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**Datasheet for the decision
of 13 June 2023**

Case Number: T 2162/21 - 3.2.07

Application Number: 11871730.5

Publication Number: 2747965

IPC: B25F5/02, B27B17/00

Language of the proceedings: EN

Title of invention:

BATTERY POWERED REAR HANDLE CHAIN SAW

Patent Proprietor:

Husqvarna AB

Opponent:

Andreas Stihl AG & Co. KG

Headword:

Relevant legal provisions:

EPC Art. 84, 54(2), 54(3), 56

RPBA 2020 Art. 12(6), 13(2)

Keyword:

Amendment to case - amendment admitted (no)

Claims - clarity in opposition appeal proceedings - clarity -
main request (yes)

Novelty - (yes)

Amendment after summons - exceptional circumstances (no) -
taken into account (no)

Inventive step - (yes)

Decisions cited:

Catchword:



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Case Number: T 2162/21 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 13 June 2023

Appellant: Andreas Stihl AG & Co. KG
(Opponent) Badstrasse 115
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Representative: Witte, Weller & Partner Patentanwälte mbB
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Respondent: Husqvarna AB
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
18 October 2021 concerning maintenance of the
European Patent No. 2747965 in amended form.

Composition of the Board:

Chairman A. Pieracci
Members: V. Bevilacqua
O. Loizou

Summary of Facts and Submissions

- I. An appeal was filed by the opponent against the decision of the opposition division to maintain European patent No. 2 747 965 in amended form according to the then first auxiliary request.
- II. In preparation for oral proceedings, the Board gave its preliminary opinion in a communication pursuant to Article 15(1) RPBA 2020, to which the patent proprietor (respondent) replied with a letter dated 29 March 2023 and the appellant with letter dated 19 May 2023.
- III. Oral proceedings before the Board took place on 13 June 2023.

At the conclusion of the proceedings, the decision was announced. Further details of the oral proceedings can be found in the minutes.

The final requests of the parties were as follows.

The opponent (appellant) requested that

- the decision under appeal be set aside and
- the patent be revoked.

The patent proprietor (respondent) requested

- that the appeal of the opponent be dismissed (main request);
- alternatively, that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 6, or
- as a further alternative, that the patent be maintained as granted (auxiliary request 7), all the above requests filed with the reply to the

statement of grounds of appeal.

The respondent requested further that the patent be maintained in amended form on the basis of one of auxiliary requests 0a-6a (in that order), 0b-6b (in that order) and 3c-6c (in that order), all these requests filed with the letter dated 29 March 2023.

IV. The following documents are mentioned in the present decision:

D2: US 2010/218386 A1;

D3: EP 2 438 808 A1;

D4: US 4 272 889 A;

D5: EP 1 792 533 B1.

D10a: STIHL E10-Handbook;

D10b: STIHL- Catalogue;

D10c: Technical Drawings of STIHL E10.

V. The arguments of the parties relevant for the decision are dealt with in detail in the Reasons for the Decision.

VI. Independent claim 1 of the main request reads as follows (features added with respect to claim 1 as granted are in bold, emphasis added by the Board):

"A battery-powered chain saw, comprising a housing (10) extending in a longitudinal direction (X) between a front end (12) and a rear end (11),

the longitudinal direction (X) being parallel with a flat ground surface as the chain saw is put away in an inoperable rest position,

a rear handle (20) fixedly connected to or integral with the housing (10) and extending in the longitudinal direction (X),
a front handle (30) fixedly connected to the housing (10), wherein an upper portion of the front handle extends in an essentially transversal direction (Z) of the chain saw,
an electric motor (40) arranged to drive a cutting element of the chain saw, the electric motor having a motor rotation axis (A1), and
a cutting element supporting guide bar (50) extending from the front end (12) of the housing (10), in said longitudinal direction (X), the chain saw having a longitudinal rotation axis (X1),
characterized in that a point (60) in which a center axis (A2) of an upper portion (31) of the front handle (30) intersects a vertical plane (P) comprising the longitudinal rotation axis (X1) of the chain saw and also comprising a longitudinal center line of the rear handle (20), is positioned rearwardly of a point (70) in which the motor rotation axis (A1) intersects said vertical plane (P),
wherein the vertical plane (P) is essentially parallel with a main extension plane of said cutting element supporting guide bar (50)."

The text of the independent claims of the auxiliary requests is not repeated in the following because the present decision is not based thereupon.

Reasons for the Decision

1. Main request - First clarity objection (Article 84 EPC)

1.1 The first clarity objection of the appellant, whose admissibility has been contested by the respondent (reply to the appeal, section 2), arises out of the amendment:

"as the chain saw is put away in an inoperable rest position".

1.1.1 According to the appellant the lack of clarity objection raised against this feature in the statement setting out the grounds of appeal (point 2, page 6, second paragraph and page 7 second paragraph) does not represent an amendment with respect to their case as submitted in opposition, on which the decision under appeal was based.

This is because the interpretation of "inoperable rest position" was already discussed during opposition proceedings, as it is evident from section 4 of the letter of 7 September 2021 and from sections 9.4 to 9.7 of the minutes of oral proceedings (letter of 4 October 2022, section 6, letter of 19 May 2023, section 2).

1.1.2 As a second line of argumentation the appellant argues that this objection is to be admitted into appeal proceedings even in the case that, following the respondent, the Board considers it an amendment of its case in the sense of Articles 12(2) and 12(4) RPBA 2020.

This is because there are clear reasons for submitting this objection with the statement setting out the grounds of appeal, as it is a reaction to the stance taken by the opposition division at point 17.2 of the appealed decision on the interpretation of "inoperable rest position", according to which this feature is to be understood as a "unique position", univocally defined for any chainsaw (letter of 4 October 2022, section 6, second paragraph).

- 1.2 The Board disagrees with the opponent's allegation that the above discussed clarity objection was already submitted before the opposition division, for the following reasons.

Section 4 of the letter of 21 September 2021, to which the appellant refers, does not contain any clarity objection against the formulation "as the chain saw is put away in an inoperable rest position".

This passage rather contains a novelty objection based upon a particular interpretation of the features added with respect to claim 1 as granted, also comprising "as the chain saw is put away in an inoperable rest position".

In this section the appellant argued that these features, being very broad, are not enough to establish novelty over the chain saw disclosed in D2.

The minutes of oral proceedings before the opposition division (sections 9.4 to 9.7, and in particular section 9.5) also do not show that this objection was raised before the opposition division.

According to section 9.4, the appellant argued that the features "flat ground surface" and "longitudinal direction" were not clear.

Section 9.5 shows that the respondent based its reply to the above objections also on the feature "as the chain saw is put away in an inoperable rest position".

Section 9.6 shows that the appellant, being made aware of the relevance of this particular feature for clarity, insisted on its clarity objection against "flat ground surface".

Section 9.7 gives the respondent's reply thereto, and also does not contain any clarity objection.

The Board therefore agrees with the respondent that this objection was first submitted with the statement setting out the grounds of appeal, and is therefore an amendment in the sense of Article 12(4) RPBA 2020.

- 1.3 The Board also concurs with the respondent that sections 9.5 and 9.6 of the minutes show that the appellant missed a clear opportunity to submit a clarity objection against the feature "as the chain saw is put away in an inoperable rest position".

The argument of the appellant that this objection could not have been formulated earlier and is a reaction to point 17.2 of the appealed decision is not convincing, because section 9.5 of the minutes clearly show that the interpretation of this feature was already object of the clarity discussions during oral proceedings.

The Board therefore concurs with the respondent that the clarity objection to "inoperable rest position" should have been submitted during opposition proceedings.

- 1.4 According to article 12(6) RPBA 2020 the Board shall not admit objections which should have been submitted in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance.

As the only justifying circumstances submitted by the appellant are not convincing, as discussed above, the clarity objection raised in the statement setting out the grounds of appeal against the feature "as the chain saw is put away in an inoperable rest position" is not admitted into appeal proceedings (Article 12(6) RPBA).

2. Main request - Second clarity objection (Article 84 EPC)

- 2.1 The appellant also submitted a second clarity objection arising out of the amendments made to claim 1 of the main request, arguing that, contrary to the findings at section 17.2 of the appealed decision, it is not clear which structural limitations are imposed to the chainsaw through the following feature, added with respect to claim 1 as granted:
"the longitudinal direction being parallel with a flat ground surface" (statement of grounds, section 2, letter of 4 October 2022, section 6).

According to the appellant a skilled reader is left in doubt as to the meaning of the expression "flat ground surface", because it is not clear how the claimed chain saw and the "flat ground surface" relate to each other.

This is because the "flat ground surface" is different from the "support surface" mentioned in the description

(paragraph [0013]) of the patent in suit), does not belong to the chain saw and could have any possible orientation.

2.2 The Board is not convinced by the above arguments that the amendment

"the longitudinal direction being parallel with a flat ground surface"

introduces non-compliance with Article 84 EPC.

This is because the expression "flat ground surface" is, taken alone, clear, as it defines an external surface without curvature (flat, planar), which is, being a "ground surface", positioned below the claimed chainsaw (letter of 29 March 2023, section 2.2).

The claimed parallelism between this planar surface and the longitudinal direction of the housing, although not being enough to univocally identify a specific longitudinal direction, still does not introduce any obscurity with respect to granted claim 1, because it introduces a (very broad) restriction which is easily understood by a skilled person who is familiar with the concept of parallelism between straight lines and planes (appealed decision, section 17.2, letter of 29 March 2023, section 2.1).

As a consequence of the above the appellant failed to convincingly demonstrate the incorrectness of the findings of the appealed decision on clarity of claim 1 of the main request.

3. Lack of novelty objections based on D2
(Article 54(2) EPC)

3.1 The appellant contests the findings of section 17.3.1 of the appealed decision according to which the subject-matter of claim 1 of the main request is novel over the chain saw disclosed in document D2, the distinguishing feature being that

"the point in which a center axis of an upper portion of the front handle intersects a vertical plane comprising the longitudinal rotation axis of the chain saw and also comprising a longitudinal center line of the rear handle, is positioned **rearwardly** of a point (70) in which the motor rotation axis intersects said vertical plane".

3.1.1 The appellant puts forward that as the orientation of the claimed "flat ground surface" and also the "inoperable rest position" are not restricted in any way, a skilled reader would see, in the content of the disclosure of document D2, and in particular of figure 2 thereof, also longitudinal directions angled with respect to axis 33 depicted therein, such as those indicated in figures 2 and 3 of section 3.1.1 of the statement of grounds of appeal.

According to the appellant, once one of these directions is identified with the longitudinal direction of claim 1 of the main request, the center point of an upper portion of the front handle would be positioned **rearwardly** with respect to the motor rotation axis, with the result that all the features of claim 1 of the main request would be disclosed.

3.1.2 According to the appellant (statement of grounds, section 3.1.2) D2 discloses all the features of claim 1 of the main request **also** because, according to paragraph [0033] thereof, the motor is positioned **approximately below** the upper grip section of the front grip.

The disclosure of D2 therefore does not only encompass embodiments in which the central axis of the upper section of the front handle and the motor axis are vertically aligned, but also embodiments in which there is some misalignment.

D2 therefore also discloses novelty destroying embodiments in which the point in which a center axis of an upper portion of the front handle intersects a vertical plane comprising the longitudinal rotation axis of the chain saw and also comprising a longitudinal center line of the rear handle, is positioned **rearwardly** of a point in which the motor rotation axis intersects said vertical plane.

3.1.3 The appellant also submitted, during oral proceedings, a third line of attack, also starting from the disclosure "approximately below" at paragraph [0033] of D2, but this time based it on the case law on selection from parameter ranges.

According to the appellant the exceptional circumstances justifying that this third line of attack be taken into account are that the respondent and the Board are in a position to immediately discuss it during oral proceedings, as novelty objections based upon D2 had been in the proceedings since the beginning.

3.2 The above arguments of the appellant do not demonstrate that the findings of the appealed decision on novelty over D2 are not correct, for the following reasons.

3.2.1 The argument that there being no restriction, in claim 1 of the main request, on the orientation of the "flat ground surface" and on the "inoperable rest position", a skilled reader would see, in the content of the disclosure of document D2, and in particular of figure 2 thereof, also longitudinal directions angled with respect to axis 33 depicted therein, such as those indicated in figures 2 and 3 of section 3.1.1 of the statement of grounds of appeal, is not convincing.

This is because, as argued by the respondent, a skilled reader finds in D2 (last sentence of paragraph [0023]) a clear statement according to which the longitudinal axis of the tool depicted in the figures 1 to 3 is indicated by reference 33.

While it is a well-established principle laid down by the Boards' case law that a non-specific definition in a claim should be given its broadest technically sensible meaning (see the Case Law of the Boards of Appeal, CLB, 10th Edition, 2022, I.C.4.1), always according to the Boards' settled case law, for the interpretation of any document, in particular a patent application or patent, in order to determine its true meaning and thus its content and disclosure, no part of such a document should be construed in isolation from the remainder of the document.

On the contrary, each part of such a document has to be construed in the context of the contents of the document as a whole.

The first novelty attack of the appellant (statement of grounds, section 3.1.1.) is therefore not convincing, because it is based on an interpretation of the content of the disclosure of figure 2 of document D2 which does not take into account the above principles, as it deliberately ignores the information given in paragraph [0023] of this document according to which the longitudinal axis of the tool depicted in the figures 1 to 3 is the one indicated by reference 33.

- 3.2.2 The second novelty attack (statement of grounds, section 3.1.2) submitted by the appellant, according to which the wording at paragraph [0033] of D2 "**approximately below**" could be seen as a broad disclosure encompassing novelty destroying embodiments, can also not be followed by the Board.

This is because while a specific disclosure destroys the novelty of a generic feature, it is established case law (CLB, *supra*, I.C.5.2.6) that a generic disclosure does not destroy the novelty of a specific feature.

- 3.2.3 The third novelty attack, submitted, during oral proceedings, is not admitted into the proceedings (Article 13(2) RPBA 2020).

The appellant acknowledged that this objection was an amendment to his case made after notification of a summons to oral proceedings.

Such an amendment shall, in principle, not be taken into account unless there are exceptional circumstances which have been justified with cogent reasons by the party concerned (Article 13(2) RPBA 2020).

In the present case, the Board finds that the circumstances submitted by the appellant are not exceptional.

This is because the appellant failed to identify any new or unforeseen development in the appeal proceedings justifying the late filing of this new line of argumentation (CLB, *supra*, V.A.4.5.1).

In the absence of any such new or unforeseen development the fact that novelty against D2 has already been contested since the beginning of opposition proceedings does not justify the late submission of a new line of attack based on the same document, but rather shows that nothing prevented the appellant from filing this new argumentation at an earlier stage.

4. Lack of novelty objection based on D3
(Article 54(3) EPC)

4.1 The appellant contested the findings of section 17.3.2 of the appealed decision according to which the subject-matter of claim 1 of the main request is novel over the chain saw disclosed in document D3 (statement of grounds, section 3.2).

According to the appealed decision features 1h and 1k, namely

(1h) "a vertical plane (P) comprising the longitudinal rotation axis (X1) of the chain saw and also comprising a longitudinal center line of the rear handle (20)"

(1k) "wherein the vertical plane (P) is essentially

parallel with a main extension plane of said cutting element supporting guide bar (50)"

are not disclosed in D3, because figure 1 thereof is schematic and does not show the position and orientation of the guide bar and of the rear handle.

The appellant puts forward that the findings of the appealed decision are not correct, and that figure 1 of D3, even if it was to be considered as a schematic representation, shows the position of the guide bar and of the rear handle.

There is no indication in this document that the motor and the upper handle shown in figure 1 thereof should not be positioned as depicted.

Figure 1 is in spite of the absence of any information in the description in that respect, detailed enough for a skilled person to be able to understand,, that the mutual position shown therein between the motor rotation axis and the center axis of an upper portion of the front handle is based on technical considerations.

For the above reasons, according to the appellant, a chain saw constructed exactly as depicted in figure 1 of D3 has all the features of claim 1 of the main request.

4.2 The Board disagrees.

According to the established jurisprudence (CLB, *supra*, I.C.4.6) features shown solely in a drawing form part of the state of the art only if a person skilled in that art is able, in the absence of any

other description, to derive a technical teaching from them.

As a result of the above principle the relative position between the motor rotation axis (which is not depicted) and the center axis of an upper portion of the front handle which the appellant derives from figure 1 of D3 can only be seen as part of the disclosure of this document if this particular detail corresponds, in the eyes of a skilled person, to a technical feature of the chain saw.

In the present case, however, the appellant failed to identify any passage of D3 supporting its allegation that locating the engine as shown in figure 1 was the deliberate result of technical considerations.

As acknowledged by the appellant the relative position between the motor rotation axis and the center axis of an upper portion of the front handle is, in fact, never mentioned in the text of D3.

D3 deals with issues related to motor control (see paragraph [006] thereof), and, as already discussed, does not contain any passage mentioning the importance of the relative positioning between motor and upper handle.

In view of the above, the lack of any indication in D3 that the motor and the upper handle shown in figure 1 thereof should be positioned differently, is not sufficient for concluding that D3 discloses that

"the point in which a center axis of an upper portion of the front handle intersects a vertical plane comprising the longitudinal rotation axis of the chain

saw and also comprising a longitudinal center line of the rear handle, is positioned **rearwardly** of a point (70) in which the motor rotation axis intersects said vertical plane".

Given in particular that paragraph [0018] of D3 clearly states that figure 1 is a schematic illustration, the Board concurs with the opposition division that it could not be excluded that the details of figure 1 upon which the appellant based its novelty attack are merely an expression of the draughtsman's artistic freedom.

The exact position of the motor is therefore not derivable from figure 1 of D3 (reply to the appeal, section 3.2).

In addition, although guide bar and rear handle are visible in figure 1 of D3, the orientation thereof cannot be univocally identified from this figure alone, or in combination with the rest of the disclosure of D3.

This means that the longitudinal center line of the rear handle is not necessarily essentially parallel to the plane of the guide bar.

It is therefore not possible to determine the position where the plane P would intersect the top handle, and that for this reason D3 fails to disclose the claimed vertical plane, which has to be essentially parallel with a main extension plane of the cutting element supporting guide bar plane and has to comprise the longitudinal rotation axis of the chain saw and a longitudinal center line of the rear handle (reply to the appeal, section 3.2, appealed decision, section 17.3.2).

As a consequence of the above the appellant failed to demonstrate the incorrectness of the findings at section 17.3.2 of the appealed decision.

5. Inventive step, starting from D2

5.1 The opposition division dismissed the inventive step objections formulated by the appellant starting from D2 in combination with the knowledge of a skilled person (appealed decision, 17.4.1) and in combination with D5 (appealed decision, 17.4.2).

The appealed decision is based on the assumption that the effect linked to the distinguishing features established in section 17.3.1 of the appealed decision (feature 1j, repeated in full in section 3.1 above) was that the rotational inertia of the chain saw around the upper portion of the front handle is reduced, optimising the longitudinal balance.

The problem to be solved was seen in providing a battery powered chain saw which is comfortable to carry and operate.

Inventive step was acknowledged with the argument that a skilled person would not find, in his general knowledge or in D5, a teaching that, to improve comfort, the design of the chain saw of D2 should be modified in such a way that the center axis of the front handle is positioned rearward of the motor rotation axis.

5.2 The appellant contests the above findings and argues that the appealed decision is to be set aside for the

following reasons.

- 5.2.1 The effect on the basis of which inventive step was acknowledged cannot be used for the purposes of discussing inventive step (statement of grounds, sections 4.1 and 4.2).

This is because the rotational inertia of the chain saw around the upper portion of the front handle is only reduced by moving the motor forwardly if there is a heavy battery and the battery and the motor are arranged on opposite sides of the upper grip portion of the front handle in the longitudinal direction, instead of on the same side, as shown in D2, figure 2.

As however claim 1 does not foresee the presence of a heavy battery in the rear side of the housing the above effect is not achieved by the claimed subject-matter.

- 5.2.2 Inventive step should be denied even in case that a skilled person would seek to solve the problem as formulated in the appealed decision because, already on the basis of his knowledge, the distinguishing features (see point 3.1 above) would be implemented to obtain a chain saw that is more comfortable to carry and operate.

The skilled person would have no practical difficulties in moving the motor to arrange it on the forward side of the upper grip portion of the front handle.

This is because room for a motor displacement within the housing shown in figure 2 of D2 can be easily achieved by moving away the lubricating oil tank 31.

Another obvious possibility to arrive to the subject-matter of claim 1 of the main request would be to move the upper grip portion of D2 rearwardly.

In one of these two ways the skilled person would arrive at the subject-matter of claim 1 of the main request without having to exercise any inventive skill.

5.2.3 Lack of inventive step is also apparent, when the teachings of document D5 are taken into consideration.

This is because D5 (see paragraph [0003]) deals with the task of enabling user-friendly handling of gardening devices, such as chain saws (see paragraph [0012]).

Figure 3 thereof shows a hedge trimmer, in which the motor housing (8) is positioned in front of the front handle (3).

The skilled person would see the advantages of this teaching and have no practical difficulties in applying it to the chainsaw disclosed in D2. In this way he would arrive at the subject-matter of claim 1 of the main request without having to exercise any inventive skill.

5.3 The Board disagrees.

5.3.1 The Board is not convinced that the effect on the basis of which inventive step was acknowledged by the opposition division cannot be used for the purposes of discussing the inventive step objection submitted by the appellant, starting from D2.

According to the problem-solution approach (CLB, *supra*, I.D.2) once a particular starting point has been selected, it is necessary to assess the technical results (or effects) achieved by the distinguishing features of the claimed invention **when compared with this particular piece of prior art.**

As, in the present case, the appellant deliberately chose to start from the chain saw of D2, which comprises a battery (15), the Board is satisfied that rotational inertia around the upper portion of the front handle thereof is reduced if the motor is positioned in accordance with the distinguishing feature of claim 1 of the main request.

This effect of the distinguishing feature is also clearly mentioned in the patent in suit (see paragraphs [0007], [00031] and [00032]) and therefore derivable therefrom.

The appealed decision is therefore based on a correct application of the problem-solution approach, because the opposition division correctly assessed the effect of the distinguishing feature with respect to D2.

- 5.3.2 The argument of the appellant that a skilled person would, already on the basis of his knowledge, implement the distinguishing feature of claim 1 of the main request to solve the problem as formulated in the appealed decision, without having to apply the need of any inventive step is also not convincing.

This is because the appellant explained how the skilled person could have arrived at the invention by modifying the prior art (by moving the motor, by moving the handle), but failed to explain why the skilled person

would have done so, on the basis of the general knowledge, in the expectation of solving the underlying technical problem (reply to the appeal, sections 4.1.vi and 4.1.vii).

Contrary to what has been argued by the appellant technical feasibility and the absence of obstacles are not sufficient to render obvious what is actually achievable for the skilled person (could-would approach, CLB, *supra*, I.D.5).

- 5.3.3 The inventive step objection based on the combination of documents D2 and D5 is not convincing either.

The Board here follows the arguments of the respondent and concurs with the findings of the appealed decision that a skilled skilled person would not see how the particular motor configuration of this known foldable hedge trimmer could be advantageous for improving the balance and handling of the chain saw of D2.

This is because paragraph [0012] of this document, where chain saws are mentioned once, contains an explanation of the advantages achieved through the pivot joint (12) which allows adaptation to different work situations.

In other words this passage does not address the reduction of the rotational inertia around the upper portion of the front handle of a chain saw or of a similar device.

It is therefore not apparent why a skilled person would have modified the chain saw of D2 by moving the motor in front of the front handle, as shown in the hedge trimmer depicted in figure 3 of this document.

Based on the above the opposition division correctly found that the subject-matter of claim 1 of the main request involves an inventive step over the combination of the teachings of documents D2 and D5 (appealed decision, section 17.4.2).

6. Inventive step, starting from D4

6.1 The opposition division found that the subject-matter of claim 1 of the main request involves an inventive step over the disclosure of document D4 taken in combination with the knowledge of the skilled person (appealed decision, section 17.4.4).

This was because as D4 fails to disclose that the chain saw is battery operated and also fails to disclose a cutting element supporting guide bar **extending** from the front end of the housing in the **longitudinal direction**, it would not be possible to modify this device and obtain the subject-matter of claim 1 of the main request in a simple, straightforward way, which does not involve inventive step.

6.2 The appellant contests the above findings as follows (see the statement of grounds of appeal, point 4.3).

A switchover of this known chain saw to battery operation would not require inventive step, because it is sufficient to provide a battery and a corresponding inverter.

A reorientation of the saw blade can also be easily achieved, for example, by installing simple pulleys to drive the chain.

It is also not apparent why the balance of the saw

would be endangered by the modification.

The subject-matter of claim 1 according to auxiliary claim 1 is therefore not inventive compared to the D4.

6.3 The Board disagrees.

As correctly found by the opposition division (section 17.4.4) there are substantial differences between the chain saw disclosed in D4 and the claimed chain saw, at least because they have different cutting directions.

This implies that the chain saw of D4 would not be regarded by a skilled person as a suitable starting point for an inventive step discussion.

The allegation of the appellant that changing the orientation of the chain saw of D4 is within the capabilities of a skilled person is not convincing because it has not been substantiated.

In any case, as noted by the respondent (reply, section 4.3), although a person skilled in the art is completely free in choosing a starting point, he is afterwards bound by that choice.

According to the jurisprudence a change of type of chain saw during the further development of the type of chain saw chosen as the starting point, to another type, which was previously known but had not been chosen, could then only be seen as the result of an ex-post-facto analysis (CLB, *supra*, I.D.3.6).

7. D10 - admittance into the proceedings

7.1 According to the appellant the discretionary decision not to admit prior use D10 (appealed decision, section 17.5) has to be reviewed by the Board as this prior use is objectively prima facie relevant, in the view of documents 10a, 10b and D10c.

The appellant argues that the opposition division wrongly applied the correct admissibility criterion, namely of prima facie relevance (statement of grounds, section 4.4).

7.2 The Board decided not to admit document D10. According to established case law, if the way in which a department of first instance has exercised its discretion is challenged in appeal, it is not the function of the Board of Appeal to put itself in the place of that department and consider how it would have exercised its discretion itself (CLB, *supra*, V.A. 3.4.1.b).

A Board should only overrule the way in which the discretion was exercised if it concludes that it was done according to the wrong principles, or without taking into account the right principles, or in an unreasonable way.

In the present case it is not apparent to the Board that the opposition division examined the prima facie relevance of document D10 in a manifestly unreasonable manner, and notes that the decision not to follow the arguments of the appellant has been fully and comprehensibly reasoned (appealed decision, section 17.5.2).

As a consequence of the the Board's intention not to reverse the opposition division's discretionary decision not to admit D10 into the proceedings, the appellant's line of argument for lack of inventive step starting from this document (statement of grounds, section 4.4) is not taken into account in the present appeal proceedings (Article 12(4) RPBA).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

A. Pieracci

Decision electronically authenticated