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**Datasheet for the decision
of 8 February 2017**

Case Number: T 0013/15 - 3.2.01

Application Number: 09165762.7

Publication Number: 2272739

IPC: B62D55/28

Language of the proceedings: EN

Title of invention:
Replaceable wear pad

Patent Proprietor:
Wirtgen GmbH

Opponent:
BOMAG GmbH

Headword:

Relevant legal provisions:
EPC Art. 54, 56, 114(1)

Keyword:
Novelty (yes)
Inventive step (yes)
Admission of new line of argument (yes)

Decisions cited:

G 0009/91

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 0013/15 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 8 February 2017

Appellant: BOMAG GmbH
(Opponent) Hellerwald
56154 Boppard (DE)

Representative: Lang, Friedrich
Lang & Tomerius
Patentanwälte
Rosa-Bavarese-Strasse 5
80639 München (DE)

Respondent: Wirtgen GmbH
(Patent Proprietor) Reinhard-Wirtgen-Strasse 2
53578 Windhagen (DE)

Representative: dompatent von Kreisler Selting Werner -
Partnerschaft von Patent- und Rechtsanwälten mbB
Deichmannhaus am Dom
Bahnhofsvorplatz 1
50667 Köln (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 11 November
2014 rejecting the opposition filed against
European patent No. 2272739 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: C. Narcisi
O. Loizou

Summary of Facts and Submissions

I. The Opposition against European patent No. 2 272 739 was rejected by the decision of the Opposition Division posted on 11 November 2014. Against this decision an appeal was lodged by the Opponent on 19 December 2014 and at the same time the appeal fee was paid. The statement of grounds of appeal was filed on 11 March 2015.

II. Oral proceedings were held on 8 February 2017. The Appellant (Opponent) requested that the decision be set aside and that the patent be revoked. The Respondent (Patentee) requested that the appeal be dismissed and the patent be maintained as granted (main request) or, in the alternative, that the patent be maintained in amended form on the basis of the set of claims of the first auxiliary request as filed with its reply to the statement of grounds of appeal, or one of auxiliary requests two to six, as filed with its letter dated 6 January 2017.

III. Granted claim 1 reads as follows:

"A replaceable wear pad apparatus (12) for a crawler track (10) of a construction machine, the apparatus (12) comprising:

an elongated reinforcing element (34, 36) having first and second sides (66, 68), the reinforcing element (34, 36) including first and second holes (80, 82) disposed therethrough, and

a wear pad (32) molded from a wear pad material, characterized in that

the reinforcing element (34, 36) includes first and second polygonal cross section sockets, preferably hexagonal sockets (84, 86), defined therein on the

first side (66) of the reinforcing element (34, 36) co-axial with the first and second holes (80, 82), respectively, each socket (84, 86) including a socket floor (8) and multiple sides (90, 92, 94, 96, 98, 100); that first and second polygonal cross section nuts, preferably hexagonal nuts (104, 106), received in the first and second sockets (84, 86) have a threaded bore (108) co-axial with one of the holes (80, 82); and that the reinforcing element (34, 36) and the nuts (104, 106) are embedded in the molded wear pad (32) material so that the wear pad material holds the nuts (104, 106) in place within the socket (84, 86)."

Claim 1 of auxiliary request 1 is identical to claim 1 of the main request.

Claim 1 of auxiliary request 2 differs from claim 1 of the main request in that the wording "the wear pad material holds the nuts (104, 106) in place within the socket (84, 86)" is replaced by the wording "the wear pad material holds the nuts (104, 106) in place within the socket (84, 86); characterized in that the reinforcing element (34, 36) includes first and second lengthwise outer portions (70, 72) having the first and second sockets (84, 86) defined therein, respectively, the outer portions (70,72) being channel shaped in cross-section transverse to the length of the reinforcing element (34, 36), the channel shaped cross-section including a channel floor (126) and opposed outer longitudinal walls (128, 130)".

IV. The Appellant's arguments may be summarized as follows:

The arguments relating to lack of novelty of the subject-matter of granted claim 1 in view of E4 were submitted during oral proceedings before the Opposition

Division. It was not possible to file these arguments earlier in writing, for the Appellant realized only the day before the oral proceedings (studying the case in preparation of said proceedings) that E4 anticipated the subject-matter of granted claim 1. Therefore the Appellant did not wilfully and intentionally submit these arguments at such a late stage of the proceedings and no procedural abuse occurred. The Opposition Division properly exercised its discretionary power when deciding to admit these arguments into the opposition proceedings, for it considered that (based on the Appellant's submissions during the oral proceedings) said arguments based on E4 were indeed relevant to the discussion of novelty and could have prejudiced maintaining the patent as granted.

E4 anticipates the subject-matter of granted claim 1. In effect, contrary to the view taken by the Opposition Division in the appealed decision, the features reading "the reinforcing element (34, 36) includes first and second polygonal cross section sockets, preferably hexagonal sockets (84, 86), defined therein on the first side (66) of the reinforcing element (34, 36) co-axial with the first and second holes (80, 82)" (hereinafter designated as feature (i)) and "the reinforcing element (34, 36) and the nuts (104, 106) are embedded in the molded wear pad (32) material so that the wear pad material holds the nuts (104, 106) in place within the socket (84, 86)" (hereinafter designated as feature (ii)) are known from E4. E4 discloses namely a metal cap 14 being welded to the reinforcing element 11 (E4, figures 1, 3; description, paragraph [0013] of the machine translation into the English language) and constituting a socket with polygonal cross section according to feature (i). Further, E4 also discloses (see figure 1; paragraphs

[0007], [0012], [0013]) that the nut 13 and the reinforcing element 11 are embedded in the molded wear pad material 10, 12 according to feature (ii), such that the nuts are held (at least partly) in place within said socket by the wear pad material (at least indirectly, by exerting a force on the socket or metal cap 14).

The subject-matter of claim 1 of auxiliary request 2 is not new over E4. In addition to the above mentioned features E4 also discloses feature (iii) (i.e. that the "reinforcing element (34, 36) includes first and second lengthwise outer portions (70, 72) having the first and second sockets (84, 86) defined therein, respectively, the outer portions (70,72) being channel shaped in cross-section transverse to the length of the reinforcing element (34, 36), the channel shaped cross-section including a channel floor (126) and opposed outer longitudinal walls (128, 130)"), given that figure 2 shows the socket (or cap) 14 having two delimiting outer walls in a direction transverse to the length of the reinforcing element, the socket thus having a channel shaped cross-section in said transverse direction.

In any event, the subject-matter of claim 1 of auxiliary request 2 lacks an inventive step over E4 and the skilled person's common general knowledge, and likewise over the combination of E4 with E1 or E3. In effect, said feature (iii) (if regarded as being not disclosed in E4) could not contribute to inventive step, for it is generally known to reinforce and strengthen a great variety of constructional elements by providing reinforcing ribs. The skilled person would obviously provide the longitudinal sides of said reinforcing element 11 shown in E4 with such ribs and

would thus obtain the claimed channel shaped cross-section. The same result would be obviously obtained in view of E1 or E3. E1 shows a reinforcing element 8 (figures 3, 6) having a concave or channel shaped cross-section and being delimited by outer longitudinal walls. This configuration of the reinforcing element would be obviously translated by the skilled person to the reinforcing element 11 (figure 1) disclosed in E4. Similar arguments apply in conjunction with E3, particularly figure 2 showing a base plate 4 for a crawler track, said base plate being provided with reinforcing ribs. The skilled person starting from E4 would thus arrive in an obvious manner to the claimed subject-matter in view of E1 or E3.

V. The Respondent's arguments may be summarized as follows:

Arguments based on E4 against the novelty of granted claim 1 were first submitted by the Opponent during the oral proceedings before the Opposition Division. Previous written submissions by the Opponent concerning E4 related only to some of the dependent claims (i.e. 12, 13, 15 to 17). The Opponent did not give any reasons why these arguments could not be filed earlier. Thus, the Patentee was clearly at a disadvantage since it had only a very limited amount of time to respond. This behaviour amounts to a procedural abuse. Under these circumstances the Opposition did not correctly exercise its discretionary power and erroneously admitted these arguments based on E4 into the appeal proceedings. This all the more, for the Opposition Division discussed these arguments without previous assessment of their relevance by means of a prima facie examination. For these reasons these arguments based on

E4 against novelty of the claimed subject-matter should not be admitted into appeal proceedings.

The subject-matter of granted claim 1 (main request) is novel over E4. As a general remark it is first noted that E4 being a Japanese document it is not appropriate for the discussion of novelty to rely solely on the figures and on the machine translation into English, for these do not provide sufficient basis for unambiguous identification of the relevant features. Further, it is noted that aforementioned features (i) and (ii) are anyway not known from E4. As to feature (i), the caps 14 in E4 (see figures 1 to 3) cannot be regarded as constituting a polygonal cross-section socket included in the reinforcing element 11 disclosed in E4, given that these caps are only welded to the reinforcing element 11 and hence are not part of it. Moreover, these caps also do not fulfil any reinforcing function. Concerning feature (ii), the Opposition Division correctly decided that the wear pad 10, 12 illustrated in E4 does not contribute to hold in place the nuts 13 within said caps 14, for the nuts are held in place by the very caps 14. Therefore no embedding of the reinforcing element and nuts in the wear pad such as to fulfil feature (i) is disclosed in E4.

The subject-matter of claim 1 of auxiliary request 2 is new and inventive over E4. It distinguishes from E4 by said feature (iii), which evidently requires that longitudinal outer portions of the reinforcing element be provided, these outer portions including said sockets and having a channel shaped cross section. E4 does not contain any hint or suggestion pointing to feature (iii) and the skilled person would not obviously combine E4 with E1 or E3 such as to arrive to the claimed subject-matter.

Reasons for the Decision

1. The appeal is admissible.
2. In the Board's view the Opposition Division correctly exercised its discretionary power pursuant to Article 114(1) EPC when admitting into the opposition proceedings the line of arguments based on E4 related to lack of novelty of granted claim 1.

First, contrary to the Patentee's allegations, there is absolutely no evidence that these arguments were wilfully and intentionally submitted late, only during oral proceedings, in order to put the Patentee at a disadvantage. The Opponent's statement in this respect is entirely plausible, to the extent that it realized the relevance of E4 only when preparing for the oral proceedings on the preceding day.

Second, the Opposition Division correctly allowed the Opponent to outline its arguments (see minutes, points 8, 9, 10, 11), in order to be able to understand their nature, and the Patentee to comment on these arguments. Thereafter the oral proceedings were interrupted (see minutes, point 10) to allow close consideration of these arguments by the Opposition Division and by the Patentee, and to allow the Opposition Division to deliberate on their admission. Thus, the Patentee had enough time to prepare for a response and its right to be heard was not violated. When the oral proceedings were resumed the Opposition Division announced its decision to admit said arguments (see minutes, point 11) and the Patentee presented its response during the following discussion (see minutes, point 12). What is more, the minutes demonstrate that admission of said

arguments occurred only after listening to both parties' arguments and after deliberation.

The Respondent argued that the Opposition Division should have assessed the relevance of the arguments based on E4 by means of a prima facie examination.

The criterion of prima facie relevance is indeed used by the departments of first instance when deciding whether to admit facts, evidence or grounds for opposition not filed in due time. If these are prima facie relevant, then according to the Guidelines for Examination (see E-V, 2.) "the competent department has to take such grounds, facts or evidence into consideration, no matter what stage the procedure has reached and whatever the reasons for belated submissions. In that case, the principle of examination by the EPO of its own motion under Art. 114(1) takes precedence over the possibility of disregarding facts or evidence under Art. 114(2)".

Furthermore, in decision G9/91, the Enlarged Board of Appeal stated that the consideration of grounds not properly covered by the statement pursuant to Rule 55(c) EPC 1973, should only take place before the Opposition Division in cases where, prima facie, there are clear reasons to believe that such grounds are relevant and would in whole or in part prejudice the maintenance of the European patent. The criterion of prima facie examination thus has to be applied by an Opposition division when deciding whether to admit a new ground for opposition.

However, there is no obligation for an Opposition to apply the principle of prima facie relevance in case of a new line of attack which is within the framework of a

ground for opposition (here: lack of novelty, Article 100(a) EPC) and which is based on a document (here: document E4) which is already in the proceedings (E4 being cited and discussed in the notice of opposition, although only in respect of dependent claims). In fact, in the present case, the Opposition Division gave precedence to the principle of examination by the EPO of its own motion under Article 114(1) EPC, having regard to the fact that neither reasons of procedural economy (see point 6.1 of the of the impugned decision: "E4 was already in the proceedings from the beginning and it could be expected that arguments based on the teaching of E4 might be filed later in the proceedings") nor reasons of fairness in respect of one of the parties spoke against it. In fact, the Opposition Division considered that the Patentee could be expected to deal with the new line of argumentation during an interruption of the oral proceedings (see point 6.1 of the impugned decision: "to give the patent proprietor and the opposition Division sufficient time to study E4 and the arguments of the Opponent based on E4 the proceedings were interrupted"). This, in fact, was not contested by the Patentee as is apparent from the minutes of the oral proceedings before the Opposition Division.

Under these circumstances, the Board does not see any valid reason to conclude that the Opposition Division incorrectly exercised its discretionary power and thus set aside the decision of the Opposition Division to admit the line of argumentation of lack of novelty in view of E4.

3. The subject-matter of granted claim 1 lacks novelty over E4 (Article 54 EPC). The Patentee's generic arguments against the nature and quality of the

evidence provided by E4 are rejected by the Board, these objections being to the extent that said evidence is solely (and not sufficiently clearly) derivable from the figures of this Japanese document and its machine translation. As a matter of fact, the discussion of novelty with respect to E4 (before the Opposition Division and before the Board) did not present any specific difficulties related to a proper interpretation of the disclosure of E4.

Concerning the substantive issues, both features (i) and (ii) are known from E4. In particular, the cap 14 (see E4, figures 1 to 4; paragraphs [0012], [0013], claims) is welded to the reinforcing element 11 and thus can be regarded as forming part of the reinforcing element. Moreover, claim 1 does not stipulate that the reinforcing element be integrally formed and the question whether said cap 14 contributes or not to strengthen said reinforcing element 11 is irrelevant, for anyway it is not prejudicial to its reinforcing function and does not in any way (negatively) affect this function. Further, cap 14 has a polygonal shape and constitutes a polygonal socket having multiple sides (see figure 2). Further, as shown by figure 1 (paragraph [0007]), the nuts 13 (having a polygonal cross section) are received in said sockets 14 and have a threaded bore coaxial with the holes formed in said reinforcing element 11. Finally, figure 1 clearly illustrates that the reinforcing element 11 and the nuts 13 are "embedded" in the molded wear pad material 10, 12, insofar as the term "embedded" does not necessarily entail complete enclosure nor direct contact. Also, the wear pad material 10, 12 obviously contributes to indirectly hold the nuts in place within the sockets, since the wear pad material contributes to holding in place the sockets, particularly during operation of the the crawler track, where external

forces acting on the socket and the nut are countered and compensated for by reaction forces generated by the wear pad material.

4. For the same reasons as above, the subject-matter of claim 1 of auxiliary request 1, being identical with granted claim 1 (main request), is not new over E4.

5. The subject-matter of claim 1 of auxiliary request 2 is new over E4 (Article 54 EPC). Indeed, the feature of claim 1 according to which "the outer portions (70,72) being channel shaped in cross-section transverse to the length of the reinforcing element (34, 36)" (see feature (iii)) implies, by referring to the cross-section, that the outer portions are channel shaped throughout the whole transversal extension thereof. This feature is not disclosed in E4, not even in the region of the outer portions where the socket is formed, contrary to the Opponent's allegations. E4 shows (see figure 2) that even in this region the overall cross-section of the outer portion of the reinforcing element 11 is not channel shaped, for the cross-section of the socket constitutes only a portion of the overall cross-section of the outer portion of the reinforcing element in a transverse direction of the same.

6. The subject-matter of claim 1 of auxiliary request 2 involves an inventive step in view of E4 and further documents E1 or E3, as well as the skilled person's common general knowledge (Article 56 EPC). The Opponent's arguments could not convince the Board. Specifically, feature (iii), distinguishing the invention from the disclosure of E4, does not result in an obvious manner from the combination of E4 with the skilled person's common general knowledge. The Opponent

is right in that it is generally known and appropriate in various different situations to form ribs on constructional elements in order to reinforce and strengthen said elements. Nonetheless, the skilled person has at its disposal various different ways in which these ribs may be formed on said constructional elements, depending on the specific needs (e.g. acting external forces) and the specific structure of the constructional elements. The Opponent's arguments do not explain why the skilled person would specifically choose a reinforcing configuration according to feature (iii) of claim 1 and which incentive the skilled person would have to modify the wear pad apparatus in such a manner. Moreover, E4 likewise does not explicitly or implicitly hint at such a modification, for E4 does not deal with this technical problem. In addition, the actual structure and configuration of the wear pad apparatus as depicted in figure 1 of E4 does not suggest any real need for a measure according to feature (iii), for the relative thickness of the reinforcing element 11 and of base plate (or shoe) 20 is about the same and it is comparable to the thickness of the wear pad 10, 12.

Even if the skilled person, starting from E4, would consider E1 or E3, the same conclusions would apply as above. Analogously to the reasons given above, the skilled person starting from E4 would lack any incentive to modify the known wear pad apparatus in the way of feature (iii). E1 and E3 disclosing wear pad apparatuses with a structure and configuration different from those of the apparatus of E4, it is not obvious why, in the absence of any hint or suggestion, the skilled person would extract specific features which are designed and suitable as components and parts

of a different construction or structure and translate these features into the apparatus of E4.

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 with the order to maintain the patent in amended form on the basis of the following:

Description:

Columns 3-4 as filed during oral proceedings (annex 1) and columns 1-2 and 5-11 of the patent as granted.

Claims:

No. 1-16 of the second auxiliary request filed with letter dated 6 January 2017.

Drawings:

Fig. 1-20 of the patent as granted.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated