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**Datasheet for the decision
of 31 October 2007**

Case Number: T 0397/04 - 3.2.06

Application Number: 96104717.2

Publication Number: 0722800

IPC: B23B 31/12

Language of the proceedings: EN

Title of invention:
Non-impact keyless chuck

Patentee:
POWER TOOL HOLDERS, Inc.

Opponent:
Röhms GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 113(2)
RPBA Art. 10b(1)

Keyword:
"Late-filed submissions - not admitted"

Decisions cited:
T 0397/01

Catchword:
-



Case Number: T 0397/04 - 3.2.06

DECISION
of the Technical Board of Appeal 3.2.06
of 31 October 2007

Appellant:
(Opponent)

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Respondent:
(Patent Proprietor)

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Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
15 January 2004 concerning maintenance of
European patent No. 0722800 in amended form.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: M. Harrison
R. Menapace

Summary of Facts and Submissions

- I. In its interlocutory decision posted on 15 January 2004, the opposition division found that European patent number 0 722 800 in its amended form met the requirements of the European Patent Convention. The amended form corresponded to the proprietor's 5th auxiliary request filed during the opposition proceedings.
- II. The proprietor (appellant I) and the opponent (appellant II) each filed an appeal against the decision; appellant I requested maintenance of the patent in an amended form according to one of its 1st to 4th auxiliary requests whilst appellant II requested revocation of the patent.
- III. In the Board's communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal, the subject matter of claim 1 of each request was questioned in regard to whether there was a basis for such subject matter in the content of the application as filed or the parent application.
- IV. In its submission of 16 June 2006, appellant I filed auxiliary requests 6 to 8 involving various amendments to the wording of claim 1. In its submission of 1 October 2007, appellant I filed a further auxiliary request, referred to as "auxiliary submission 9" containing a further amended claim 1.
- V. During the oral proceedings of 31 October 2007, appellant I requested that the patent be maintained in an amended form on the basis of claim 1 of one of its

auxiliary submissions 13 to 16 as filed during the oral proceedings. Auxiliary submissions 13 to 16 were filed after several previous requests by appellant I filed during the written and oral proceedings had been discussed with the parties and subsequently withdrawn. Auxiliary submissions 15 and 16 were filed shortly before the Chairman closed the debate in the oral proceedings.

- VI. Claim 1 of "auxiliary submission 13" reads as follows:
"A chuck for use with a manual or powered driver having a rotatable drive shaft, said chuck comprising a generally cylindrical body member (16) having a nose section (20) and a tail section (22) and a first and a second circumferential grooves (36, 82) formed therein intermediate said nose and tail sections, said tail section (22) having a first axial bore (26) formed therein to mate with said drive shaft of said driver and said nose section (20) having a second axial bore (24) formed therein and a plurality of angularly disposed passageways (30) formed therethrough and intersecting said second axial bore (24) and said first circumferential groove (36), a plurality of jaws (18) slidably positioned in each of said angularly disposed passageways (30) each of said jaws (18) having a tool engaging face (32) formed on one side thereof and threads (34) formed on the opposite side thereof, a split nut (38) rotatably mounted in said first circumferential groove (36) and in threaded engagement with said threads (34) on said jaws (18), said nut (38) having a first bearing race (46) formed thereon, a generally cylindrical front sleeve member (12a) fixed on said nut and overlying the said nose section (20) of said body member (16), a bearing thrust ring (50) fixed

on said body member (16) and having a second bearing race (54) formed thereon and in juxtaposition with said first bearing race (46) and an anti-friction bearing (48) disposed between said first and second bearing races (46, 54), characterized in that said nut (38) has an annulus (64) fixed on an outer circumferential surface thereof, said annulus has a plurality of flexible teeth (68) formed on an outer circumferential surface thereof, said front sleeve member (12a) having an axial bore (72) and a plurality of teeth (70) formed on said axial bore and adapted to engage with said plurality of teeth (68) on said annulus (64), a sleeve retainer disc (84) being fixed in said axial bore (72) of said front sleeve member (12a) and being rotatably mounted in said second circumferential groove (82) to retain said front sleeve member (12a) with respect to said body member (16), wherein the teeth (70) of the front sleeve member (12a) are substantially symmetrical about a radius of the front sleeve member, and have a surface angle configured to depress or deform the teeth (68) on the annulus, whereby the teeth (70) of said front sleeve member (12a) pass over the teeth of said annulus (64) at a predetermined tightening torque.

VII. Claim 1 of "auxiliary submission 14" is the same as that of "auxiliary submission 13" with the exception that the word "fixed" has been removed from the expression "a generally cylindrical front sleeve member (12a) fixed on said nut and overlying the said nose section..."

VIII. Claim 1 of "auxiliary submission 15" is the same as that of "auxiliary submission 13" with the exception that the wording

"are substantially symmetrical about a radius of the front sleeve member, and"

has been deleted from the expression

"...the teeth (70) of the front sleeve member (12a) are substantially symmetrical about a radius of the front sleeve member, and have a surface angle..."

and by the wording

"a series of axial slots intermediate the inner and outer surfaces of the annulus, and"

being added after the words "...fixed on an outer circumferential surface thereof, said annulus has"

in the characterizing portion of claim 1.

IX. Claim 1 of "auxiliary submission 16" is the same as that of "auxiliary submission 15" with the exception that the word "fixed" has been removed from the expression "a generally cylindrical front sleeve member (12a) fixed on said nut and overlying..."

X. The submissions of appellant I may be summarised as follows:

(i) with regard to claim 1 of auxiliary submissions 13 and 14, the expression "...the teeth (70) of the front sleeve member (12a) are substantially symmetrical about a radius of the front sleeve member, and have a surface angle..." was within the content of the application as

filed (see column 7, lines 5 to 16 of the published application). This added expression was adapted to the wording used in the description, yet no subject matter was added. The requirements of Article 123(2) EPC were thus met. Although the requests were late filed, they dealt with all the open issues including those arising during the oral proceedings.

(ii) with regard to claim 1 of auxiliary submissions 15 and 16, the expression "are substantially symmetrical about a radius of the front sleeve member, and" was removed compared to the wording used in claim 1 of auxiliary submission 13 and the expression "a series of axial slots intermediate the inner and outer surfaces of the annulus, and" was added in order to take account of comments arising during the discussions about auxiliary request 13 in relation to Article 123(2) EPC. The provision of axial slots as disclosed in column 6, lines 40 to 42 was now included such that any alleged generalisation of the features of the disclosed embodiments could be ruled out.

XI. The arguments of appellant II can be summarised as follows:

(i) as regards auxiliary submissions 13 and 14, claim 1 of each extended beyond the content of the application as filed since e.g. axial slots were not defined and these were disclosed as an integral part of the embodiments from which the patentee had derived the amendment introduced into claim 1; this was clear from column 6, line 35 *et seq.* The requests were also filed very late in proceedings and contained amendments from

the description. The requests were not allowable at least for this reason and should not be admitted.

(ii) as regard auxiliary submissions 15 and 16, these were extremely late and should not be admitted. Insufficient time was available to study the request in detail in particular as the claim was already fairly complicated in its formulation. The deletion of certain wording and the addition of further wording did not overcome all the objections existing against the previous requests.

Reasons for the Decision

1. *Auxiliary submission 13*

The request to maintain the patent based on claim 1 of auxiliary submission 13 was filed late, the request having been filed for the first time during the oral proceedings. Such a late-filed request must therefore be considered under Article 10b(1) of the Rules of Procedure of the Boards of Appeal (RPBA), whereby admittance of the request into proceedings is at the Board's discretion.

In accordance with well established case law (see e.g. T 397/01), a request filed at a late stage in proceedings should only be admitted if it is *prima facie* allowable. In the present case, the features concerning the provision of tightening torque limiting means, namely "...wherein the teeth (70) of the front sleeve member (12a) are substantially symmetrical about a radius of the front sleeve member, and have a surface

angle configured to depress or deform the teeth (68) on the annulus", were not in the granted or filed claim and have been introduced for the first time by way of this submission. These features are based on the embodiments shown in Figures 5E to 5G and described in column 7, lines 5 to 16 of the published application. However, column 7, lines 5 and 6 of the published application states that "Figs. 5E-5G show modifications of the structures respectively shown in Figs. 5B-5D." Referring to Figures 5E to 5G, and to the structures shown in Figures 5B-5D as well as the description of those embodiments in column 6, lines 47 to column 7, line 4, it is disclosed *inter alia* that the annulus is provided with "a series of open slots which result in a series of pawls having a tooth at the end thereof ...". No explicit or implicit unambiguous disclosure exists that the disclosed pawls can be omitted at the same time as maintaining the other "modified" features described with respect to Figures 5E to 5G. The pawl structure is however omitted from the features of the tightening torque limiting means introduced into claim 1 of auxiliary submission 13. Thus, these introduced features constitute an unallowable intermediate generalisation of the disclosure in the application as filed. The subject matter of claim 1 thus extends beyond the content of the application as filed.

It is thus evident that the requirement of Article 123(2) EPC would not be met by this request. At least for this reason the Board finds that claim 1 of auxiliary submission 13 is not *prima facie* allowable and consequently auxiliary submission 13 is not admitted into the appeal proceedings.

2. *Auxiliary submission 14*

The deletion of the word "fixed" in claim 1 of this request does not alter the conclusion reached in regard to claim 1 of auxiliary submission 13. Auxiliary submission 14 is thus not allowed into the proceedings at least for the same reasons as apply to auxiliary submission 13.

3. *Auxiliary submission 15*

In auxiliary submission 15, the feature "are substantially symmetrical about a radius of the front sleeve member, and" has been deleted compared to claim 1 of auxiliary submission 13. The subject matter of claim 1 of auxiliary submission 15 is thus broader than that of claim 1 of auxiliary submission 13 in this regard, even though an additional feature has been added relating to axial slots as disclosed with regard to Fig. 5A.

The Board thus finds that the admittance of auxiliary submission 15 into proceedings is not acceptable, since the request cannot be considered as converging the appeal procedure towards an allowable claim, but rather diverging the appeal procedure which would result in renewed consideration of whether a basis would exist in the filed application for the (new) combination of the features of the claim with this particular feature being omitted. In view of the state of proceedings and the particular lateness of the request, combined with the diverging effect on the appeal procedure at such a

late stage, the Board uses its discretion not to admit the request into proceedings (see Article 10b(1) RPBA).

4. *Auxiliary submission 16*

The deletion of the word "fixed" in claim 1 of this request does not alter the conclusion reached in regard to auxiliary submission 15. Auxiliary submission 16 is thus not allowed into the proceedings for the same reasons as apply to auxiliary submission 15.

5. *No requests in the proceedings in terms of Article 113(2) EPC*

Since none of the requests on which appellant I wishes to have the patent maintained are admitted into proceedings, there is no text in the proceedings which has been submitted to the EPO or agreed by the proprietor on which the EPO can take a decision regarding maintenance of the patent (Article 113(2) EPC). The patent must therefore be revoked.

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:

M. Patin

P. Alting van Geusau