning of Article 84 EPC. It was argued that the fact that claims 1 and 15 recited a third and a fourth electric machine (see features F1.B1 and F1.B2 and F15.B1 and F15.B2 respectively) without having previously defined a first and a second electric machine rendered the scope of the protection afforded by the claims unclear.
- 3.2 However, the Board shares the view of the opposition division that the objected inconsistency is of mere formal nature and does not prevent the person skilled from clearly establishing the intended scope of protection. The Board considers that the person skilled in the art reading and construing the claims with a mind willing to understand has no doubt that the expressions "*third electric machine*" and "*fourth electric machine*" merely designate two distinguished electric machines which are meant to drive the tiller and the winch (when provided) respectively, and this irrespective of the inconsistent numbering adopted in the claim. Also the lack of clarity raised by the appellant (opponent) against the formulation of feature F1.B2 is unjustified because there cannot be any doubt that the verb "*is*" (see second line of this feature) is clearly redundant. The reader would thus read feature

F1.B2 in the same way as in feature F1.B1, i.e. by disregarding the verb "is" as being erroneously present in the second line of this feature.

Articles 52(1) and 54 EPC: Novelty

4. The subject-matter of independent claims 1 and 15 according to the main request is novel over the prior art within the meaning of Articles 52(1) and 54 EPC and this irrespective of the assessment of the objection raised by the appellant (patent proprietor) against the decision of the opposition division to admit document D3/D3' and of the disputed question of the admittance of the novelty attacks based on D1 and D2.

Novelty over D3/D3'

- 4.1 The respondent (opponent) contested the conclusion of the opposition division that document D3/D3' did not disclose features F1.5 and F1.6 to F1.8 of claim 1 according to the auxiliary request 1 underlying the decision under appeal, said features being also recited in claim 1 of the main request under examination.
- 4.2 However, the Board follows the view of the opposition division that in the drive system according to D3/D3' (see Figures 1 and 2) the internal combustion engine (2) is not connected to the first and second driving wheels by a mechanical power transmission assembly as required by feature F1.5, but rather and directly to the generator (10), whereas the drive sprockets (4) are mechanically connected via planetary gears (13,14) only to the electric motors (11,12). Consequently D3/D3' does not disclose feature F1.5 of claim 1 of the main request. As a consequence, also features F1.6 to F1.8 which imply the provision of such

a mechanical power transmission assembly are also not directly and unambiguously disclosed in D3/D3'. The same conclusions apply for the same reasons to the corresponding features of independent method claim 15 which is thus also novel over D3/D3'.

Novelty over D1 or D2

- 4.3 Irrespective of the decision on the admissibility of these attacks, these prior art documents are not prejudicial to novelty of the subject-matter of claims 1 and 15 according to the main request. Contrary to the allegation of the respondent (opponent), D1 does not directly and unambiguously disclose a sky slope groomer comprising an accessory assembly according to feature F1.A, but merely a power split hybrid wheel drive system. The same applies to the technical disclosure of document D2.

Articles 52(1) and 56 EPC: Inventive Step

5. The subject-matter of claims 1 and 15 of the main request is not rendered obvious by the cited prior art within the meaning of Articles 52(1) and 56 EPC.

- 5.1 The respondent (opponent) submitted following lines of inventive step attack which are however not convincing:

D3/D3' in combination with D1

- 5.2 The respondent (opponent) reiterated the arguments submitted during the first instance oral proceedings in respect to claims 1 and 15 of the narrower auxiliary request 1. These arguments as well as the reasoning of the opposition division also apply to the subject-matter of claims 1 and 15 of the main request under

discussion, and this because they are not linked to the presence of the winch. The respondent (opponent) argued that the person skilled in the art starting from D3/D3' and aiming to make the drive system of the ski slope groomer of D3/D3' redundant in order to face and compensate for the possible failure of any electric component will obviously consider to introduce the hybrid drive system of D1 in the ski slope groomer of D3/D3', thereby arriving without inventive step to the subject-matter of claims 1 and 15 of the main request.

- 5.3 In accordance with the arguments provided by the opposition division and the appellant (patent proprietor), the Board considers that the choice of the hybrid system of D1 is not univocal and hence non obvious. In fact there are several other solutions to the technical problem at stake as stated under point 5.2 above which can be implemented, for example to provide redundancy at the level of the electric component of the drive system as already suggested in D3/D3'.

D1 in combination with D2 and common general knowledge as represented for example by D3/D3'

Admissibility

- 5.4 This line of arguments was never submitted by the respondent (opponent) during the opposition proceedings. The Board also observes that the respondent (opponent) under point 6. of their reply merely made the unsubstantiated allegation that the combination of D1 with D2 or common general knowledge would result in an obvious manner to the subject-matter of independent claims 1 and 15 of the main request. No further submissions were made by the respondent (opponent) in reaction to the communication pursuant

Article 15(1) RPBA, in which the Board expressed its preliminary view that these new attacks were likely to be disregarded, or at the oral proceedings. In view of the above the Board decided to disregard this new line of attack under Article 12(5) in combination with Article 12(3) RPBA.

Request for Referral of the Case to the Enlarged Board of Appeal

6. With the reply to the communication of the Board pursuant Article 15(1) RPBA dated 12 February 2024 the respondent (opponent) requested the Board, should their arguments regarding compliance with Article 123(2) EPC not be followed, to refer a question to the Enlarged Board of Appeal pursuant to Article 112(a)(1) EPC in order to ensure uniform application of the law. Stay of the proceedings was also requested. The question was specifically formulated only at the oral proceedings by submitting it by Email (see point III above). Essentially, the respondent requested a review by the Enlarged Board of Appeal of the assessment made by the present Board as regards the requirements of Article 123(2) EPC in connection with features F1.A, F1.B2 and F15.A, F15.B2 of claims 1 and 15, respectively.

6.1 Under Article 112(1)(a) EPC it is for the Boards of Appeal to refer a case to the Enlarged Board of Appeal if this appears necessary for ensuring uniform application of the law or if a point of law of fundamental importance arises. Since the present Board followed the established jurisprudence with respect to the issue of added subject-matter ("gold standard", see point 1.4 above), uniform application of the law is not at issue. The question also does not address an important point of law needing to be considered by the

Enlarged Board of Appeal.

In fact, the question formulated by the appellant is not a question of law but a question of fact (see in this respect in particular decision T 118/89, point 5 of the reasons), i.e. of how a skilled person would assess the content of the application as filed and of whether the amendments made go beyond the content thereof . This is an issue to be decided by the Board depending on the circumstances of the case.

6.2 For these reasons the requested referral to the Enlarged Board of Appeal is to be rejected.

Order

For these reasons it is decided that:

1. The request for a referral to the Enlarged Board of Appeal is rejected.
2. The decision under appeal is set aside.
3. The case is remitted to the opposition division with the order to maintain the patent in amended form with the following documents:
 - Claims 1 to 20 according to the main request filed with the statement of grounds of appeal;
 - Description: Paragraphs 3-8, 16-50 of the patent specification and paragraphs 1, 2, 9-15 filed during oral proceedings before the opposition division on 12 October 2021;
 - Figures of the patent specification.

The Registrar:

The Chairman:



M. Schalow

G. Pricolo

Decision electronically authenticated