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**Datasheet for the decision
of 6 June 2013**

Case Number: T 1978/12 - 3.2.07

Application Number: 07776664.0

Publication Number: 2040882

IPC: B25C 1/04

Language of the proceedings: EN

Title of invention:

Control valve assembly for fastener-driving tool

Applicant:

Illinois Tool Works Inc.

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 54, 123(2), 111(1)

Keyword:

"Amendments: allowable (yes)"

"Remittal to the department of first instance (yes)"

"Novelty (yes - after amendment)"

Decisions cited:

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Catchword:

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Case Number: T 1978/12 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 6 June 2013

Appellant: Illinois Tool Works Inc.
(Applicant) 3600 West Lake Avenue
Glenview, IL 60026 (US)

Representative: Gevers France
41, avenue de Friedland
F-75008 Paris (FR)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 14 February 2012
refusing European patent application
No. 07776664.0 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: K. Poalas
E. Kossonakou

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the Examining Division refusing European patent application 07 776 664.0.

- II. In its decision, the Examining Division held that the subject-matter of claim 1 of the main request filed with fax on 9 April 2010 is not novel over each of the teachings of D1 (US 5 785 228 A), D2 (GB 2 286 790 A), D3 (US 2005/156008 A1) or D4 (US 4 404 894 A) and that the subject-matter of claim 1 of the auxiliary request filed with the same fax is not novel over each of the teachings of D1, D2 or D3.
In examination, the Examining Division had indicated that a combination of claims 1 and 3 of the main request could form the basis for further prosecution (item 3.1, communication of 19 October 2010).

- III. In a provisional opinion, annexed to summons for oral proceedings, the Board gave its provisional opinion, confirming the decision under appeal.

- IV. The appellant amended its requests and requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 6 filed as main request with letter dated 7 May 2013. Oral proceedings were requested as an auxiliary measure.

- V. During a telephone conversation with the rapporteur on 28 May 2013 the appellant's representative, after having been informed about the Board's preliminary opinion concerning novelty of the subject-matter of claim 1 of this main request, agreed to the remittal of

the case to the Examining Division for further prosecution.

VI. Independent claim 1 of the main request reads as follows:

"A fastener-driving tool comprising a trigger-actuated control valve assembly (110) disposed within a fastener driving tool housing of said fastener-driving tool and comprising:

a trigger-actuated control valve housing;
a trigger-actuated control valve member (116) disposed within said trigger-actuated control valve housing;
a window means (156, 158), defined within said trigger-actuated control valve housing, in fluidic communication with a substantially horizontally oriented port (166) defined within a first lower end portion of a substantially vertically oriented air passageway (162) which is defined within the fastener-driving tool housing and which is fluidically connected at a second upper end portion thereof with a control air chamber of the fastener-driving tool;
a lower section (114) of said trigger-actuated control valve housing having a diametrical extent which is greater than the diametrical extent of an upper section (112) of said trigger-actuated control valve housing so that an outer peripheral portion of said lower section (114) of said trigger-actuated control valve housing extends radially beyond an outer peripheral portion of said upper section (112) of said trigger-actuated control valve housing in order to define a space within which the first lower end portion of the substantially vertically oriented air passageway (162), and the substantially horizontally oriented port (166) defined

within the first lower end portion of the substantially vertically oriented air passageway (162), can be accommodated characterized in that said lower section (114) of said trigger-actuated control valve housing is disposed in an eccentric manner with respect to said upper section (112) of said trigger-actuated control valve housing".

VII. The appellant argued essentially as follows:

In accordance with the proposal of the Examining Division in item 3.1 of its communication dated 19 October 2010 claim 1 of the main request is now based on the combination of claims 1, 2 and 3 as originally filed.

The further amendments of claim 1 represent the appellant's reaction to lack of clarity objections raised by the Board in item 3 of its provisional opinion. These amendments are supported by at least lines 3 to 4 of the originally filed description page 1.

The feature of claim 1 that "the lower section of the trigger-actuated control valve housing is disposed in an eccentric manner with respect to said upper section" is not present in the apparatuses known from documents D1 to D4. In particular, the sections of the valve disclosed by D3 are all coaxial.

Reasons for the decision

1. *Main request: Amendments - Article 123(2) EPC*

The Board follows the appellant's argument that amended claim 1 is a combination of claims 1, 2 and 3 as originally filed together with the information of page 1, lines 3 to 4 of the description as originally filed and that claims 2 to 6 correspond to originally filed claims 4 to 8.

Therefore, the Board concludes that claims 1 to 6 meet the requirements of Article 123(2) EPC.

2. *Claim 1 according to the main request: Novelty - Article 54 EPC*

2.1 The Board follows the appellant's argument that the feature of claim 1 according to the main request that "the lower section of the trigger-actuated control valve housing is disposed in an eccentric manner with respect to said upper section" is not present in the control valve assemblies known from documents D1 to D4.

2.2 Thus, the subject-matter of claim 1 according to the main request is novel over the disclosure of fastener driving tools with control valve assemblies of each of documents D1 to D4.

3. *Remittal of the case to the department of first instance*

Substantial amendments have been made in claim 1 according to the main request, in particular the

incorporation of the features of originally filed claim 3 into said claim. The amendments concur with the suggestion of the Examining Division in its communication of 19 October 2010 and have the effect that the reason of lack of novelty given for refusing the present application no longer applies, see point 2.2 above. Since the Examining Division on the one hand did not address in its contested decision any other reason hindering the grant of a patent, as for example lack of inventive step, and on the other hand raised in the examination proceedings other formal objections, see for example point 3.6 of its communication dated 19 October 2010, the Board exercises its discretion according to Article 111(1) EPC not to examine these issues for the first time of its own motion but to remit the case to the Examining Division for further prosecution.

4. Since the appellant agreed to this course of action (see point V), the oral proceedings set for 12 June 2013 could be cancelled.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders