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**Datasheet for the decision  
of 28 September 2010**

**Case Number:** T 1723/08 - 3.2.07

**Application Number:** 02015914.1

**Publication Number:** 1249315

**IPC:** B25F 3/00

**Language of the proceedings:** EN

**Title of invention:**  
Power tool

**Applicant:**  
Black & Decker Inc.

**Opponent:**  
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**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 84, 114(2)  
RPBA Art. 12, 13

**Relevant legal provisions (EPC 1973):**  
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**Keyword:**  
"Clarity (no) - (main request, remaining auxiliary requests 2 and 3)"  
"Late-filed auxiliary request 4: not admitted"

**Decisions cited:**  
T 1126/97

**Catchword:**  
-



Case Number: T 1723/08 - 3.2.07

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.07  
of 28 September 2010

**Appellant:**  
(Applicant)

Black & Decker Inc.  
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**Representative:**

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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 10 June 2008  
refusing European patent application  
No. 02015914.1 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** H. Meinders  
**Members:** K. Poalas  
I. Beckedorf

## Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the Examining Division refusing European patent application 02 015 914.1. Said application is a divisional application of the parent application 99 310 163.1, (see case T 2134/08).
- II. In its decision the Examining Division held that the subject-matter of claim 1 according to the main request filed with letter dated 8 April 2008 does not meet *inter alia* the requirements of Articles 123(2) and 84 EPC, and that the subject-matter of claim 1 according to the auxiliary request filed with the same letter does not meet *inter alia* the requirements of Article 84 EPC.
- III. Oral proceedings before the Board took place on 28 September 2010.
- IV. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of one of the sets of claims filed as main request and as auxiliary requests 2 and 3, all with letter of 18 August 2008, and as auxiliary request 4 during the oral proceedings. Auxiliary request 1 filed with letter of 18 August 2008 was withdrawn.
- V. Claim 1 according to the **main request** reads as follows:
- "A power saw comprising: a body (36) housing a motor for driving an output shaft (2) of the power saw along a linear path in a reciprocating manner, the body including a handle (38) at an end of the power saw

remote from the output shaft (2) to allow a user to manually hold and operate the power saw; a trigger (44) positioned adjacent the handle (38), the trigger (44) being operable by a user when gripping the handle (38), wherein the handle (38) is positioned relative to the body (36) such that a user may operate the power saw via the handle (38) in a plurality of positions relative to a workpiece, wherein one position of the plurality of positions being the position of a panel saw relative to the workpiece and a second position of the plurality of positions being the position of a jigsaw relative to the workpiece; characterised in that the power saw is operated as either the panel saw or the jigsaw dependent upon the position of the power saw relative to the workpiece, and in that the handle (38) is positioned on the body (36) for the user to operate the saw such that a force applied to the handle in a particular direction allows operation of the power saw in that direction regardless of in which of the plurality of positions the power saw is held relative to the workpiece; and wherein the body (36) comprises a first (40) gripping portion formed on a first edge of the body for gripping by the user when the saw is operated as a panel saw and second (56) gripping portion formed on a second edge of the body for gripping by the user when the saw is operated as a jigsaw, and the handle (38) is configured to be accessible from more than one side, each accessible side corresponding to a given one of the plurality of different positions".

Claim 1 according to **auxiliary request 2** differs from claim 1 according to the main request in that in the third line the following sentence has been added:

"and which output shaft is arranged to accept one of a plurality of different sized, interchangeable, saw blades"

and in the characterising part the following sentences have been added:

"characterised in that the saw is used as the panel saw with a first, larger saw blade of the plurality of interchangeable saw blades coupled to the output shaft and in that the saw is used as a jigsaw with a second, relatively smaller, different, one of the plurality of saw blades coupled to the output shaft;".

Claim 1 according to **auxiliary request 3** differs from claim 1 according to the main request in that the following sentences have been introduced:

"and which output shaft is arranged to accept one of a plurality of different sized, interchangeable, saw blades",

"the power saw as either the panel saw, when held in one position relative to a workpiece, or the jigsaw, when held in another position relative to the workpiece",

"characterised in that the saw is used as the panel saw with a first, larger saw blade of the plurality of interchangeable saw blades coupled to the output shaft and in that the saw is used as a jigsaw with a second, relatively smaller, different, one of the plurality of saw blades coupled to the output shaft;".

Claim 1 according to **auxiliary request 4** reads as follows:

"A power saw operable in either a panel saw mode or a jigsaw mode comprising:

a body (36) housing a motor for driving an output shaft (2) of the power saw along a linear path in a reciprocating manner; a first, larger and a second, smaller, saw blade (12), each for selectively mounting to the output shaft (2); the body including a handle (38) at an end of the power saw remote from the output shaft (2) to allow a user to manually hold and operate the power saw;

a trigger (44) positioned adjacent the handle (38), the trigger (44) being operable by a user when gripping the handle (38), wherein the handle (38) is positioned relative to the body (36) of the saw, such that the saw is used in the panel saw mode with the first saw blade mounted on the output shaft (2) and held by a user in a first orientation and wherein the saw is used in the jigsaw mode with the second saw blade mounted on the output shaft (2) and held by a user in a second orientation wherein the first and second orientations correspond to two accessible sides of the handle, respectively; the handle (38) being positioned on the body (36) for the user to operate the saw such that a force applied to the handle in a particular direction allows operation of the power saw in that direction regardless of in which of the plurality of modes the power saw used and held relative to the workpiece; and wherein the body (36) comprises a first (40) gripping portion formed on the body for gripping by the user when the saw is operated in the panel saw mode and second (56) gripping portion formed on f the body for

gripping by the user when the saw is operated in the jigsaw mode".

III. The appellant argued as follows:

*Main request and auxiliary requests 2 and 3: Clarity - Article 84 EPC*

The feature in claim 1 that the handle is "positioned on the body for the user to operate the saw such that a force applied to the handle in a particular direction allows operation of the power saw in that direction regardless of in which of the plurality of positions the power saw is held relative to the workpiece" is to be seen as a functional and therefore allowable feature and any further defining meaning relative to the body of the power saw is not envisaged. Further technical features of the same, reflecting the use of the saw, as suggested by the Board, would be unnecessarily limiting. It is obvious to the skilled person that utility has to prevail when operating the power saw in a particular direction. For the operation as a panel saw it is clear that the blade used has a considerable width, such as a handsaw used for sawing panels along a straight line.

Claim 1 is not unclear.

*Auxiliary request 4: admittance into the proceedings*

Due to the amendments of claim 1 according to the auxiliary request 4 all objections raised in the Board's communication as annexed to the summons to the oral proceedings have been overcome. The auxiliary

request 4 should therefore be admitted into the proceedings.

### **Reasons for the decision**

1. *Main request and auxiliary requests 2 and 3: Clarity - Article 84 EPC*

1.1 In its communication annexed to the summons to oral proceedings the Board objected to the clarity of claims 1 of these requests as regards the passage: "handle (38) is positioned on the body (36) for the user to operate the saw such that a force applied to the handle in a particular direction allows operation of the power saw in that direction regardless of in which of the plurality of positions the power saw is held relative to the workpiece," as it defines the positioning of the handle on the body by features of the use to which the saw is put, rather than by a technical feature of the saw, its handle or their cooperation. Furthermore, since this particular direction is not specifically defined in claim 1 this could be any arbitrarily chosen direction. In particular the application of a force to the handle in a direction deviating from the one of the cutting edge of the saw blade, especially when it is used as a panel saw, could not in general produce satisfactory cutting results.

1.2 The Board, after having heard the appellant at the oral proceedings, has reconsidered the case, but sees no reason to deviate from its earlier finding.



1.3 The appellant's argument that the above mentioned passage of claim 1 need have no further defining meaning relative to the body of the power saw, other than describing its functionality, cannot be followed by the Board. Said passage is meant to define in the Board's view the position of the handle on the body and therefore has to be clear as to its meaning and its technical implications for the handle. It has to work for any of the plurality of positions in which the power saw can be held.

1.4 In this respect the Board accepts, for the sake of argument, the appellant's position that the plurality of positions in which the power saw is held relative to the workpiece relates in fact to the two uses, either as a panel saw or as a jigsaw, to which the saw is to be put, be it with a horizontally or a vertically oriented workpiece.

This means that the handle should be such that any force applied to it as a jigsaw should also allow the saw to operate as a panel saw and vice versa.

However, with a force applied at a right angle to the reciprocating movement of the saw, e.g. a torque applied to the handle - which is entirely normal for a jigsaw to make a curve - this saw when supplied with a panel saw as argued by the appellant (see point III above) would not be able to operate. The same applies to a force applied to the handle of the saw when supplied with a panel saw, in the direction of movement of the cutting teeth, i.e. operated as a handsaw as suggested by the appellant and confirmed by the description, page 7, lines 18 to 22. Such a force, when

applied to a jigsaw would not work out well for the workpiece, nor for the jigsaw blade itself. A jigsaw blade is not meant to be operated on the pushing stroke as a panel saw is meant to be used, the latter as suggested by the appellant.

The further appellant's argument that the power saw is designed to provide optimum cutting and it is obvious to the skilled person that utility has to prevail when operating the power saw in a particular direction, can for the above reasons not be accepted.

1.5 Therefore, apart from the fact that this definition of the handle unnecessarily relates to the use to which the saw is put, it also brings with it unclarity as to how the arrangement of the handle or the body of the saw actually has to be.

1.6 For the above mentioned reasons the subject-matter of claim 1 does not meet the requirements of Article 84 EPC and the main request and the auxiliary requests 2 and 3 are therefore not allowable.

2. *Auxiliary request 4: Admittance into the proceedings*

2.1 The feature of claim 1 according to auxiliary request 4 that "the handle (38) being positioned on the body (36) for the user to operate the saw such that a force applied to the handle in a particular direction allows operation of the power saw in that direction regardless of in which of the plurality of modes the power saw used and held relative to the workpiece" only differs from the corresponding feature of claim 1 according to the previous requests in that the expression

"positions" has been replaced by the expression "modes" and the expression "the power saw is held" has been replaced by the expression "the power saw [is] used and held". Since this amendment does not address nor does it overcome the above mentioned objections as communicated by the Board with its annex to the summons, it is not a clearly allowable request.

2.2 The criteria applied by the Boards of Appeal for admitting amendments to claims filed at a late stage in the appeal procedure, in particular during oral proceedings are the following (see T 1126/97, not published in the OJ EPO, point 3.1.2 of the reasons):

(a) there should be some justification for the late filing;

(b) the subject-matter of the new claims should not diverge considerably from the claims already filed, in particular they should not contain subject-matter which has not previously been claimed;

(c) the new claims should be clearly allowable in the sense that they do not introduce new objections under the EPC and overcome all outstanding objections.

The appellant could not give a justification for the late filing of this auxiliary request, other than that it thought this was generally possible in an ex-parte hearing.

The Board, however, had set the ultimate date for filing submissions at one month before the oral proceedings, indicating that the admittance of facts

and evidence was still subject to the discretion of the Board under Article 114(2) EPC and Articles 12 and 13 RPBA. In any case, at the oral proceedings the Board did not add any objections to those already made, thus did not create a new situation for the appellant warranting such a late-filing.

Since apart from condition (a) also condition (c) is not fulfilled, see point 2.1 above, the Board in the exercise of this discretion, does not admit this request.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders