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Aktenzeichen / Case Number / N^o du recours : T 638/89 - 3.4.2

Anmeldenummer / Filing No / N^o de la demande : 81 109 362.4

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Bezeichnung der Erfindung: Apparatus for measuring tire uniformity
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : G01M 17/02

ENTSCHEIDUNG / DECISION

vom / of / du 9 November 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

KABUSHIKI KAISHA TOYOTA CHUO KENKYUSHO

Einsprechender / Opponent / Opposant :

Gebr. Hofmann GmbH & Co. KG Maschinenfabrik

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Articles 111(1) and 104(1) EPC

Schlagwort / Keyword / Mot clé :

"Remittal of the case to the Opposition
Division (yes); Apportionment of costs (no)"

Leitsatz / Headnote / Sommaire

Summary of Facts and Submissions

- I. European patent No. 0 052 809 was granted on the basis of European patent application No. 81 109 362.4.
- II. The opposition filed by the Appellant against the patent was rejected by decision of the Opposition Division.
- III. The Appellant (Opponent) lodged an appeal against the decision. In his Statement of the Grounds of Appeal he only invoked document DE-A-1 648 435 (M) which had neither been cited in the examination nor in the opposition procedure. The Appellant essentially stressed that document M disclosed a number of features, corresponding in effect to the features set out in granted Claim 1 valid at this time and, thus, implicitly challenged the novelty of its subject-matter.
- IV. Oral proceedings were held before the Board at the end of which the Appellant requested that the decision under appeal be set aside and that the patent be revoked.

The Respondent (Patentee) requested that the appeal be dismissed and, in accordance with his main request, that the patent be maintained on the basis of Claims 1 to 11 filed as "main request" during the oral proceedings, of which Claim 1, the only independent claim, reads as follows:

- "1. A tire uniformity measuring apparatus comprising
 - (a) a drum (11, 21, 31) contacting a tire (T) to be measured;

- (b) a rotatable shaft (12, 22, 32) having an attachment for securing the tire in position;
- (c) a drive source (M);
- (d) a load applying means (14, 24, 34) for applying a predetermined load directly on the tire by a movement of said drum for changing an interaxial distance between said drum and rotatable shaft;
- (e) a movable member (13, 23) being movable about a fulcrum being rigidly supported on the measuring apparatus in response to a force acting between said drum (11, 21, 31) and the tire (T) to be measured;
- (f) a displacement detecting means (15, 25, 35) for detecting a displacement of said movable member dependent on a variation in a load applied radially to the tire while the latter is rotated by said drum and
- (g) display means (16, 26, 36) for displaying the variation in the load applied radially to the tire in response to the displacement of said movable member,

c h a r a c t e r i z e d in that

- (h) said movable member (13, 23) has a part rotatably and coaxially supporting said rotatable shaft (12, 22, 32),
- (i) said drum (11, 21, 31) is rotatively driven by the drive source (M) and rotates the tire and that

(j) the longitudinal axis of said movable member (13, 23, 33) is disposed in parallel with the rotation axis of the drum."

As a first auxiliary request, the Respondent requested that the patent be maintained on the basis of Claims 1 to 11 filed as "first auxiliary request" during the oral proceedings (in the opinion of the Board the expression "Claims 1 to 11" should read "Claims 1 to 10" because Claim 3 of the first auxiliary request filed at the oral proceedings does not include the subject-matter of Claim 3 as granted, as proposed by the Respondent in his manuscript page entitled "B1. Auxiliary request" presented at the oral proceedings). This set of claims comprises two independent Claims 1 and 3, which in effect correspond to a combination of the features of independent Claim 1 of the main request with those of dependent Claims 2 and 3 as granted, respectively.

As a second auxiliary request, the Respondent requested that the case be remitted to the Opposition Division for further prosecution.

As an independent request, the Respondent requested a decision apportioning the costs incurred by his representative and charged to him for responding to the appeal.

- V. In support of his request, the Appellant essentially argued that document M disclosed a tire uniformity measuring apparatus comprising a detecting means ("Kraftmeßdose" 17) capable of detecting variations in the load applied radially to the tire and which is not influenced by any axial force simultaneously exerted on it.

Accordingly, the subject-matter of Claim 1 of the main

request was distinguished from this known apparatus only in that the fulcrum about which the movable member was rotatably mounted was rigidly supported on the measuring apparatus instead of being axially movable, and in that the load was applied directly on the tire by a movement of the drum instead of being applied on the movable member.

However, the apparatus of document M was intended for measuring both radial and axial forces, and to a skilled person interested in determining only the radial component it would be obvious to dispense with such slidably mounting of the fulcrum. Moreover, load applying means for applying a predetermined load directly and radially on the tire by a movement of a drum was known from document US-A-3 661 014 (document E) and the skilled person could incorporate it in the apparatus of document M without the exercise of any inventive ingenuity.

Concerning the late citing of document M at the appeal stage, the Appellant stressed that the desirability of filing another document showing a tire uniformity measuring apparatus comprising a member being movable about a fulcrum, had arisen only during the oral proceedings held before the Opposition Division at the end of the opposition procedure, when it appeared that the Opposition Division questioned the fact that the structure disclosed in the document "Dynamic Measurement of Vehicle Front Wheel Loads Using a Special Purpose Transducer" by Sonny G. Edwards, General Motors Engineering Journal, 4th quarter 1964, pages 15 to 18 (document L), or in "ATZ" 1967, pages 251 to 255 (document I) could actually be equated with a fulcrum.

- VI. The Respondent for his part submitted that an essential feature of the claimed apparatus was to be seen in the absence of decoupling between the radial and axial forces detected by the apparatus. The recognition that such

decoupling was not paramount for the obtention of satisfactory measurements could not be obvious from the prior art since the citations on file all disclosed tire uniformity measuring apparatus providing such decoupling.

In addition, since document M explicitly taught that the axis of the tire and of the drum should be kept strictly parallel, the skilled person had no obvious reason to provide instead for a substantial displacement of the member supporting the tire about a fulcrum.

In support of his second auxiliary request for remittal of the case to the Opposition Division for further prosecution, the Respondent stressed that document M was invoked for the first time in the Appellant's Statement of the Grounds of Appeal in which, furthermore, no mention was made to the appealed decision itself. Accordingly, Appellant's appeal amounted virtually to the filing of a new opposition. The Board, therefore, should remit the case to the Opposition Division for further prosecution in order not to deprive the Patentee of one level of jurisdiction, in accordance with the findings in the decision T 416/87 - 3.3.1 (OJ EPO 1990, 415).

As concerns his independent request for apportionment of the costs of the appeal procedure, the Respondent, referring again to the above-mentioned decision T 416/87, submitted that such apportionment of the costs was justified by reasons of equity because of the late filing of document M.

Reasons for the Decision

1. The appeal is admissible.
2. Admissibility of document M into the procedure.

Document M has been cited by the Appellant for the first time in his Statement of the Grounds of Appeal, which is long after expiry of the opposition period set out in Article 99(1) EPC.

However, the Board, having examined document M of its own motion in accordance with Article 114(1) EPC, considers it to be highly relevant for judging the patentability of the subject-matter of the patent, as already indicated in the communication pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal dated 2 August 1990. Therefore, in accordance when the principles set out in the decision T 156/84 - 3.4.1 (OJ EPO 1988, 372; point 3 of the Reasons) the Board can admit document M into the procedure.

3. Amendments

Claim 1 according to the main request differs from the granted Claim 1 by the addition of "directly" and "a movement of said drum for" in feature d), and by the addition of "being rigidly supported on the measuring apparatus" in feature e).

The feature "movement of the drum" corresponds to the feature contained in granted Claim 4 (original Claim 5). The fact that the load is applied "directly" on the tire is clearly shown in Figures 4, 5, 7, 8, 10 and 11 (cf. also page 24, lines 1 to 8 of the original description).

For the embodiment relating to a cantilever beam movable about a constricted portion forming a fulcrum, the fact that the fulcrum is "rigidly supported on the measuring apparatus" follows from granted Claim 2 (original Claim 3) and page 5, lines 37 to 38 of the patent specification (original page 14, lines 4 to 5) as well as Figure 5. For

the other embodiment comprising a pivot arm pivotably supported at its center (fulcrum), Figure 8 and the text page 6, lines 52, of the patent specification (original page 19, lines 7 and 8) disclose the fact that the fulcrum is "rigidly supported".

All these amendments merely produce a limitation of the scope of protection conferred.

The Board is therefore satisfied that the amendments to the granted claims do not violate Article 123(2) and (3) EPC. This fact has also not been contested by the Appellant.

Independent Claims 1 and 3 according to the first auxiliary request correspond to a combination of Claim 1 according to the main request with granted Claims 2 and 3, respectively. Thus, they do not infringe either Article 123(2) and (3) EPC.

4. Remittal of the case to the Opposition Division

Since document M was first filed (and the subsequent amendments of the claims introduce features which were not recited in any of the granted claims) at the appeal procedure, the Opposition Division has had no opportunity to consider the patentability of the present claims in view in particular of the prior art disclosed in document M.

Accordingly, the Board deems it appropriate in the present circumstances to make use of the power conferred upon it by Article 111(1) EPC not to decide on the main and first auxiliary requests of the Respondent, but to remit the case to the Opposition Division for further prosecution so as to allow the Respondent's main and first auxiliary requests to be examined in the first instance and not to deprive him of one such instance, in compliance with

earlier decisions of the Boards of Appeal (T 156/84 above, point 3.8, last paragraph; T 273/84: OJ EPO 1986, 346, points 6 and 7 of the Reasons, T 326/87 to be published).

5. Apportionment of costs

According to Article 104(1) EPC, each party to the proceedings shall meet the costs it has incurred unless a different apportionment of costs incurred during taking of evidence or in oral proceedings is ordered by an Opposition Division or Board of Appeal "for reasons of equity".

The Board considers the declaration of the Appellant credible, which declaration indicates that up to the end of the opposition procedure the Appellant was convinced that documents like L and I provided sufficient proof for the fact that a tire uniformity measuring apparatus having a fulcrum in the sense of the present invention was known, and that the Appellant did not realize the negative opinion of the Opposition Division regarding this point until at the oral proceedings.

Thus, in the view of the Board, the Appellant did not file a new opposition at the appeal stage as claimed by the Respondent, but - although not explicitly referring to the appealed decision - reacted to the interpretation given by the Opposition Division by filing a document which took better account of this interpretation.

In this respect, the case on which the decision T 416/87 referred to by the Respondent was based, differs decisively from the present case. The filing of document M at this stage of the present procedure cannot be regarded, in contrast with the situation referred to in the decision T 416/87, as an abuse of procedure (cf. T 416/87, point 10 of the Reasons, second paragraph).

Accordingly, Appellant's independent request for a decision apportioning the costs incurred by his representative and charged to him for responding to the appeal according to Rule 63 EPC cannot be accepted.

Order

For these reasons, it is decided that:

1. The decision of the Opposition Division is set aside.
2. The case is remitted to the Opposition Division with the order to continue the procedure giving due relevance to document DE-A-1 648 435, presented for the first time before the Board of Appeal.
3. The independent request by the Respondent for apportionment of costs is rejected.

The Registrar:

The Chairman:

P. Martorana

E. Turrini